Supreme Court, U.S.
FILED

No. 971317 FEB 11 1998

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In The

Supreme Court of the United States

October Term, 1997

THE WEST BEND COMPANY,

Petitioner,

vs.

SUNBEAM PRODUCTS, INC.,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

PETITION FOR WRIT OF CERTIORARI

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QUESTIONS PRESENTED

1. Whether, under 15 U.S.C. § 1125(a), the *product configuration* of a kitchen appliance, *not* a registered trademark, is a trademark for such appliance despite the expired design and utility patents on the product, their limited terms as set forth under 35 U.S.C. § 173 and § 154, and the Constitutional mandate that exclusive patent rights be secured for "limited times."

2. Whether a holding of likelihood of public confusion due to *product configuration* similarities in competitive kitchen appliances is improper when it is undisputed that respondent's and petitioner's appliances (and their packages) are prominently marked with their respective well-known registered word marks.

3. Whether, under 15 U.S.C. § 1125(a), the *product configuration* of a kitchen appliance is a trademark despite the fact that it consists of a combination of functional features.

4. Whether the "utilitarian standard of functionality" is too narrow when a *product configuration* is asserted as a purported trademark — particularly considering that, as a practical matter, alternative product configurations are always possible.

5. Whether, when the *product configuration* of a kitchen appliance is asserted as a purported trademark, more than a mere period of use should be required to create a presumption of secondary meaning.

6. Whether the *product configuration* of a kitchen appliance never registered as a trademark is a "famous trademark" within the meaning of recently-enacted 15 U.S.C. § 1125(c).

STATEMENT PURSUANT TO RULE 29.6

The parties to the proceedings below were petitioner, The West Bend Company, and respondent, Sunbeam Products, Inc. The West Bend Company, a wholly-owned subsidiary of Premark International, Inc., of Deerfield, Illinois, has no nonwholly-owned subsidiaries.

TABLE OF CONTENTS

	Page
Questions Presented	i
Statement Pursuant to Rule 29.6	ii
Table of Contents	iii
Table of Citations	v
Opinions Below	1
Statement of Jurisdiction	1
Constitutional Provisions, Statutes and Administrative Rules Involved	2
Statement of the Case	4
A. The Parties	4
B. Course of Proceedings and Disposition in Court Below	5
C. Facts of the Case	7
1. The Alleged Sunbeam Trademark	7
2. Secondary Meaning Evidence	8
3. Functionality of the Supposed Trademark	8

Contents

Page

4. Third-Party Uses of the "Key Design Features" 11

5. Expired Sunbeam Patents (Design and Utility) 11

6. The Accused WEST BEND® Mixers 11

7. Distinctive Labeling and Packaging 14

Reasons for Granting the Writ 14

I. Clarification Is Needed On The Issue Of Lanham Act Protection For Alleged Product Configuration Trademarks In Light Of The Patent Laws. 14

II. Allowing *Product Configurations* To Acquire Trademark Status (Secondary Meaning) By Mere Use Extends The Exclusivity Of Patented Designs In Violation Of The Constitution And The Patent Laws. 18

III. Clarification Of Functionality Analysis Is Needed With Respect To Alleged Product Configuration Marks. 21

A. A Product Configuration Which Is a Combination of Functional Features Should Not Qualify as a Trademark. 22

B. The "Utilitarian" Test of Functionality Is Inappropriate for Determining Whether a Product Configuration Is a Trademark. . 23

Contents

	Page
IV. In Cases Involving Similar Product Configurations, Distinctive Marking Of Products And Packaging Is Legally Sufficient To Avoid Confusion As To Source.	24
V. Unregistered Product Configurations Which Are Combinations Of Functional Features Are Not "Famous Marks" Under The New Federal Anti-Dilution Act.	26
Conclusion	27

TABLE OF CITATIONS

Cases Cited:

AmBrit, Inc. v. Kraft, Inc., 812 F.2d 1531 (11th Cir. 1986)	22
Black & Decker Inc. v. Hoover Service Center, 886 F.2d 1285 (Fed. Cir. 1989)	16
Blue Bell Bio-Medical v. Cin-Bad, Inc., 864 F.2d 1253 (5th Cir. 1989)	24
Bonito Boats, Inc. v. Thunder Craft Boats, Inc., 489 U.S. 141 (1989)	17
Bose Corporation v. Linear Design Labs, Inc., et al., 467 F.2d 304 (2nd Cir. 1972)	24

Contents

Page

Brunswick Corp. v. Spinit Reel Co., 832 F.2d 513 (10th Cir. 1987) 16

Clamp Mfg. Co., Inc. v. Enco Mfg. Co., Inc., 870 F.2d 512 (9th Cir. 1989) 16

Compco Corp. v. Day-Brite Lighting, Inc., 376 U.S. 234 (1964), *reh. denied*, 377 U.S. 913 (1964) 17

Dorr-Oliver, Inc. v. Fluid-Quip, Inc., 94 F.3d 376 (7th Cir. 1996) 16

Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd., 40 F.3d 1431 (3rd Cir. 1994) 16, 25

Elmer v. ICC Fabricating Inc., 67 F.3d 1571 (Fed. Cir. 1995) 17, 22

Ferrari S.P.A. Esercizio Fabriche Automobili E. Corsi v. Roberts, 944 F.2d 1235 (6th Cir. 1991) 16

Fisher Stoves, Inc. v. All Nighter Stove Works, Inc., 626 F.2d 193 (1st Cir. 1980) 16, 22, 24

Keene Corporation v. Paraflex Industries, Inc. et al., 653 F.2d 822 (3rd Cir. 1981) 23

Kellogg Co. v. National Biscuit Co., 305 U.S. 674 (1938), *reh. denied*, 305 U.S. 674 (1938) 17, 20, 24, 25

Contents

Page

Kohler Co. v. Moen Inc., 12 F.3d 632 (7th Cir. 1993) 16, 17, 24

Landscape Forms, Inc. v. Columbia Cascade Company, 113 F.3d 373 (2nd Cir. 1997) 16

Litton Systems, Inc. v. Whirlpool Corporation, 728 F.2d 1423 (Fed. Cir. 1984) 24

Quaker Oats Co. v. General Mills, Inc., 134 F.2d 429 (7th Cir. 1943) 25

Qualitex Co. v. Jacobson Products Co., 514 U.S. 159 (1995) 14, 15, 18, 21

Scott Paper Co. v. Marcalus Mfg. Co., Inc. et al., 326 U.S. 249 (1945), *reh. denied*, 326 U.S. 811 (1945) 17

Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 225 (1964), *reh. denied*, 376 U.S. 973 (1964) 17

Singer Mfg. Co. v. June Mfg. Co., 163 U.S. 169 (1896) 17

Sno-Wizard Manufacturing, Inc. v. Eisemann Products Co., et al., 791 F.2d 423 (5th Cir. 1986) 24

Thomas & Betts Corp. v. Panduit Corp., 65 F.3d 654 (7th Cir. 1995) 16, 17

Contents

Page

Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992) 14, 15, 16, 18, 21

Versa Products Co., Inc. v. Bifold Co. (Mfg.) Ltd., 50 F.3d 189 (3rd Cir. 1995) 16, 17, 25

Vornado Air Circulation Systems, Inc. v. Duracraft Corp., 58 F.3d 1498 (10th Cir. 1995) 16, 17

Statutes Cited:

15 U.S.C. § 1052(f) 19

15 U.S.C. § 1121 1

15 U.S.C. § 1125 2

15 U.S.C. § 1125(a) ..... i, 2, 4, 14, 22

15 U.S.C. § 1125(c) ..... i, 2, 4, 5, 26

28 U.S.C. § 1254(1) 2

28 U.S.C. § 1292 2

28 U.S.C. § 1292(a)(1) 2

28 U.S.C. § 1338(a) 1, 3

28 U.S.C. § 1338(b) 2, 3

Contents

	Page
35 U.S.C. § 154	i, 3, 15
35 U.S.C. § 154(a)(2)	3
35 U.S.C. § 154(c)(1)	3
35 U.S.C. § 171	3, 19
35 U.S.C. § 173	i, 3, 15

United States Constitution Cited:

United States Constitution, Article I, Section 8	2, 15

Other Authorities Cited:

MPEP § 1502	3
MPEP § 1502.01	3, 19

APPENDIX

Appendix A — Opinion Of The United States Court Of Appeals For The Fifth Circuit Filed September 15, 1997	1a
Appendix B — Order Granting Preliminary Injunction Of The United States District Court For The Southern District Of Mississippi, Hattiesburg Division Filed May 3, 1996	32a

Contents

Page

Appendix C — Order Modifying Preliminary Injunction Of The United States District Court For The Southern District Of Mississippi, Hattiesburg Division Filed May 14, 1996 ..... 62a

Appendix D — Order Further Modifying Preliminary Injunction Of The United States District Court For The Southern District Of Mississippi, Hattiesburg Division Filed May 14, 1996 ..... 67a

Appendix E — Order And Findings Of The United States District Court For The Southern District Of Mississippi, Hattiesburg Division Filed May 24, 1996 ..... 72a

Appendix F — Order Approving Statements Of Proceedings As Submitted By Defendant Of The United States District Court For The Southern District Of Mississippi, Hattiesburg Division Filed June 27, 1996 With Attached Statements Of Proceedings 81a

Appendix G — Order Of The United States District Court For The Southern District Of Mississippi, Hattiesburg Division Filed August 7, 1996 ..... 101a

Appendix H — Constitutional Provisions, Statutes And Regulations 103a

Lodging Appendix L-1 through L-12
Under Separate Volume

The West Bend Company ("West Bend") petitions this Court for a Writ of Certiorari to review the judgment of the United States Court of Appeals for the Fifth Circuit entered in this case on September 15, 1997.

OPINIONS BELOW

The opinion of the United States Court of Appeals for the Fifth Circuit of September 15, 1997, is reported at 123 F.2d 246 (5th Cir. 1997) and is in the Appendix (App.) at 1a-31a.

The following orders of the United States District Court for the Southern District of Mississippi, Hattiesburg Division, were the subject of the consolidated appeal to the Fifth Circuit:

- The "Order Granting Preliminary Injunction," dated May 3, 1996, is reported at WL 511639 (SD MS 1997) and is at App. 32a-61a;

- The "Order Modifying Preliminary Injunction," dated May 14, 1996, is at App. 62a-66a;

- The "Order Further Modifying Preliminary Injunction," dated May 14, 1996, is at App. 67a-71a;

- The Order and "Findings by the Court as to Sequence of Events and Reasoning Behind Various Orders Entered by the Court in this Cause," dated May 23, 1996, is at App. 72a-80a;

- The Order, dated August 6, 1996, is at App. 101a-102a.

STATEMENT OF JURISDICTION

Subject matter jurisdiction in the District Court was based on 15 U.S.C. § 1121 and 28 U.S.C. § 1338(a) with respect to the

federal claims arising under 15 U.S.C. § 1125(a) and (c), and on 28 U.S.C. § 1338(b) and the doctrine of pendent jurisdiction with respect to the common law claim.

The jurisdiction of the Court of Appeals was pursuant to 28 U.S.C. § 1292 for consolidated interlocutory appeals of District Court orders of May 3, 1996, May 14, 1996 (two), May 23, 1996, and August 6, 1996 — a preliminary injunction and related subsequent orders.

The jurisdiction of this Court is invoked under 28 U.S.C. § 1254(1).

On December 5, 1997, after an application (A-411) by petitioner, Justice Scalia granted an extension of time within which to file this petition for a writ of *certiorari* to and including February 11, 1998.

CONSTITUTIONAL PROVISIONS, STATUTES AND ADMINISTRATIVE RULES INVOLVED

United States Constitution, Article I, Section 8

> The Congress shall have the power . . . To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries. . . .

15 U.S.C. § 1125: False designations of origin, false descriptions, and dilution forbidden

See App. 103a-107a.

28 U.S.C. § 1292(a)(1): Interlocutory decisions

See App. 107a-108a.

28 U.S.C. § 1338(a) and (b): Patents, plant variety protection, copyrights, mask works, trademarks and unfair competition

See App. 108a.

35 U.S.C. § 154(a)(2) and (c)(1): Contents and term of patent

See App. 108a-109a.

35 U.S.C. § 171: Patents for Design

> Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.
>
> The provisions of this article relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

35 U.S.C. § 173: Term of Design Patent

> Patents for design shall be granted for the term of fourteen years.

***Manual of Patent Examining Procedure* (*MPEP*) § 1502: Definitions of a Design**.

See App. 110a.

***MPEP* 1502.01: Distinction Between Design and Utility Patents**

See App. 110a.

STATEMENT OF THE CASE

A. The Parties

Sunbeam is a manufacturer of consumer products, including mixers and other household appliances and has numerous facilities across the country, including a plant in Hattiesburg, Mississippi. West Bend is based in West Bend, Wisconsin, and makes most of its products, including household appliances, at that location.

B. Course of Proceedings and Disposition in Court Below

On April 11, 1996, Sunbeam Products, Inc. ("Sunbeam") sued The West Bend Company ("West Bend") in United States District Court for the Southern District of Mississippi, Hattiesburg Division.

The complaint alleged that Sunbeam has trademark rights in the *product configuration* of a SUNBEAM® MIXMASTER® stand mixer[1] and that, under 15 U.S.C. § 1125(a), West Bend's stand mixer Model #41012[2] infringed such purported trademark. More specifically, Sunbeam alleged that a grouping of product features is either inherently distinctive or has acquired secondary meaning. Other common law counts typical in trademark cases were also included.

In addition, Sunbeam alleged that the *product configuration* it described is a "famous mark" within the meaning of 15 U.S.C.

1. This was later defined as SUNBEAM® MIXMASTER® Model #2360. L-1 is a photograph of this stand mixer; the product itself is Exhibit C-1 of the appeal record below. (All references in this petition to "L" followed by a number are intended to refer to pages in the Lodging Appendix filed with this petition.)

2. This product is referred to herein as "West Bend Mixer #1." L-2 is a photograph of this product; the product itself is Exhibit C-2 of the appeal record below. Subsequent configurations are referred to as "West Bend Mixers ##2-6" (L-3 through L-7).

§ 1125(c), the 1996 Federal Anti-Dilution Act and that West Bend Mixer #1 violates that new statutory provision.

Sunbeam also filed "Sunbeam's Motion for Temporary Restraining Order and Preliminary Injunction" and, on April 12, 1996, after an *ex parte* hearing without prior notice, the District Court entered a TRO enjoining West Bend Mixer #1. The TRO was dissolved April 16, and a preliminary injunction hearing was set for April 30, 1996.

On May 3, 1996, following the preliminary injunction hearing, the District Court entered its "Order Granting Preliminary Injunction" (App. 32a-61a), enjoining West Bend from making, using and selling West Bend Mixer #1.

In view of an impending trade show, West Bend filed a motion for clarification and, on May 4, 1996, Judge Charles W. Pickering, Sr. graciously convened a hearing at his residence to consider whether a revised West Bend prototype (West Bend Mixer #2) would violate the injunction.[3] The matter was not resolved.

On May 6, 1996, the District Court held a telephone hearing further dealing with applicability of the injunction to revised product configurations.[4] The Court ruled, as later seen in the May 14, 1996 "Order Modifying Preliminary Injunction" (App. 62a-66a), as follows: that West Bend Mixer #2 was enjoined; that West Bend could proceed if it changed the shape of the speed control dial such that it "flares outwardly" according to a rough sketch (App. 66a); that West Bend would have to make two further changes, each by a different later date, including elimination of any "middle-up arched" handle curvature (top and bottom profile)

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3. App. 83a-90a is a Court-approved summary of the May 4, 1996 proceedings. L-3 shows West Bend Mixer #2.

4. App. 91a-100a is a Court-approved summary of the May 6, 1996 telephone proceedings.

and redesign of the face plate; that West Bend would have to promptly inform Sunbeam of proposed modifications; and that the District Court would maintain continued jurisdiction "to consider any modifications or requests for modifications made by the parties as the need arises."

West Bend's attempt to execute the flaring of the sketched control dial is West Bend Mixer #3 (L-4). Such modification was given to Judge Pickering a few days later and further hearings were held on May 13 and 14, 1996 to determine whether West Bend Mixer #3 avoided the injunction. This resulted in issuance of the May 14, 1996 "Order Further Modifying Preliminary Injunction" (App. 67a-71a). The District Court enjoined West Bend Mixer #3, but approved mixers having any of three further proposed modifications. One of these became West Bend Mixer #4 (L-5) — the first product West Bend delivered to its customers. The *only* difference between enjoined West Bend Mixer #3 and approved West Bend Mixer #4 was elimination of mixing speed terms (*e.g.*, "mix," "beat" and "blend") from the annular wall of the speed control dial.

On May 23, 1996, the District Court issued "Findings By the Court as to Sequence of Events and Reasoning Behind Various Orders Entered By the Court in this Cause" (App. 72a-80a).

On May 31, 1996, West Bend filed a Notice of Appeal with respect to the Preliminary Injunction Order of May 3, and the two May 14 orders enjoining West Bend Mixer #2 and West Bend Mixer #3.

On July 31, 1996, before briefing began on the appeal, the District Court held a hearing regarding West Bend's request for an order approving further-modified West Bend Mixer #5 (L-6), which included a complete new motor housing with integrated handle and no face plate. In an Order signed August 6, 1996 (App. 101a-102a), the District Court enjoined West Bend Mixer #5, but held that the product would be approved if the flared, wordless speed

control dial of West Bend Mixer #4 were used on West Bend Mixer #5, instead of what was proposed; in other words, the District Court approved what became West Bend Mixer #6 (L-7).

On August 12, 1996, West Bend filed a Notice of Appeal of the August 6 Order enjoining West Bend Mixer #5. On motion, the Court of Appeals consolidated the two appeals.

On September 15, 1997, after briefing and oral argument before the United States Court of Appeals for the Fifth Circuit, the orders of the District Court were affirmed (App. 1a-31a).

C. Facts of the Case

1. The Alleged Sunbeam Trademark

Sunbeam's suit claims that West Bend Mixer #1 infringes alleged Sunbeam trademark rights in the *product configuration* of the SUNBEAM® MIXMASTER® stand mixer because West Bend's product is similar in appearance. Sunbeam's complaint asserts that certain "key design features" constitute its trademark, including: (1) a "torpedo-shaped" motor housing with a rounded[5] rear-mounted speed control dial which conforms to the shape of the housing; (2) a handle attached to the front of the housing, arching over the housing and terminating in space (a free end) above the housing; (3) a beater ejector button located to the left of the handle; (4) a tear-drop shaped face plate on the front of the housing; and (5) a horizontal stripe or groove along each side of the housing.

Sunbeam's definition of its purported trademark has changed since filing the complaint. For example, while no reference was made to color in the complaint, Sunbeam later argued that its "trademark" also involved the white-with-black colors of Model

5. While the complaint states that Sunbeam's speed control dial is "rounded," it was later described as a "frustum" shape.

#2360, even though Sunbeam models have a variety of other color combinations. Sunbeam's deposition witness designated most-knowledgeable, Walter R.M. Hall, testified that the beater eject button was not part of the mark, but that certain features not mentioned in the complaint (mixer stand, turntable and dual-mounted beaters) may be part of it.

Sunbeam's *product configuration* is not a registered trademark; the registered trademarks for Sunbeam's stand mixer are SUNBEAM® and MIXMASTER®. Concurrent with its complaint, Sunbeam filed five trademark applications in the Patent & Trademark Office showing general views and a silhouette of the product configuration. At this writing, these applications are either abandoned by Sunbeam (two) or the subject of Opposition proceedings (three).

2. Secondary Meaning Evidence

As seen in the opinions below, the evidence relied on in holding that the product configuration has become a trademark was Sunbeam's extended use.

3. Functionality of the Supposed Trademark

Evidence is compiled in West Bend's Exhibit F (appeal record below) to show functionality of Sunbeam's "key design features." This evidence is in a variety of documents (Exhibits F1-F64, all part of Exhibit F), including many prior Sunbeam patents. Examples of the evidence for functionality of the "key design features" include the following:

Regarding feature #1, a "torpedo-shaped" motor housing with a rear-mounted speed control dial conforming to the shape of the motor housing, expired Sunbeam Patent Nos. 2,703,381 (Exhibit F1), 2,165,858 (Exhibit F7) and 2,274,480 (Exhibit F8) are pertinent, disclosing and claiming "key design feature" #1 and

noting its functions and advantages.[6] Functionality is also seen in Sunbeam's Instruction Book (Exhibit F17), carton panel (Exhibit F18) and cookbook (Exhibit F19), which states, "[I]n no other mixer is the switch so convenient [and] so easily used." More evidence confirms the functionality of the motor housing and housing-dial layout.

Regarding feature #2, a handle attached to the front of the housing, arching over it and terminating in a free end, expired Sunbeam Patent No. 2,070,768 (Exhibit F12) is pertinent, disclosing and claiming this feature.[7] Free-ended handles, many at least slightly arched, are on many mixers (Exhibits F38-F56, F13 and F2).

Regarding feature #3, a beater ejector button at the left of the handle, expired Sunbeam Patent No. 3,198,490 (Exhibit F3) is pertinent.[8] Sunbeam's book (Exhibit F17) and carton (Exhibit F18)

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6. The '858 patent claims "a control knob . . . comprising a body having an outer surface shaped to conform with the outer surface of the motor . . ." (claim 4). The '381 patent notes that the '480 patent discloses juxtaposition, shape and rotational relationship of dial and housing. The '381 patent says the dial is "an extension of the casing blending therewith" (col. 8, lines 62-63) and is "a large section which may readily be grasped by the operator and which . . . may also accommodate suitable indicia for indicating the operating condition of the mixer" (col. 8, lines 63-67); claim 12 has "a control dial forming an extension of [the] casing . . ." and claim 13 has a "cone-shaped control member having indicia-containing sections circumferentially spaced each containing indicia showing an operating function intended to be performed by the motor at a given speed."

7. It discloses "a handle having a single point of support" (p. 1, col. 1, lines 10-11), allowing "avoidance of unsightly attaching means for the ends of the handle" (p. 2, col. 1, lines 8-9); claim 3 has "means for supporting the handle on the casing comprising a plate positioned against one end of the casing."

8. Claim 4 of the patent claims a beater ejecting mechanism (Cont'd)

confirm functionality; the carton says, "No mess beater ejection is easy to reach" — as is apparent since the button is at the thumb position on the handle. Other evidence confirms functionality.

Regarding feature #4, a tear-drop shaped face plate on the front of the housing, expired Sunbeam Patent Nos. 3,280,351 (Exhibit F5) shows the function of the face plate as covering and closing the open motor housing and end structure.[9]

Regarding feature #5, a horizontal stripe or groove along the sides of the motor housing, expired Sunbeam Patent Nos. 2,530,302 (Exhibit F6) and 3,077,340 (Exhibit F14) shows functionality.[10] Other evidence further shows the functionality of feature #5.

(Cont'd)
"includ[ing] a reciprocally movable knob movable in a recess in [the] handle." The patent shows left eject button placement and notes (at col. 10, lines 15-16) that for beater ejection "all [one] need do is to press downwardly on the knob 162. . . ."

9. The patent states, "These open portions of casing 1 and post 4 are closed by a . . . plate 7 . . ." (col. 3, lines 30-32).

10. Claim 5 of the '302 patent claims "a case for a motor unit comprising two separable parts each having spaced edge portions, the edge portions of one part being shaped to substantially match the edge portions of the other part when the parts are positioned to form a unitary case. . . ." The '340 patent says,

> It would be desirable to provide a household food mixer which is very simple to build and assemble, and which may readily be disassembled for repair purposes

(col. 1, lines 31-33), and refers to the benefit of

> parts [which] may be assembled on a base unit or the like while still being fully exposed for repair, and wherein the housing comprises such base unit and a suitable cover

(col. 1, lines 37-41). A horizontal parting line is a necessary result.

4. Third-Party Uses of the "Key Design Features"

West Bend's Exhibit F (appeal record below) also shows that there have been various third-party users of the "key design features" alleged by Sunbeam. These include: torpedo-shaped housings on stand mixers and rear knobs (*e.g.*, Exhibit F20, photo of A.C. Gilbert Co. mixer, Exhibit F28, photo of Kitchen-Aid mixer, and Exhibit F20); handles fixed at one end and arching over the mixer body and terminating in space (*e.g.*, Exhibit F55, Dominion mixer, Exhibit F56, Hamilton Beach mixer, and Exhibit F28; and the patents of Exhibits F42, F44, F45, F47 and F50); beater-ejector buttons located to the left of the handle (*e.g.*, Exhibit F57, Hamilton Beach/Proctor-Silex mixer); and horizontal stripes or grooves along the side of the housing (*e.g.*, Exhibit F21, Waring mixer, Exhibits F38-F40 and F56, Hamilton Beach mixers, Exhibit F41, GE mixer, Exhibit F55, Dominion mixer, and F57). Furthermore, black and white colors are common colors for kitchen appliances, as seen at least in Exhibits F20 and F28.

5. Expired Sunbeam Patents (Design and Utility)

Sunbeam's United States Design Patent Nos. 208,805 and 210,682 (seen in Lodging Appendix, L-9 through L-12) claimed as inventive designs the Sunbeam stand mixer *product configuration* now in issue. These design patents *expired* in the 1980's.

Furthermore, as noted above, there are numerous *expired* Sunbeam utility patents bearing on the so-called "key design features" referred to by Sunbeam in its complaint, including at least Patent Nos. 2,703,381, 2,165,858, 2,274,480, 2,070,768, 3,198,490, 3,280,351, 2,530,302 and 3,077,340.

6. The Accused WEST BEND® Mixers

West Bend was fully aware of the Sunbeam mixer when the design of West Bend Mixer #1 (L-2) was developed. It is conceded

that West Bend Mixer #1 and the Sunbeam mixer have similar functional features and functional layout.

However, evidence was presented as to the many design differences; such differences are evidence of what the design experts for the parties agreed is a different "form language."[11] In other words, West Bend Mixer #1 is not identical to the Sunbeam mixer, nor is it a "knock-off" in the sense that the mixers have interchangable parts. It was independently designed.

The different form language of West Bend Mixer #1 is seen in many features distinguishing it from the Sunbeam mixer, including:

- The West Bend motor housing is of smooth conical form (*i.e.*, round in its cross-sections); Sunbeam's has a "squared-off" bottom.

- The West Bend speed control dial is elliptical in side profile; Sunbeam's is rectilinear. West Bend's dial is also smaller and more tapered, and is formed of several blended curved surfaces including a pronounced concave rear surface.

- The West Bend handle is attached to a raised upper portion of the motor housing; Sunbeam's handle reaches down to a non-raised motor housing. The West Bend handle terminates rearwardly in a smooth continuous curve; Sunbeam's is "cut off" at an angle.

- The West Bend beater eject button is curved and elliptical in form; Sunbeam's which has several flat surfaces and sharp corners.

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11. The differences are in the declaration of West Bend's design expert Marc Harrison (in Exhibit D-18 of the appeal record below), and acknowledged in testimony by Sunbeam's design expert, Steve Meister (Preliminary Injunction Transcript, pp. 172-183 and 154-155).

- The West Bend face plate covers the entire frontal area of the housing; Sunbeam's covers less than the entire frontal area. West Bend's face plate, in both front and side profiles, consists of continuously curved segments blended into a soft-looking form; Sunbeam's is primarily flat in profile and has several straight line elements, well-defined edges and sharp angles. West Bend's face plate has an elliptical grill portion with vertical slots for cooling air; Sunbeam's does not have the appearance of a grill.

- The West Bend mixer has no added horizontal stripe on its motor housing; Sunbeam's mixer does.

- The West Bend pedestal has a broad bulbous appearance; Sunbeam's pedestal is much narrower, with sharp vertical corners tapering toward one another.

These differences show that West Bend Mixer #1 resulted from independent design development, albeit with knowledge of the Sunbeam product. West Bend Mixer #1 was enjoined by the District Court.

West Bend Mixers #2, #3 and #5 (L-3, L-4 and L-6), also enjoined, differ still more when compared to the Sunbeam mixer. West Bend Mixers #2 and #3 each have a handle which is visually connected at its rear end to the top of the motor housing, so that there is no free end. West Bend Mixer #3 has a flared rear speed control. West Bend Mixer #5, as noted above, has a still further different body-and-handle arrangement, eliminating any face plate, and integrating and repositioning the handle. West Bend Mixers #2, #3 and #5 have no black coloration at all.

The District Court ruled (App. 68a, ¶ 2a) that if the speed-indication words (*e.g.*, "mix," "stir" etc.) were removed from the side of the speed control dial of West Bend Mixer #3, it would be approved. In response, West Bend eliminated this highly-desirable

product feature to create court-approved West Bend Mixer #4.[12] Later, in enjoining West Bend Mixer #5, the court required that the speed control be changed (App. 101a-102a).

West Bend Mixer #4 and West Bend Mixer #6 were approved by the District Court. However, West Bend has been barred from using speed-indication words on the dial side wall unless it increases the outward flare of the speed control dial (App. 68a, ¶ 2b).

7. Distinctive Labeling and Packaging

All of petitioner's enjoined stand mixers (and the packaging for them) have been prominently marked with petitioner's well-known WEST BEND® trademark. Likewise, respondent's stand mixer (and packaging) have always been prominently marked with plaintiff's well-known SUNBEAM® and MIXMASTER® trademarks. Such packaging is seen in L-8.

REASONS FOR GRANTING THE WRIT

I.

CLARIFICATION IS NEEDED ON THE ISSUE OF LANHAM ACT PROTECTION FOR ALLEGED PRODUCT CONFIGURATION TRADEMARKS IN LIGHT OF THE PATENT LAWS.

Sunbeam Products, Inc. v. The West Bend Company provides the opportunity for consideration by the Supreme Court of a case which, with *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992), and *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995), would complete a trilogy of recent cases clarifying the scope of Lanham Act protection under 15 U.S.C. § 1125(a). *Two*

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12. At the same time West Bend straightened the handle (eliminating its slight arch), thus complying with one of delayed requirements imposed by the District Court.

Pesos dealt with trade dress issues in the context of restaurant decor and *Qualitex* dealt with the protection of color. Unlike either *Two Pesos* or *Qualitex*, this case presents clear issues relating to *product configurations* as alleged trademarks. Thus, this case involves important policy-related interplay with the protections for product configurations afforded by the patent laws.

A dictum in *Qualitex* cautioned about the important concerns attending assertions that *product configurations* are trademarks, particularly considering the constitutional mandate of limits on duration of patent protection. The *Qualitex* Court stated:

> It is the province of patent law, not trademark law, to encourage invention by granting . . . a monopoly over *new product designs* or *functions* for a limited time, . . . after which competitors are free to use the innovation. (emphasis added)

514 U.S. at 164. The present case provides the opportunity to address precisely the issues about which the Court expressed concern in its *Qualitex* dictum.

The Lanham Act involves potentially-perpetual exclusive rights while, based on the constitutional and statutory mandates for patents, design patent rights and utility patent rights are for "limited times" (Article I, Section 8; *see also* 35 U.S.C. § 173 and § 154, which state the limited terms for design and utility patents). A conflict regarding duration of rights becomes apparent when trademark protection is afforded to the product configuration of a household appliance — particularly one which, as here, is the subject of two expired design patents and numerous expired utility patents. The Fifth Circuit, in upholding the entry of a preliminary injunction against a West Bend stand mixer, has set up just such a conflict.

The confusion concerning product configurations as alleged trademarks is demonstrated by a split between the appellate courts regarding analysis of alleged product configuration marks, and by judicial calls for clarification. While the confusion has been brewing

for some time, it has escalated since this Court's *Two Pesos* decision as more plaintiffs seek to enforce purported *product configuration* trademarks against their competitors. In *Landscape Forms, Inc. v. Columbia Cascade Company*, 113 F.3d 373, 373 (2nd Cir. 1997), the Second Circuit notes:

> Those who would seek monopolistic protection for industrial design . . . , [g]iven impetus by the Supreme Court's opinion in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992), . . . have turned to the law of trade dress as it has evolved under the Lanham Act.

Product configurations have been held to be trademarks in the following appellate decisions: the Fifth Circuit in the present *Sunbeam Products* case; the Sixth Circuit in *Ferrari S.P.A. Esercizio Fabriche Automobili E. Corsi v. Roberts*, 944 F.2d 1235 (6th Cir. 1991); the Seventh Circuit in the registration appeal case of *Kohler Co. v. Moen Inc.*, 12 F.3d 632 (7th Cir. 1993); the Ninth Circuit in *Clamp Mfg. Co., Inc. v. Enco Mfg. Co., Inc.*, 870 F.2d 512 (9th Cir. 1989); the Tenth Circuit in *Brunswick Corp. v. Spinit Reel Co.*, 832 F.2d 513 (10th Cir. 1987); and the Federal Circuit in *Black & Decker Inc. v. Hoover Service Center*, 886 F.2d 1285 (Fed. Cir. 1989).

Other appellate decisions, on various rationales, have refused to recognize or enforce alleged product configuration trademarks: the First Circuit in *Fisher Stoves, Inc. v. All Nighter Stove Works, Inc.*, 626 F.2d 193 (1st Cir. 1980); the Second Circuit in *Landscape Forms, supra*; the Third Circuit in *Versa Products Co., Inc. v. Bifold Co. (Mfg.) Ltd.*, 50 F.3d 189 (3rd Cir. 1995), and *Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd.*, 40 F.3d 1431 (3rd Cir. 1994); the Seventh Circuit in the enforcement cases of *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654 (7th Cir. 1995), and *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376 (7th Cir. 1996); the Tenth Circuit in *Vornado Air Circulation Systems, Inc. v. Duracraft Corp.*, 58 F.3d 1498 (10th Cir. 1995); and the Federal

Circuit in *Elmer v. ICC Fabricating Inc.*, 67 F.3d 1571 (Fed. Cir. 1995).

Various decisions and dissents have discussed the conflict that can arise between federal patent law and trademark law with respect to protection afforded product configurations. Among these are *Thomas & Betts*, 65 F.3d at 659; *Versa Products*, 50 F.3d at 203, and *Vornado Air Circulation Systems*, 58 F.3d at 510. Additionally, in *Kohler*, in a vigorous dissent, Judge Cudahy observed that the idea of product configurations themselves being subjects of federal trademark protection "notoriously lacks the support and endorsement of the Supreme Court." *Kohler*, 12 F.3d at 644. Despite discussion of this conflict, the courts seem reluctant to directly address this issue. Consequently, there are many conflicting analyses and decisions between the various circuit courts; there is a need for clarification by the Supreme Court.

Supreme Court decisions both before and after passage of the Lanham Act have emphasized the right to copy product configurations which are the subject of expired patents. *See, e.g., Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896); *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 674 (1938), *reh. denied*, 305 U.S. 674 (1938); *Scott Paper Co. v. Marcalus Mfg. Co., Inc. et al.*, 326 U.S. 249 (1945), *reh. denied*, 326 U.S. 811 (1945); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 225 (1964), *reh. denied*, 376 U.S. 973 (1964); *Compco Corp. v. Day-Brite Lighting, Inc.*, 376 U.S. 234 (1964), *reh. denied*, 377 U.S. 913 (1964); and *Bonito Boats, Inc. v. Thunder Craft Boats, Inc.*, 489 U.S. 141 (1989).

This Court has emphasized the constitutional requirement that patents be issued for a "limited time," and that such time is not extendible. *See, e.g., Scott Paper*, 326 U.S. at 256, in which the Court stated:

> [A]ny attempted reservation or continuation in the patentee or those claiming under him of the patent monopoly, after the patent expires, whatever the legal

> device employed, runs counter to the policy and purpose of the patent laws. . . .
>
> By the force of the patent laws not only is the invention of a patent dedicated to the public upon its expiration, but the public thereby becomes entitled to share in the good will which the patentee has built up in the patented article or product through the enjoyment of his patent monopoly. Hence we have held that the patentee may not exclude the public from participating in that good will or secure, to any extent, a continuation of his monopoly by resorting to the trademark law. . . .

In light of the Court's post-*Two Pesos* cautionary comments regarding "product designs" in *Qualitex*, *supra*, it would be particularly helpful to the courts, and to product designers and manufacturers, if the Supreme Court were to grant *certiorari*.

II.

ALLOWING *PRODUCT CONFIGURATIONS* TO ACQUIRE TRADEMARK STATUS (SECONDARY MEANING) BY MERE USE EXTENDS THE EXCLUSIVITY OF PATENTED DESIGNS IN VIOLATION OF THE CONSTITUTION AND THE PATENT LAWS.

The Fifth Circuit stated that for the product configuration of Sunbeam's mixer to qualify for trademark protection Sunbeam must demonstrate that the product configuration is either inherently distinctive or has an acquired distinctiveness (secondary meaning), and that the product configuration is not functional. *Sunbeam Products, Inc. v. West Bend Co.*, 123 F.3d 246, 251 (5th Cir. 1997). While declining to decide whether Sunbeam's design was inherently distinctive, the Fifth Circuit ruled that Sunbeam's long-term use was *prima facie* evidence of secondary meaning. *Id.* at 255.

The Lanham Act refers to acquired distinctiveness (secondary meaning) in trademarks in general by stating:

> The Commissioner may accept as *prima facie* evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of distinctiveness is made.

15 U.S.C. § 1052(f). In other words, a presumption of a possibly *permanent* right may arise with no more than some exclusive use.

Design patents, of course, confer exclusive use rights on patentees with respect to "new, original and ornamental designs for an article of manufacture." 35 U.S.C. § 171. And, as is well known and noted in the *Manual of Patent Examining Procedure*, § 1502.01, design patents are available for the "shape/configuration" of an article of manufacture. Unlike trademark rights, design patent rights are limited to nonextendible fourteen-year terms. The product configuration protected by a design patent is, of course, used exclusively by the patentee during such patent term.

By allowing a presumption of secondary meaning under the trademark laws to result solely from five years of use of a *product configuration* covered by a design patent, the Fifth Circuit has set forth a rule that allows any design patentee to claim trademark protection in the design under a "secondary meaning" theory after termination of the patent term. This is clear legal error and runs counter to the constitutional mandate and sound public policy.

The Fifth Circuit's decision will have a harmful effect on competition since it allows the mere exclusive use of a product

configuration resulting from design patent protection to *automatically* qualify the product configuration for possible permanent protection — as a "trademark" *after* the design patent expires. If the Fifth Circuit's application of a presumption of secondary meaning to a *product configuration* is allowed to stand, no competitor would attempt to use a product configuration similar to that of a design patent even though it had *expired* — for fear such effort would be enjoined by the inventor-user. At the very least, competitive market research as to potential claims of secondary meaning would be necessary to prepare to rebut a presumption — not the sort of exercise competitors should be driven to in their efforts to provide valuable products to the public at competitive prices.

There is no reason to depart from the Supreme Court's clear direction on this matter as laid out in *Kellogg*, 305 U.S. at 119-120:

> The plaintiff has not the exclusive right to sell shredded wheat in the form of a pillow-shaped biscuit — the form in which the article became known to the public. That is the form in which shredded wheat was made under the basic patent. The patented machines were designed to produce only the pillow-shaped biscuits. And a *design patent* was taken out to cover the pillow-shaped form. Hence, upon expiration of the patents the form . . . was dedicated to the public. . . .
>
> . . . Kellogg Company was free to use the pillow-shaped form, subject only to the obligation to identify its product lest it be mistaken for that of the plaintiff. (emphasis added)

III.

CLARIFICATION OF FUNCTIONALITY ANALYSIS IS NEEDED WITH RESPECT TO ALLEGED PRODUCT CONFIGURATION MARKS.

This Court's *Qualitex* decision, while not involving an alleged product configuration trademark, recognized the importance of functionality considerations in such cases by stating:

> The functionality doctrine prevents trademark law, which seeks to promote competition by protecting a firm's reputation, from instead inhibiting legitimate competition by allowing a producer to control a useful product feature. It is the province of patent law, not trademark law, to encourage invention by granting inventors a monopoly over new product designs or functions for a limited time, . . . after which competitors are free to use the innovation. If a product's functional features could be used as trademarks, however, a monopoly over such features could be obtained without regard to whether they qualify as patents and could be extended forever (because trademarks may be renewed in perpetuity).

514 U.S. at 164-165. The claimed trade dresses in *Two Pesos* and *Qualitex* were held to be nonfunctional and thus protectible as trademarks, but neither involved a product configuration. Given the Court's concerns about perpetual monopolies as stated in *Qualitex*, the instant case, which so clearly involves a product configuration, provides the right opportunity for the Court to clarify how the doctrine of functionality should be applied with respect to alleged product configuration trademarks.

A. A Product Configuration Which Is a Combination of Functional Features Should Not Qualify as a Trademark.

A review of the Fifth Circuit's decision in this case would resolve a split between the appellate courts on the issue of whether a combination of functional features can be nonfunctional, and thus protectible as a trademark under 15 U.S.C. § 1125(a). The First Circuit (in *Fisher Stoves, supra*) and Federal Circuit (in *Elmer, supra*) have held that a combination of functional features which are not the subject of an unexpired patent or copyright may be imitated. The Fifth Circuit's holding in *Sunbeam Products* states that it "is manifestly not the law" that trademark-like protection is ruled out for a product configuration which is a combination of functional features. *Sunbeam Products*, 123 F.3d at 256. A similar position was taken by the Eleventh Circuit In *AmBrit, Inc. v. Kraft, Inc.*, 812 F.2d 1531 (11th Cir. 1986).

The Fifth Circuit distinguished the *Elmer* decision by saying that *Elmer* involved a trade dress in which *every* feature was functional. *Sunbeam Products*, 123 F.3d at 256, n.19. Such reasoning raises the question of just what "features" make up a product configuration; it is always possible to describe a product with greater and greater levels of detail (features) — until a level of nonfunctionality is finally reached, thereby providing an argument for trademark status.

This reasoning allows a self-serving exercise by those attempting to stop a competitor's functionally-similar product. Despite the functionality of a number of similar features, the task for the plaintiff is simply to ascertain some nonfunctional similarity between the products at whatever level of detail is necessary — in order to argue for trademark rights for the overall configuration sufficient to stop the competitor. However, under this reasoning, in asserting such purported rights against a competitor, the "overall similarity" is what is important — even if such overall similarity is the result of the combination of similar functional features.

It is apparent that, using the reasoning of the Fifth Circuit, that functionality findings can almost always be avoided. Thus, alleged trademark rights in product configurations may be enforced even where such rights conflict with public policy.

B. The "Utilitarian" Test of Functionality Is Inappropriate for Determining Whether a Product Configuration Is a Trademark.

The so-called "utilitarian" standard of functionality followed by the Fifth Circuit below also raises the issue of whether *any product configuration* could qualify as functional.

Under this standard as applied with respect to an alleged product configuration trademark, unless there are *few if any* reasonable product design alternatives available to the accused party, the product configuration alleged as a trademark is nonfunctional. Under this standard few if any product configurations would ever be held to be functional (and, thus, available to the public), because a number of alternative designs are virtually always possible.

Furthermore, the "utilitarian standard" of functionality, as applied by the Fifth Circuit with respect to an alleged product configuration trademark, does not properly consider such factors as expired utility patents on the product and the manner in which the plaintiff has touted functionality in its advertising — factors among those considered by other circuits and the PTO. Also not considered is the aesthetic attractiveness of the product design to purchasers, an issue considered under an "aesthetic functionality" analysis used by some others. *See, e.g., Keene Corporation v. Paraflex Industries, Inc. et al.*, 653 F.2d 822 (3rd Cir. 1981).

A review of the widely varying tests for functionality as applied to alleged product configuration trademarks by the circuit courts suggests that direction by this Court would be very helpful to federal courts as well as product designers and manufacturers. The uncertainty inherent in the varying standards for functionality as

applied to alleged product configuration trademarks is mentioned in the *Kohler* dissent:

> The "functionality" doctrine has proved to be at best an extremely fuzzy border. . . . The line between nonfunctional and functional is difficult to draw and an obvious source of litigation.

Kohler, 12 F.3d at 649.

An appropriate analytical framework is needed, particularly considering the public policy issues arising due to the interplay of patent law and federal trademark law.

IV.

IN CASES INVOLVING SIMILAR PRODUCT CONFIGURATIONS, DISTINCTIVE MARKING OF PRODUCTS AND PACKAGING IS LEGALLY SUFFICIENT TO AVOID CONFUSION AS TO SOURCE.

It would also be beneficial for the Court to clarify whether marking of products and packages with distinctive word marks is sufficient to avoid a likelihood of public confusion as to the source of products having similar product configurations.

Various circuits, including the Fifth Circuit in other cases, have held that labeling may dispel consumer confusion. *Blue Bell Bio-Medical v. Cin-Bad, Inc.*, 864 F.2d 1253 (5th Cir. 1989); *Sno-Wizard Manufacturing, Inc. v. Eisemann Products Co., et al.*, 791 F.2d 423 (5th Cir. 1986); *Fisher Stoves, supra*; *Bose Corporation v. Linear Design Labs, Inc., et al.*, 467 F.2d 304 (2nd Cir. 1972); *Versa Products Co., Inc. v. Bifold Co. (Mfg.) Ltd.*, 50 F.3d 189 (3rd Cir. 1995); and *Litton Systems, Inc. v. Whirlpool Corporation*, 728 F.2d 1423 (Fed. Cir. 1984).

Indeed, a prior Supreme Court ruling has held that the only obligation one has even when *copying* a configuration that was the subject of an expired patent is "to identify its product lest it be mistaken for that of the plaintiff." *Kellogg*, 305 U.S. at 120. Indeed,

this Court went on to say that the obligation regarding identification was "not to insure that every purchaser will know it [the accused party] to be the maker, but to use every reasonable means to prevent confusion." *Kellogg*, 305 U.S. at 115.

In the present case, the Fifth Circuit recognized that it was "uncontested that both the West Bend stand mixers and the Sunbeam . . . Mixmaster® [stand mixer] are labeled with the trademarks of their respective manufacturers" (App. 26a), and uncontested that the product packages (L-8) were likewise both prominently marked with their distinctive trademarks. The Fifth Circuit nevertheless upheld the District Court's inference of a likelihood of public confusion based on intent to copy (App. 23a-24a), despite a complete lack of evidence of an intent to infringe.[13] The decisions below in the present case are in direct conflict with *Kellogg*.

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13. When it comes to product configurations, even copying of product configurations, a distinction is appropriate with respect to intent.

> [T]he mere copying of product configurations does not suggest that the copier was necessarily trying to capitalize on the good will of the source of the original product.

Versa Products, 50 F.3d at 201. *See also Duraco Products*, 40 F.3d at 1453. This is especially true when the competing products are clearly marked with the distinctive word marks of the parties. "The pirate flies the flag of the one he would loot. The free and honorable non-pirate flies the colors of his own distinctive ensign." *Quaker Oats Co. v. General Mills, Inc.*, 134 F.2d 429, 432 (7th Cir. 1943).

V.

UNREGISTERED PRODUCT CONFIGURATIONS WHICH ARE COMBINATIONS OF FUNCTIONAL FEATURES ARE NOT "FAMOUS MARKS" UNDER THE NEW FEDERAL ANTI-DILUTION ACT.

A further reason for granting *certiorari* in this case is to provide clarification and direction to the lower courts in defining the term "famous mark" as used in the recent Federal Anti-Dilution Act, 15 U.S.C. § 1125(c), particularly as it applies to alleged product configuration trademarks.

Petitioner believes that this case is the first in which a *product configuration* has been held to be a "famous mark." The Fifth Circuit affirmed the District Court's holding that the unregistered product configuration of the Sunbeam stand mixer is a "famous mark" within the meaning of the Act despite the fact that there was no showing whatsoever that purchasers of the product even recognized the configuration as a trademark, much less a "*famous mark*."

In the instant case, Sunbeam has relied for years on its registered SUNBEAM® and MIXMASTER® marks for source identification for its stand mixers. This is understandable, considering that product configurations, particularly those involving mechanical devices, rarely if ever serve as indicators of source. In fact, the Third Circuit has stated, "[P]roduct configurations in general are not reliable as source indicators. . . ." *Versa Products*, 50 F.3d at 201.

The purpose of the 1996 Federal Anti-Dilution Act is to remove the trademark owner's burden, if the trademark is "famous," of proving a likelihood of public confusion when the accused defendant's goods are *not* competitive with the plaintiff's goods — *e.g.*, "COCA-COLA" as used on cars. When considering an alleged product configuration trademark (*i.e.*, where the alleged

mark is *the product itself* rather than a symbol), it is hard to conceive of circumstances in which the "mark" would ever be used on goods which are non-competitive. Therefore, it is inappropriate to apply the Federal Anti-Dilution Act to alleged product configuration trademarks.

CONCLUSION

In conclusion, West Bend respectfully asks the Court to accept this Petition for a Writ of *Certiorari* and grant *certiorari* in this case.

Respectfully submitted,

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APPENDIX

APPENDIX A — OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE FIFTH CIRCUIT FILED SEPTEMBER 15, 1997

IN THE UNITED STATES COURT OF APPEALS
FOR THE FIFTH CIRCUIT

No. 96-60413
No. 96-60540

SUNBEAM PRODUCTS, INC.,

Plaintiff-Appellee,

VERSUS

THE WEST BEND COMPANY,

Defendant-Appellant.

Appeals from the United States District Court
for the Southern District of Mississippi

Before JOLLY, SMITH, and DENNIS, Circuit Judges.

JERRY E. SMITH, Circuit Judge:

The West Bend Company challenges a preliminary injunction entered pursuant to the Lanham Act, 15 U.S.C. § 1125(a). Finding no reversible error, we affirm.

I.

Sunbeam Products, Inc. ("Sunbeam"), sued The West Bend Company ("West Bend"), requesting injunctive relief to bar West

Bend from manufacturing and marketing a stand mixer, Model No. 41012 ("West Bend Mixer #1"). The complaint alleged that West Bend Mixer #1 unlawfully replicated the product configuration of a stand mixer made by Sunbeam, the "American Classic Mixmaster®," Model No. 2360.

Sunbeam alleged that the manufacture and sale of West Bend Mixer #1 violated the Lanham Act, 15 U.S.C. § 1125(a); the Federal Trademark Dilution Act of 1995, 15 U.S.C. § 1125(c); and the common law of unfair competition, trade dress infringement, dilution, and false and misleading advertising. To demonstrate that West Bend had unlawfully replicated its product configuration, Sunbeam identified six "key design features" in the American Classic Mixmaster® that, when taken in combination, allegedly distinguish the Sunbeam mixer from all other commercially available stand mixers:

(1) a distinctive "torpedo-shaped" housing configuration with a rounded rear-mounted speed control dial that conforms to the shape of the housing;

(2) a distinctive handle attached to the front of the housing that arches over the housing and terminates in the space above the housing;

(3) a distinctive beater-eject button located on the left side of the housing beneath the handle;

(4) a distinctive "tear-drop shaped" face plate on the front of the housing;

(5) a distinctive horizontal stripe or groove along the side of the housing; and

(6) a distinctive combination of black and white features.

The district court granted a temporary restraining order ("TRO") on April 12, 1996, enjoining West Bend from marketing any products embodying the Mixmaster® product design trademark or similar designs or using any other mark or device likely to dilute the distinctive quality of the Mixmaster® product design and the Sunbeam trademark. In particular, the court enjoined West Bend from marketing West Bend Mixer #1, or displaying it at a pending Gourmet Show in San Francisco on May 4-8, 1996. West Bend filed a motion to quash the TRO, leading the court to dissolve it on April 16, 1996. Nevertheless, the court set a hearing for April 30 to consider the motion for preliminary injunction.

Following the hearing, the court granted Sunbeam's request for a preliminary injunction on May 3, 1996, reinstating the injunction against West Bend Mixer #1. The preliminary injunction substantially reinstated the terms of the TRO.

West Bend filed an emergency motion to clarify the injunction, proposing an alternative design for the mixer ("West Bend Mixer #2"). On May 6, the court ruled that West Bend Mixer #2 also violated the Sunbeam trademark and was likewise prohibited by the preliminary injunction, but the court suggested that West Bend could escape the injunction by modifying the speed control dial.[1] The court modified the terms of the preliminary injunction to reflect this ruling on May 14.

1. In addition, the court required West Bend to make two future modifications: (1) eliminate the "middle-up arced" handle curvature by August 31, 1996; and (2) remove and redesign the face plate by December 31, 1996.

Appendix A

West Bend redesigned the stand mixer in an effort to comply, and the new design ("West Bend Mixer #3") was presented to the court on May 13-14. On May 14, the court further modified the terms of the preliminary injunction to bar West Bend Mixer #3. The court approved a design incorporating additional modifications, which subsequently was marketed by West Bend ("West Bend Mixer #4"). The most prominent difference between West Bend Mixer #3 and #4 was the elimination of mixing speed terms from the speed control dial (e.g., "mix," "beat," "stir," and "blend").

Finally, on May 23, the court entered an order and findings summarizing the scope of the preliminary injunction. West Bend filed a notice of appeal from the preliminary injunction, the two orders modifying it, and the final order and findings.

On July 31, 1996, West Bend submitted to the district court its design for the next generation of mixers ("West Bend Mixer #5"). On August 6, the court ruled that West Bend Mixer #5 was prohibited by the preliminary injunction, but approved a design that incorporated the nondescript speed control dial of Mixer #4 ("West Bend Mixer #6").

On August 12, West Bend filed a notice of appeal from the August 6 order, and the cases were consolidated. We have jurisdiction over these cases under 28 U.S.C. § 1292(a)(1), which authorizes interlocutory appeal from preliminary injunctions.

II.

A preliminary injunction is an extraordinary equitable remedy that may be granted only if the plaintiff establishes four

elements: (1) a substantial likelihood of success on the merits; (2) a substantial threat that the movant will suffer irreparable injury if the injunction is denied; (3) that the threatened injury outweighs any damage that the injunction might cause the defendant; and (4) that the injunction will not disserve the public interest. *See Blue Bell Bio-Medical v. Cin-Bad, Inc.*, 864 F.2d 1253, 1256 (5th Cir. 1989). These four elements are mixed questions of law and fact. Accordingly, we review the factual findings of the district court only for clear error, but we review its legal conclusions *de novo*. Likewise, although the ultimate decision whether to grant or deny a preliminary injunction is reviewed only for abuse of discretion, a decision based on erroneous legal principles is reviewed *de novo*. *Id.*[2]

III.

The Lanham Act, 15 U.S.C. § 1125(a), creates a cause of action for trade dress infringement, analogous to the common law cause of action for unfair competition. "Trade dress" refers to the total image and overall appearance of a product. Blue Bell, 864 F.2d at 1256.[3] The protection of trade dress is tantamount to trademark protection:

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2. *See also Falcon Rice Mill, Inc. v. Community Rice Mill, Inc.*, 725 F.2d 336, 344 (5th Cir. 1984) ("If the trial court misapplies the governing legal standards, however, the 'clearly erroneous' standard is inapplicable.").

3. "Trade dress" may include features such as the size, shape, color, color combinations, textures, graphics, and even sales techniques that characterize a particular product. *See Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 764 n.1 (1992) (citing *John H. Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966, 980 (11th Cir. 1983)). Accordingly, the inquiry does not focus on isolated elements

(Cont'd)

> Protection of trade dress, no less than of trademarks, serves the Act's purpose to "secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers. National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance of quality by securing to the producer the benefits of a good reputation."

Two Pesos, 505 U.S. at 774 (citations omitted).[4]

To demonstrate an unlawful trade dress infringement, the plaintiff must first establish that the trade dress qualifies for trade dress protection. This inquiry encompasses three issues: (1) distinctiveness, (2) secondary meaning, and (3)

(Cont'd)
of the dress, but on whether a combination of features creates a distinctive visual impression, identifying the source of the product. *Falcon Rice Mill*, 725 F.2d at 346; *accord Taco Cabana Int'l, Inc. v. Two Pesos, Inc.*, 932 F.2d 1113, 1118-19 (5th Cir. 1991), *aff'd*, 505 U.S. 763 (1992). Thus, "[t]he whole, in trademark law, is often greater than the sum of its parts." *Association of Coop. Members, Inc. v. Farmland Indus., Inc.*, 684 F.2d 1134, 1140 (5th Cir. 1982); *accord Taco Cabana*, 932 F.2d at 1120.

4. Accordingly, because the Lanham Act "provides no basis for distinguishing between trademark and trade dress," *Two Pesos*, 505 U.S. at 773, the test for trade dress protection is identical to that for trademark protection. "[T]he protection of trademarks and trade dress under § 43(a) serves the same statutory purpose of preventing deception and unfair competition. There is no persuasive reason to apply different analysis to the two." *Id.*

functionality.[5] If the court concludes that the trade dress is protected, the plaintiff must demonstrate that it has been infringed. "Infringement occurs only when there is a likelihood of confusion between the products of the plaintiff and the defendant." *Blue Bell*, 864 F.2d at 1256; *accord Taco Cabana*, 932 F.2d at 1118-19.

To establish that the product configuration of the American Classic Mixmaster® merits trademark protection, therefore, Sunbeam must demonstrate that the product configuration is either inherently distinctive or has acquired a secondary meaning, and that this distinctive product configuration is not functional. If a trade dress is functional, it does not merit protection, even if it is inherently distinctive or has acquired secondary meaning. *Two Pesos*, 505 U.S. at 775.[6] If the product configuration of the

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5. To warrant protection under the Lanham Act, a particular mark or product characteristic must distinguish the product from products manufactured by others. *See Two Pesos*, 505 U.S. at 768. Some marks are "inherently distinctive" and automatically entitled to trademark protection. Others, however, are not inherently distinctive, but are merely descriptive of a certain product. Nevertheless, even marks that are not inherently distinctive may become uniquely associated with a particular source, thereby acquiring a "secondary meaning." *Id.* at 766 n.4. "The general rule regarding distinctiveness is clear: An identifying mark is distinctive and capable of being protected if it *either* (1) is inherently distinctive *or* (2) has acquired distinctiveness through secondary meaning." *Id.* at 769.

Secondary meaning entitles a mark or trade dress to trademark protection, despite the absence of an inherently distinctive characteristic. Accordingly, a plaintiff need not demonstrate that a product has acquired a secondary meaning if the mark is inherently distinctive, thereby entitling it to protection *per se*. *Id.* at 773-74.

6. "[A] design is legally functional, and thus unprotectible, if it is

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Appendix A

American Classic Mixmaster® warrants trade dress protection, Sunbeam also must demonstrate a likelihood of confusion, in order to prevail on its claim of trade dress infringement under the Lanham Act.

A.

As a threshold matter, we must determine whether the product configuration of the American Classic Mixmaster® merits protection, either because the product configuration is inherently distinctive or because it has acquired a secondary meaning. We now examine these various considerations.

1.

For purposes of trademark law, marks or product features traditionally have been arranged into five categories: (1) generic, (2) descriptive, (3) suggestive, (4) arbitrary, and (5) fanciful. *Two Pesos*, 505 U.S. at 768.[7] This hierarchy determines the

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one of a limited number of equally efficient options available to competitors and free competition would be unduly hindered by according the design trademark protection." *Two Pesos*, 505 U.S. at 775. " '[A] product feature is functional,' and cannot serve as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.' " *Qualitex Co. v. Jacobson Prods. Co.*, 514 U.S. 159, 165 (1995) (quoting *Inwood Lab., Inc. v. Ives Lab., Inc.*, 456 U.S. 844, 850 n.10 (1982)).

7. *See also Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4, 9 (2d Cir. 1976) (defining these five categories for purposes of trademark law). Although these classifications were first coined
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degree of trademark protection to which a given mark is entitled. The latter three categories are considered inherently distinctive, "because their intrinsic nature serves to identify a particular source of a product." *Id.*

In contrast, marks that are merely descriptive of a product are not considered inherently distinctive, "because they do not inherently identify a particular source." *Id.* at 769. Accordingly, descriptive marks are entitled to protection only if they have come to be uniquely associated with a particular source, thereby acquiring a "secondary meaning." *Id.* at 766 n.4. Finally, generic marks are not protected under any circumstances, because they refer not to a particular product or manufacturer, but solely to "the genus of which the particular product is a species." *Id.* at 768 (quoting *Park 'N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 U.S. 189, 194 (1985)).

As this hierarchy illustrates, the essence of a protected mark is its capacity to distinguish a product and identify its source. The gravamen of trademark law is source identification. Therefore, a given mark or trade dress is "inherently distinctive" only if it is "sufficiently distinctive of itself to identify the

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in the context of trademark law, they have also been applied to cases involving trade dress. *See Two Pesos*, 505 U.S. at 773 (approving the application of the *Abercrombie* classifications to trade dress litigation); *Chevron Chem. Co. v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695, 702 (5th Cir. Unit A Oct. 1981) (holding that the same principles that govern trademark law should apply to trade dress litigation). "Thus, a trade dress feature is distinctive if it is arbitrary or fanciful, and not descriptive or functional. Functional features cannot be protected, and merely descriptive features must have acquired secondary meaning before qualifying for protection." *Sicilia Di R. Biebow & Co. v. Cox*, 732 F.2d 417, 426 (5th Cir. 1984).

producer." *Chevron*, 659 F.2d at 702; *accord Sicilia Di R. Biebow*, 732 F.2d at 426. "Trade dress is inherently distinctive when, by its 'intrinsic nature,' it identifies the particular source of the product." *Imagineering, Inc. v. Van Klassens, Inc.*, 53 F.3d 1260, 1263-64 (Fed. Cir.), *cert. denied*, 116 S. Ct. 277 (1995).[8]

Insofar as product configurations are fundamentally different from trademarks and trade dress, there is some question whether a product configuration can ever be deemed "inherently distinctive." *See Duraco Prod., Inc. v. Joy Plastic Enter.*, 40 F.3d 1431, 1445-46 (3rd Cir. 1994).[9] Unlike traditional

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8. "If a mark or dress serves as a symbol of origin it is considered distinctive and protectable. Unless a mark or dress is deemed 'inherently' or 'sufficiently' distinctive, however, secondary meaning must be established." *Sno-Wizard Mfg. v. Eisemann Prod. Co.*, 791 F.2d 423, 425 n.2 (5th Cir. 1986); *accord Taco Cabana*, 932 F.2d at 1119-20. *See also Duraco Prods.*, 40 F.3d at 1442 (explaining that "inherently distinctive trade dress is protected because presumptively it primarily identifies the product's source").

9. Although product configurations technically are regarded as trade dress, critics distinguish product configurations and designs from product packaging, which is more closely associated with traditional trademark law. *See, e.g., Knitwaves, Inc. v. Lollytogs Ltd.*, 71 F.3d 996, 1007-08 (2d Cir. 1995); *Duraco Prods.*, 40 F.3d at 1448; *see also Landscape Forms, Inc. v. Columbia Cascade Co.*, 113 F.3d 373, 378-79 (2d Cir. 1997) (discussing the *Knitwaves* interpretation); RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 16 cmt. b (1995).

> Product packaging designs, like trademarks, often share membership in a practically inexhaustible set of distinct but approximately equivalent variations, and an

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trademarks and trade dress, which function primarily to identify the source of a given product, the primary purpose of product configuration is not identification. Accordingly, as the Third Circuit stated, "one cannot automatically conclude from a product feature or configuration—as one can from a product's arbitrary name, for example—that, to a consumer, it functions primarily to denote the product's source." *Id.* at 1441.[10]

Hence, some commentators have suggested that product configurations can never be considered "inherently distinctive."[11]

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> exclusive right to a particular overall presentation generally does not substantially hinder competition in the packaged good, the item in which a consumer has a basic interest. A product configuration, contrariwise, commonly has finite competitive variations that, on the whole, are equally acceptable to consumers.

Duraco Prods., 40 F.3d at 1448. *But see Stuart Hall Co. v. Ampad Corp.*, 51 F.3d 780, 787-88 (8th Cir. 1995) (criticizing the distinction between product packaging and product configuration for purposes of trade dress law).

10. An arbitrary or fanciful mark or dress is presumed, as a matter of law, to achieve consumer recognition immediately upon its adoption and use, because the primary function of the mark or dress is source identification. In contrast, a product configuration cannot generally warrant a presumption of identification, "as consumers usually appreciate a product's configuration for its contribution to the inherent appeal of the product, not (in the absence of secondary meaning) its signifying function." *Duraco Prods.*, 40 F.3d at 1441.

11. *See* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 16 cmt. b (1995) (noting that product designs are not ordinarily considered

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Nevertheless, we need not reach this controversial question in the instant case, because the product configuration of the American Classic Mixmaster® has acquired a secondary meaning.

2.

Assuming *arguendo* that the unique product configuration of the American Classic Mixmaster® cannot be deemed inherently distinctive, the district court did not err in concluding that it has acquired secondary meaning, for purposes of the preliminary injunction test. A mark or product feature has acquired secondary meaning if it "has come through use to be uniquely associated with a specific source." *Two Pesos*, 505 U.S. at 766 n.4; *accord* RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 13 cmt. e (1995). The determination that a feature has acquired secondary meaning is a finding of fact, which we review for clear error. *Sno-Wizard*, 791 F.2d at 427.

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inherently distinctive and may be protected only upon proof of secondary meaning); J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 8.12 (4th ed. 1997) (collecting conflicting authorities). Indeed, this court has also suggested that a product configuration cannot be inherently distinctive. *See Sicilia Di R. Biebow*, 732 F.2d at 426 n.7 ("*Unlike a product's configuration*, which may acquire trademark value over time and by exposure to consumers, arbitrary and nonutilitarian trade dress or packaging usually is designed to act immediately as an identifier of source.") (emphasis added). *But see Two Pesos*, 505 U.S. at 772-75 (assuming *arguendo* that a product configuration may be inherently distinctive); *Duraco Prods.*, 40 F.3d at 1446 (noting that *Two Pesos* must be read as "giving an imprimatur to finding trade dress in a product configuration to be inherently distinctive under certain narrow circumstances"); *Sicilia Di R. Biebow*, 732 F.2d at 425 n.3 ("The same [distinctiveness] principles apply in the context of trade dress, although selection is from designs and configurations, not words.").

Appendix A

Because the primary element of secondary meaning is " 'a *mental association* in buyer's minds between the alleged mark and a single source of the product,' " the determination whether a mark or dress has acquired secondary meaning is primarily an empirical inquiry. *Sicilia Di R. Biebow*, 732 F.2d at 425 n.4 (citation omitted). This court has expressly stated, and the Supreme Court has agreed, that the gravamen of the secondary meaning determination is " 'the empirical question of current consumer association.' " *Taco Cabana*, 932 F.2d at 1120 n.7 (quoted in *Two Pesos*, 505 U.S. at 770). Accordingly, survey evidence is the most direct and persuasive evidence of secondary meaning. *Sno-Wizard*, 791 F.2d at 427.[12] In the instant case, Sunbeam introduced no survey evidence to prove that the "key design features" of the American Classic Mixmaster® have acquired secondary meaning.[13]

To compensate for the absence of empirical survey evidence, Sunbeam proffered a variety of evidence to show secondary meaning. We have recognized that consumer surveys are not the only evidence relevant to the determination of

12. "To establish secondary meaning, a manufacturer must show that, *in the minds of the public*, the primary significance of a product feature or term is to identify the source of the product rather than the product itself." *Inwood Lab.*, 456 U.S. at 851 n.11 (1982) (emphasis added).

13. Sunbeam explains that the district court proceedings were conducted with a sense of urgency, as a result of the impending Gourmet Show in San Francisco. Therefore, Sunbeam did not have time to compile survey data to prove its case. While this explanation would not excuse the omission of empirical data at trial, it is precisely the sort of contingency that the lower burden of proof governing preliminary injunctions is intended to accommodate, as this case illustrates.

secondary meaning. In addition, the court may consider the length and manner of the use of a mark, the nature and extent of advertising and promotion of the mark, the sales volume of the product, and instances of actual confusion. *See Bank of Tex. v. Commerce Southwest, Inc.*, 741 F.2d 785, 787 (5th Cir. 1984). Nevertheless, the ultimate determination whether a particular mark or dress has acquired secondary meaning remains an empirical question of consumer association. *See id.* at 787-89.

In support of its claim, Sunbeam offered evidence documenting the evolution of the American Classic Mixmaster®, consumer testimonials, and the sales and marketing history of Sunbeam stand mixer designs, contending that this product pedigree warrants a presumption of secondary meaning. While this evidence is relevant to the inquiry, it does not establish the requisite consumer association between the product configuration of the American Classic Mixmaster® and the source of the product.

In concluding that the American Classic Mixmaster® has acquired secondary meaning, the district court relied solely on the pedigree of the current model. Noting that the American Classic Mixmaster® has evolved from stand mixers marketed by Sunbeam since 1930, the court inferred that the design has acquired secondary meaning.

Evidence of long use is insufficient to prove secondary meaning, however, without empirical proof that the design "has come through use to be uniquely associated with a specific source." *Two Pesos*, 505 U.S. at 766 n.4.[14] The district court erred by assuming that the long and distinguished pedigree of the American

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14. *See also Bank of Tex.*, 741 F.2d at 788 (disavowing that "length of time alone is sufficient to establish secondary meaning").

Classic Mixmaster®, without more, is sufficient to demonstrate secondary meaning.[15]

Were this case presented for review following final judgment, we would be constrained to hold that Sunbeam had not demonstrated that the American Classic Mixmaster® has acquired secondary meaning entitling its product configuration to trade dress protection. Review of a preliminary injunction is more circumscribed, however.

To be entitled to a preliminary injunction, Sunbeam need only show "a substantial likelihood of success on the merits." In this case, the distinction is dispositive. While the evidence upon which the district court relied would not be sufficient to support a judgment of trade dress infringement warranting final injunctive relief, we conclude that it is sufficient to warrant a preliminary injunction.

The general principles qualifying a mark or trade dress for registration as a trademark, under the registration provisions of the Lanham Act, are likewise applicable to the determination whether an unregistered mark is entitled to trademark protection.

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15. This is particularly true where, as here, the alleged secondary meaning is founded upon a product configuration, rather than upon a traditional mark or dress, because "consumers do not associate the design of a product with a particular manufacturer as readily as they do a trademark or product packaging trade dress." *EFS Mktg., Inc. v. Russ Berrie & Co.*, 76 F.3d 487, 491 (2d Cir. 1996); *see also Duraco Prods.*, 40 F.3d at 1448 (opining that "a consumer is substantially more likely to trust a product's packaging, rather than its configuration, as an indicium of source"). Therefore, the mere fact that a certain product configuration has a long pedigree does not warrant a presumption of secondary meaning.

See Two Pesos, 505 U.S. at 768. The Lanham Act permits the registration of marks that have acquired a secondary meaning, and states that

> [t]he Commissioner may accept as prima facie evidence that the mark has become distinctive, as used on or in connection with the applicant's goods in commerce, proof of substantially exclusive and continuous use thereof as a mark by the applicant in commerce for the five years before the date on which the claim of [acquired] distinctiveness is made.

15 U.S.C. § 1052(f).

This statutory presumption is relevant to the instant case. The district court concluded that the external appearance of the American Classic Mixmaster® has not changed in over seventeen years and found that the other mixers on the market do not "even closely resemble the overall appearance of the Sunbeam Mixmaster® mixer." This finding of fact is not clearly erroneous and is sufficient to demonstrate "substantially exclusive and continuous use" of the "key design features" ascribed to the American Classic Mixmaster®.[16]

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16. This finding obviates West Bend's claim that the "key design features" of the American Classic Mixmaster® have changed over the long life of the product, and that other manufacturers have used the same features in competing products. It is undisputed that the "key design features" of the American Classic Mixmaster® have remained constant since 1979, and the district court found that no competing manufacturer has adopted an identical product configuration during this period. This evidence is sufficient to show "substantially exclusive and continuous use," for purposes of the Lanham Act, and is prima facie evidence of secondary meaning.

Therefore, the district court was entitled to accept this evidence as prima facie evidence of secondary meaning. 15 U.S.C. § 1052(f); *Stuart Hall Co.*, 51 F.3d at 789. Under these circumstances, although the evidence is not conclusive, Sunbeam has demonstrated a substantial likelihood of success on the merits of its trade dress infringement claim.

B.

Having concluded that the unique product configuration of the Sunbeam American Classic Mixmaster® has acquired secondary meaning, we must determine whether that product design is functional. If a product characteristic is functional, it is not entitled to trade dress protection. *See Two Pesos*, 505 U.S. at 775. The functionality doctrine is the great countervailing factor in trademark law, balancing the interest in facilitating innovation against the interest in fostering competition in the free market. "The doctrine acts to separate those configurations that may be protected as property rights or trademarks and those designs that the law will not permit any person to appropriate or monopolize." *Sicilia Di R. Biebow*, 732 F.2d at 422.

Accordingly, this court has adopted the "utilitarian" standard of functionality, which focuses on the protection of competition. "The ultimate inquiry concerning functionality," we have explained, "is whether characterizing a feature or configuration as protected 'will hinder competition or impinge upon the rights of others to compete effectively in the sale of goods.' " *Id.* at 429 (quoting *In re Morton-Norwich Prods., Inc.*, 671 F.2d 1332, 1342 (C.C.P.A. 1982)). In order to be classified as a "functional" characteristic, therefore, a product design or feature must be "superior or optimal in terms of engineering, economy

of manufacture, or accommodation of utilitarian function or performance." *Id.*[17]

The Supreme Court has placed its imprimatur on this standard, observing "a design is legally functional, and thus unprotectible, if it is one of a limited number of equally efficient options available to competitors and free competition would be unduly hindered by according the design trademark protection." *Two Pesos*, 505 U.S. at 775 (citing *Sicilia*). In a subsequent decision, the Court further observed that " 'a product feature is functional,' and cannot serve as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.' " *Qualitex Co. v. Jacobson Prod. Co.*, 514 U.S. at 165 (1995) (quoting *Inwood Labs.*, 456 U.S. 844, 850 n.10 (1982)).[18]

The district court did not err in concluding that the product configuration of the American Classic Mixmaster® is not functional and thus is entitled to protection. For purposes of this analysis, we must distinguish the isolated components of the product from the trade dress, or "total image," of the American Classic Mixmaster®. Even if a product design incorporates certain functional features, we have held that "a particular arbitrary combination of functional features, the combination of which is not itself functional, properly enjoys protection." *Taco Cabana*, 932 F.2d at 1119.

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17. We have specifically applied the utilitarian standard in the context of product configuration litigation. *See Sno-Wizard*, 791 F.2d 423, 426 n.3 (5th Cir. 1986) (citing *Sicilia Di R. Biebow*).

18. This utilitarian theory of functionality, with its focus on competition, lowers the threshold for trade dress protection. "A design that merely assists in a product or configuration's utility is not functional and may therefore be protected." *Sicilia Di R. Biebow*, 732 F.2d at 429.

Notwithstanding this principle, West Bend argues that Sunbeam may not obtain trade dress protection for a product configuration that includes functional features. This is manifestly not the law. To the contrary, we previously have characterized this argument as a "fallacious syllogism," belied by the principle that an arbitrary combination of functional features may be non-functional. *Id.*[19]

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19. The case West Bend cites for this proposition, *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995), is plainly distinguishable from this case. First, *Elmer* concerns a trade dress claim in which every element was functional; as Sunbeam notes, while some features of the American Classic Mixmaster® might be functional, others plainly are not (e.g., color combinations, aesthetic handles). This distinction is critical, as the trade dress of a product entails its "total image" and "overall appearance." *Blue Bell*, 864 F.2d at 1256.

Second, the trade dress in *Elmer* was coextensive with a utility patent, which incorporated every element of the trade dress. Under these circumstances the Federal Circuit feared that trade dress protection would effectively extend the life of the patent after its formal expiration. *See Elmer*, 67 F.3d at 1580. In contrast, the trade dress claim in the instant case entails a combination of several features, with individual utility patents granted to certain features. In this regard, the principle that trade dress is the "total image" of a product, rather than its isolated components, is dispositive. Unlike the situation in *Elmer*, granting trade dress protection to the arbitrary product configuration of the American Classic Mixmaster® would not restrict any competitors from copying the individual functional features after the individual utility patents have expired, but would simply prohibit competitors from copying the arbitrary combination of features embraced in the American Classic Mixmaster®. Hence, there is no conflict between patent law and trademark law in the instant case.

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Likewise, the fact that the American Classic Mixmaster® incorporates functional features named in utility patents does not compel the conclusion that the product configuration is legally functional. Insofar as the trade dress of a product entails its "total image" and "overall appearance," *Blue Bell*, 864 F.2d at 1256, an arbitrary combination of functional features may nevertheless be non-functional for purposes of trade dress protection.[20] Therefore, West Bend's arguments are without merit.

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Finally, the proposition that a unique combination of functional features is functional *per se*, despite the absence of any adverse effect on competition, is incompatible with the utilitarian functionality doctrine of the Fifth Circuit. It is also flatly inconsistent with the established rule that a particular arbitrary combination of functional features, the combination of which is not functional, is entitled to trade dress protection. *See Taco Cabana*, 932 F.2d at 1119.

20. Furthermore, the mere fact that a feature is named in a utility patent does not automatically render it functional. Many non-functional configurations are incidentally included in utility patents. *Dogloo, Inc. v. Doskocil Mfg. Co.*, 893 F. Supp. 911, 919 (C.D. Cal. 1995).

Even if the product configuration of the American Classic Mixmaster® was incidentally illustrated in the utility patents, therefore, this does not compel the conclusion that the design is functional. "[A] utility patent must be examined in detail to determine whether the disclosed configuration is really primarily functional or just incidentally appears in the disclosure of a patent. There is no doubt that many non-functional shapes and configurations happen to be described or pictured as an incidental detail in functional patents." J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 7:89 (4th ed. 1997). We conclude that the product

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Appendix A

The district court acknowledged that, when viewed in isolation, certain "key design features" of the American Classic Mixmaster® might be considered functional. Nevertheless, the court found that "the particular combination of functional features and the way they are arranged and packaged" warranted the conclusion that the "overall shape and configuration is non-functional." Accordingly, the court properly focused its inquiry on the trade dress, rather than on the isolated components of the product configuration. *See Taco Cabana*, 932 F.2d at 1118-19.

Protection of the arbitrary combination of features comprising the American Classic Mixmaster® would not frustrate competition. West Bend has presented no evidence demonstrating that the product configuration of Model No. 2360 is optimal in terms of engineering, economy of manufacture, or accommodation of utilitarian function.

To the contrary, Sunbeam observes that several other manufacturers compete successfully in the stand mixer market without pirating the unique product configuration of the American Classic Mixmaster®. Therefore, protection of the Sunbeam design would not impinge upon the rights of others to compete effectively in the sale of goods, the litmus test of functionality. *See Sicilia Di R. Biebow*, 732 F.2d at 429. Consequently, insofar as there are equally efficient options available to competitors, and free competition would not be unduly harmed by according the product configuration trademark protection, the district court did not err in concluding

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configuration of the American Classic Mixmaster® is not a functional part of the utility patents but appears only in incidental detail, without significance for trademark law.

that the design of the American Classic Mixmaster® is not functional. *See Two Pesos*, 505 U.S. at 775.

C.

Finally, having determined that the American Classic Mixmaster® is entitled to trade dress protection, we must determine whether that trade dress has been infringed by the West Bend stand mixers. "Infringement occurs only when there is a likelihood of confusion between the products of the plaintiff and the defendant." *Blue Bell*, 864 F.2d at 1256. Likelihood of confusion is a question of fact, which we review for clear error. *Id.* at 1259-60; *Sicilia Di R. Biebow*, 732 F.2d at 430.

In determining the likelihood of confusion, the district court must apply the "digits of confusion" test. The factors to be weighed in this calculus include (1) similarity of the two products; (2) identity of retail outlets and purchasers; (3) identity of advertising media; (4) strength of the trademark or trade dress; (5) intent of the defendant; (6) similarity of design; (7) actual confusion; and (8) degree of care employed by consumers. *See Blue Bell*, 864 F.2d at 1259-60; *Sno-Wizard*, 791 F.2d at 428. Proof of actual confusion is not a prerequisite, and no single factor is dispositive of the likelihood of confusion. *Taco Cabana*, 932 F.2d at 1122 n.9.

The district court weighed all eight factors and found that there is a substantial likelihood of confusion between the mixers. On appeal, West Bend challenges the weight accorded three factors in this analysis, arguing that they disprove any risk of confusion. The conclusions of the district court are not clearly erroneous.[21]

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21. West Bend does not dispute that the first four factors in this calculus support the findings: (1) The two products are identical; (Cont'd)

Appendix A

1.

The district court concluded that West Bend had intentionally copied the product configuration of the American Classic Mixmaster®. The intent of the defendant is a " 'critical factor, since if the mark was adopted with the intent of deriving benefit from the reputation of [the plaintiff,] *that fact alone may be sufficient to justify the inference that there is confusing similarity.*' " *Chevron*, 659 F.2d at 703-04 (quoting *Amstar Corp. v. Domino's Pizza, Inc.*, 615 F.2d 252, 263 (5th Cir. 1980)).[22]

West Bend objects to this characterization of the evidence, arguing that there is no evidence of intent to derive benefit from the Sunbeam reputation. Direct evidence is unnecessary, however; impermissible intent may be inferred from the fact that a defendant plagiarized the trade dress of a product. *See Chevron*, 659 F.2d at 704.

After considering the evidence, the district court found that

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(2) the products are marketed to the same consumers through the same retailers; (3) the two companies use the same advertising media to market their products; and (4) the American Classic Mixmaster® enjoys a "strong" distinctive trade dress. Even a "weak" trade dress may be protected within its own product line, moreover, thereby warranting injunctive relief in the instant case. *See Taco Cabana*, 932 F.2d at 1120. Finally, although Sunbeam introduced no evidence of actual confusion by consumers, proof of actual confusion is not a prerequisite to injunctive relief. *Id.* at 1122 n.9; *Blue Bell*, 864 F.2d at 1260.

22. *Accord Taco Cabana*, 932 F.2d at 1122 n.11; *Blue Bell*, 864 F.2d at 1259; *Sno-Wizard*, 791 F.2d at 428.

"there has been no other plausible explanation presented by the Defendant for the virtual replication of the Plaintiff's Mixmaster® mixer," and inferred that West Bend had intended to imitate the American Classic Mixmaster® and thereby benefit from the consumer goodwill associated with Sunbeam mixers. This circumstantial inference is corroborated by direct evidence: West Bend submitted a picture of the American Classic Mixmaster® to its manufacturer in China, directing his attention to "this one."[23] The court was entitled to infer that West Bend intended to copy the American Classic Mixmaster® and usurp consumer goodwill, and this finding of fact is not clearly erroneous.

Granted, the defendant's intent is only one element in the likelihood-of-confusion inquiry, and intent alone is not sufficient to establish trade dress infringement. *See Blue Bell*, 864 F.2d at 1258-59. Nevertheless, it is firmly established that a finding of intent may support an inference of consumer confusion. *Id.* at 1259.

Moreover, the evidence of intent does not stand alone in the instant case, but is corroborated by several other factors. Finally, the proper weighing of the relevant factors is left to the district court. *Id.* The district court was entitled to find that West Bend intentionally copied the design of the American Classic Mixmaster®, and it reasonably could infer a likelihood of confusion from this unlawful intent.

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23 Indeed, in addition to the photograph of the American Classic Mixmaster®, West Bend included a marked-up copy of the product description accompanying the Sunbeam mixer, altering the product specifications and replacing references to Sunbeam with references to West Bend. This plagiarism supports the inference that West Bend used the American Classic Mixmaster® as a template for its mixers.

Appendix A

2.

West Bend criticizes the district court for its holistic view of the similarities between the American Classic Mixmaster® and the West Bend mixers, arguing that the court should have considered the "key design features" of the mixers to determine whether there was a likelihood of confusion between the two product configurations. Once again, West Bend ignores the fact that the trade dress of a product is comprised of its "total image" and "overall appearance," not isolated components. *Blue Bell*, 864 F.2d at 1256.

In particular, for purposes of the likelihood of confusion inquiry, the courts must consider the overall trade dress of the product. "[I]t is the 'combination of features as a whole rather than a difference in some of the details which must determine whether the competing product is likely to cause confusion in the mind of the public.' " *Chevron*, 659 F.2d at 704 (citations omitted). Accordingly, the district court did not err in concluding that the similarities in design between the American Classic Mixmaster® and the West Bend mixers created a likelihood of confusion.[24]

3.

Finally, the likelihood of confusion created by similar trade dresses and product configurations may be alleviated by other

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24. West Bend reminds us that it introduced expert testimony to establish that the American Classic Mixmaster® and the West Bend mixers employ a different "form language" and thus bear a different appearance. Nevertheless, the district court did not credit this expert testimony, finding that the two products are "as alike as two peas in a pod." This is a fact issue, and the trier of fact is entitled to choose between two equally permissible views of the evidence. This factual determination is not clearly erroneous.

source indicia, such as manufacturer's labels. *E.g.*, *Blue Bell*, 864 F.2d at 1260; *Sno-Wizard*, 791 F.2d at 428. Particularly in product configuration litigation, where consumers are less likely to rely on the configuration as a source identifier, labels and packaging may eliminate confusion. *See Versa Prods. Co. v. Bifold Co.*, 50 F.3d 189, 203 (3rd Cir.), *cert. denied*, 116 S. Ct. 54 (1995). As the Third Circuit explains, "clarity of labeling in packaging and advertising will suffice to preclude almost all possibility of consumer confusion as to source stemming from the product's configuration." *Id.*

It is uncontested that both the West Bend stand mixers and the Sunbeam American Classic Mixmaster® are labeled with the trademarks of their respective manufacturers. Therefore, West Bend contends that any risk of confusion has been eliminated, as the manufacturer's labels and distinctive packaging distinguish the competing products and allay any fears of consumer confusion. This is particularly true, West Bend argues, because stand mixers are not impulse purchases, but are expensive household appliances; consumers ordinarily exercise a higher degree of care in purchasing such items, thereby reducing the likelihood of consumer confusion. Indeed, in the case of a high-priced, single-purchase article, there is hardly a likelihood of confusion when the name of the manufacturer is openly displayed on a product. *E.g.*, *Blue Bell*, 864 F.2d at 1260; *Sno-Wizard*, 791 F.2d at 428-29.

Nevertheless, although this argument has considerable merit and enjoys substantial support in our precedent, it is insufficient to demonstrate that the district court clearly erred in finding a likelihood of confusion under the unique facts of the instant case. While we have recognized that labels may dispel consumer confusion, under appropriate circumstances, we have never held

that this is an absolute affirmative defense to every trademark infringement claim. To the contrary, we have also observed that the mere labeling of a product will not automatically alleviate a likelihood of confusion, *Sno-Wizard*, 791 F.2d at 429, and the ultimate determination of consumer confusion is a question of fact for the district court.[25]

D.

In conclusion, Sunbeam established a substantial likelihood of success on the merits of its trade dress infringement claim. It introduced sufficient evidence to prove secondary meaning, particularly given the statutory presumption that the substantially continuous and exclusive use of a particular mark or dress for over five years raises an inference of secondary meaning. Accordingly, the district court correctly found that the product configuration of the American Classic Mixmaster® warrants trade dress protection.

Second, the product configuration of the American Classic Mixmaster® is not functional. Notwithstanding the incorporation of certain functional features, the protected trade dress is the

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25. We have never *vacated* a preliminary injunction on the ground that a manufacturer's label alleviated any likelihood of confusion, as a matter of law. In every decision cited to us by West Bend, we *affirmed* preliminary injunctions because the findings of the district courts were not clearly erroneous. *See, e.g., Blue Bell*, 864 F.2d at 1260; *Sno-Wizard*, 791 F.2d at 428-29. Obviously, the proposition that a court *may* conclude that a manufacturer's labels alleviate the risk of consumer confusion is not tantamount to the proposition that the court *must* reach such a conclusion, notwithstanding the other factors mandated under the "digits of confusion" test. Such a rule would eviscerate the district court's role as the finder of fact, and we decline to endorse it as a matter of law.

total image and overall appearance of the American Classic Mixmaster®.

Finally, the district court was entitled to find a likelihood of confusion between the American Classic Mixmaster® and the West Bend mixers. While the use of manufacturers' labels might dispel any confusion, the district court is entitled to evaluate conflicting evidence, and its factual determination regarding the likelihood of confusion is not clearly erroneous. Accordingly, the court did not err in concluding that Sunbeam has shown a substantial likelihood of success on the merits of its trade dress infringement claim, warranting a preliminary injunction under the Lanham Act.

III.

West Bend argues that the preliminary injunction is contrary to the public interest, because trade dress protection for the product configuration of the American Classic Mixmaster® would grant a "permanent patent" on the key design features of the mixer. This alarmist rhetoric is unfounded.

As we have stated, trade dress protection of the "total image" and "overall appearance" of the American Classic Mixmaster® is not tantamount to protection of the isolated functional components, which remain in the public domain absent protection by patent law. Therefore, trade dress protection of the American Classic Mixmaster® protects the whole, which is greater than the sum of its parts. Sunbeam "does not seek protection for individual elements, but for a particular combination of elements which constitute trade dress as a whole." *Taco Cabana*, 932 F.2d at 1119.

Appendix A

The Lanham Act embodies two strong countervailing policies: protection of the proprietary interest in distinctive trademarks, minimizing consumer confusion and maximizing consumer confidence, versus fostering competition and its attendant economic benefits. Trademark law accommodates these countervailing public policies by limiting trademark protection to distinctive, non-functional marks.

In the instant case, therefore, the public interest calculus is subsumed within the merits of the trade dress infringement claim: Because the product configuration of the American Classic Mixmaster® is entitled to trade dress protection, it necessarily follows that the preliminary injunction serves the public interest. Indeed, trade dress protection of the American Classic Mixmaster® will not frustrate competition, but will foster it.

IV.

West Bend attempted to comply with the preliminary injunction by proposing a series of modifications to its original stand mixer. With only two exceptions, the district court rejected these mixers, modifying the preliminary injunction to include the new designs. We need not consider each subsequent design modification in detail, as the district court possesses broad discretion to vindicate the preliminary injunction by prohibiting subsequent modifications that do not move a "safe distance" away from the trademark infringement. "In such a case as this, where the appellants have been found guilty of infringing the trade-mark rights of others, they should thereafter be required to keep a safe distance away from the dividing line between violation of, and compliance with, the injunction." *Eskay Drugs,*

Inc. v. Smith, Kline & French Labs., 188 F.2d 430, 432 (5th Cir. 1951).[26]

The "safe distance" rule vests broad discretion in the district court, to ensure that the Lanham Act is not frustrated by manufacturers who seek to circumvent injunctions with subsequent modifications. Accordingly, the "safe distance" rule permits the court to issue injunctions that sweep even more broadly than the Lanham Act would permit against a manufacturer who has not already been found liable for trademark infringement. " '[A] competitive business, once convicted of unfair competition in a given particular, should thereafter be required to keep a safe distance away from the margin line—even if that requirement involves a handicap as compared with those who have not disqualified themselves.' " *Chevron*, 659 F.2d at 705 (quoting *Broderick & Bascom Rope Co. v. Manoff*, 41 F.2d 353, 354 (6th Cir. 1930)).[27] Having crossed the line of fair competition, a manufacturer may be ordered to stand back from it.

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26. *See also* J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 30.13[1] (4th ed. 1997).

27. *Accord Conan Properties, Inc. v. Conans Pizza, Inc.*, 752 F.2d 145, 154 (5th Cir. 1985) ("When fashioning an injunction in a suit such as this, the court must give careful consideration to the possibility that a defendant found to have either infringed the plaintiff's mark or unfairly competed with the plaintiff will modify his behavior ever so slightly and attempt to skirt the line of permissible conduct. Courts have responded to this problem by issuing broad injunctions that prohibit conduct that clearly infringes the plaintiff's mark as well as conduct that ordinarily would not justify any relief.").

V.

In summary, the district court did not abuse its discretion by issuing the preliminary injunction. The order granting the injunction, accordingly, is AFFIRMED.[28]

28. Given our conclusion that the preliminary injunction was justified under the Lanham Act, we need not consider whether it likewise was warranted under the Federal Trademark Dilution Act, 15 U.S.C. § 1125(c).

APPENDIX B — ORDER GRANTING PRELIMINARY INJUNCTION OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF MISSISSIPPI, HATTIESBURG DIVISION FILED MAY 3, 1996

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF MISSISSIPPI
HATTIESBURG DIVISION

CIVIL ACTION NO. 2:96cv148PS

SUNBEAM PRODUCTS, INC.

PLAINTIFF

VERSUS

THE WEST BEND COMPANY

DEFENDANT

ORDER GRANTING PRELIMINARY INJUNCTION

This matter is before the Court on Motion for Preliminary Injunction filed on behalf of the Plaintiff. The Court, having conducted a hearing and having received evidence on April 30 and May 1, 1996, having reviewed the briefs of counsel, the authorities cited, the pleadings and exhibits on file, and being fully advised in the premises, finds as follows, to-wit;

On April 12, 1996, the Court granted a temporary restraining order without notice to Plaintiff which prevented Defendant from marketing its stand mixer. On April 16, 1996, on

Appendix B

Defendant's emergency motion to quash, the Court dissolved the TRO. By agreement of the parties the Court established a limited and expedited tract for discovery and set the matter for hearing on the request for a preliminary injunction on April 30, 1996.

The Plaintiff's verified complaint alleges a violations of Sections 43(a), (b) and (c) of the Lanham Act, 15 U.S.C. § 1125(a), (b) and (c), common law unfair competition, trade dress infringement, common law dilution and false and misleading advertising. These violations are alleged in regard to the offering for sale of West Bend's new Model 41012 stand mixer which Plaintiff alleges infringes on its Model 2360 Mixmaster® stand mixer. Succinctly, the Plaintiff's Motion for Preliminary Injunction requests the Court to enjoin the Defendant from marketing its stand mixer until a trial on the merits can be conducted.

A preliminary injunction is an extraordinary writ. It should be granted sparingly. In this case two very strong public policies of the United States collide head on. One is the policy of free competition, which is the very backbone of our economic system. The other policy is that a competitor should not unfairly and unlawfully copy the product of another and thus deprive the other of a lawful proprietary interest. This policy finds embodiment in the Lanham Act previously cited.

Sunbeam alleges that it is the first and only company to continuously use, promote and sell a stand mixer having the combination of a white torpedo shape front to rear tapered housing configuration, a black rear mounted tapered speed control, the shape of which conforms to the taper of the housing, a black handle which begins at the front, arches over the back,

and terminates in the space above the white mixer housing, a tear drop shaped chrome face plate and a black beater eject button to the left of the handle.

This case boils down to a question of trade dress violation. Fifth Circuit law in regard to trade dress is fairly clear and unequivocable. Applying that law to the facts of a given case is a more difficult task. This case, because it involves the power to enjoin, reminds one afresh of the responsibility that comes with assuming judicial office. A judge cannot render a decision in a case like this without being cognizant of the power of the pen. While one might be reluctant to use the pen to enjoin, one cannot but recognize that declining to use the pen, declining to issue a preliminary injunction, in an appropriate case is more detrimental, and the exercise of just as much power, as issuing the injunction in an appropriate case.

The Plaintiff in this case had the burden of establishing two things: first, that its protected trade dress has been infringed and secondly, that it is entitled to a preliminary injunction. Each of these issues has its well-established rules.

Although the question is fairly close on two or three sub issues, this Court has concluded that Plaintiff has met its burden of proof both as to protected trade dress violation and its entitlement to a preliminary injunction. Having reaching this conclusion, the Court will explain its rationale.

I. FACTS

In 1930 Sunbeam started manufacturing a stand food mixer which it now calls "the America Classic." This stand mixer is also referred to as a "Mixmaster®" and is denoted as the Model

Appendix B

2360. This stand mixer has had its present design and configuration since 1979 without change. The basic configuration which is now used was developed by Sunbeam in the late 1940s or early 1950s. Prior to 1949-50, the configuration of the Sunbeam mixer was somewhat different, but from 1949-50 forward the basic configuration has been maintained, with some slight evolution or variations between 1949-1950 to 1979. Since 1979 there have been no changes. Sunbeam's sale figures relative to mixers is $22 million annually. Model 2360, the American Classic, is by far the most popular of Sunbeam's mixers accounting for seventy percent of Sunbeam's sales of mixers.

The record indicates that Sunbeam has advertised its product extensively for over sixty years and that there is considerable satisfaction and recognition of the Sunbeam Mixmaster® Model 2360. The record also clearly indicates that none of Sunbeam's present competitors market a mixer that even slightly resembles the configuration of Sunbeam's best selling mixer which is the subject matter of this lawsuit.

In 1994, Defendant West Bend identified the stand food mixer as an attractive new product to be added by West Bend to its array of household appliances. Because of preoccupation with its good selling bread maker, West Bend took no action in regard to the stand food mixer in the year 1994. However, in 1995 West Bend began to move in its efforts to produce and market a stand food mixer. Cesaroni Design Associates, Inc., was employed to produce renderings (concepts) of possible stand mixers to be produced by West Bend. A number of renderings were produced by Cesaroni and provided to West Bend. One of these renderings was strikingly similar to the Kitchen Aid. Two or three of the renderings were strikingly

similar to Sunbeam's Model 2360. West Bend's sellers showed copies of the Cesaroni's renderings to prospective purchasers of the West Bend product. The record indicates that these prospective buyers, especially Wal-Mart, seemed to like the renderings closely resembling the Sunbeam American Classic Model 2360. This rendering was labeled "The Legend." A term very comparable to "the American Classic" despite the fact that West Bend had not continuously manufactured a stand mixer, so could hardly claim its product was a legend.

West Bend employed a manufacturer by the name of Simon Liu, who is the owner of a corporation by the name of Americorp to manufacture its stand mixer in China. William C. Dobson, director of product development for West Bend, obtained from a catalog a copy of a depiction of the Sunbeam Mixmaster® Model number 2360 and transmitted it to Simon Liu. Dobson wrote on the copy of this catalog page the words "Simon, this one" and drew an arrow indicating the Model 2360 of Plaintiff Sunbeam. He also took the wording from the descriptive plate of Plaintiffs Model 2360 and struck through all wording indicating it was manufactured in the United States and by Sunbeam and changed the wording to indicate that it was manufactured by West Bend in China and likewise forwarded this information to Simon Liu. West Bend also indicated to Liu that it did not want to "tool up from ground zero, we need someone with existing tooling."

West Bend claims that Cesaroni developed the final cosmetic design of its mixer, it failed to produce a final rendering from Cesaroni provided to West Bend or Liu, although West Bend in response to a request for relevant documents produced the copy of the catalog page which depicted the Sunbeam Model 2360 with the notation "this one" written in by Dobson. It did not produce a copy of any final rendering by Cesaroni.

Appendix B

Affidavits of Sunbeam's sellers indicate that buyers of their mixers indicated to them that West Bend was going to offer a stand mixer that looked so much like the Sunbeam Mixmaster® Model 2360 that if you covered up the name plate you could not tell the difference between the mixers. These buyers likewise indicated that the West Bend mixer would sell for $20 less than the Sunbeam Mixmaster®.

The Court recognizes that Plaintiff Sunbeam clearly has the burden of proof on all issues relating to trade dress and the issuance of an injunction. However, the Court notes that even after the Court indicated that the testimony of Mr. Dobson would be helpful to determine whether West Bend copied Sunbeam's Model 2360, and indicated that the affidavit provided in regard to the motion for change of venue was insufficient, nevertheless Dobson was not presented and not subjected to cross examination. Cesaroni, the design engineer, was likewise not presented and neither was Simon Liu, the manufacturer, to explain in detail why the West Bend mixer was so similar or why it was necessary for design purposes that it have that particular configuration and design. West Bend did not produce a final rendering of the appearance of the West Bend mixer by Cesaroni.

Testimony by Sunbeam revealed that if West Bend is not enjoined, Sunbeam's Mixmaster® will be sold side by side with the West Bend mixer and that there will be confusion by consumers and that the "look alike" being $20 cheaper would cause Sunbeam to lose millions of dollars in sales and likely to have to lay off workers.

West Bend denies that there will be confusion and states that the fact that its name appears on its product will eliminate

any possibility of confusion. West Bend likewise contends that the design of Sunbeam's mixer is functional and not subject to trade dress protection. West Bend has no manufacturing facilities and no employees to produce its product although it testified that it will lose millions of dollars if it is enjoined from marketing this product. Even though the Court inquired about West Bend's contract with Simon Liu and/or Americorp to determine the relative damages that would be sustained by the parties, this contract was not produced.

It is against this backdrop of facts that this Court must render its decision.

II. APPLICABLE LAW ON PRELIMINARY INJUNCTION

The four elements necessary to prevail on a motion for preliminary injunction are (1) a substantial likelihood of success on the merits; (2) a substantial threat that the movant will suffer irreparable injury if the injunction is not issued; (3) that the threat of injury to the movant outweighs any damage the injunction might cause the opponent; (4) that the injunction will not disserve the public interest. *See Blue Bell Bio-Medical v. Sinbad, Inc.*, 864 F.2d 1253 (5th Cir. 1989). "These items are mixed questions of law and fact." *Id.*

III. APPLICABLE LAW AS TO TRADE DRESS VIOLATION

The United States Supreme Court in two recent cases has addressed the issues of trade dress and trademark infringement. In both instances the Court affirmed the protection of trade dress or trademark, although recognizing the importance of free

competition. The Supreme Court in both cases found that the proprietary interest of the owner of trade dress or trademark was entitled to protection. One of the cases was from the Fifth Circuit. In *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. __, 120 L. Ed. 2d 615, 112 S. Ct. 2753 (1992), the Court held that where the fact finder determined that there an inherently distinctive trade dress, that the owner of the trade dress does not have to further prove that the trade dress has acquired a secondary meaning. In the other case, *Qualitex Company v. Jacobson Products Company. Inc.*, 514 U.S. __, 131 L. Ed. 2d 248, 115 S. Ct. (1995), the Court held that color alone in certain instances can be inherently distinctive and thus subject to being registered as a trademark. It should be remembered that in *Two Pesos* the Court had held that "§ 43(a) provides no basis for distinguishing between trademark and trade dress" 120 L. Ed. 2d at 626. Other prior cases give body to the law relating to trade dress, but these three cases, two from the Supreme Court and the underlying Fifth Circuit opinion in one of these cases embody the law that is controlling in this case. As indicated all three of these cases affirmed the right of a proprietor of a trade dress or trademark to be entitled to protection.

It is universally recognized that a competitor cannot copy and market an item protected by a patent or trademark of another. Under the Lanham Act a competitor cannot copy and market the trade dress of another. Trade dress is very similar to trademark. Ordinarily if a configuration of a product is subject to registration under trademark law, it is subject to being protected under trade dress.

The "Trade Dress" of a product is essentially its total image and overall appearance. *Falcon Rice Meal v. Community Rice Meal*, 725 F.2d 336, 337 (fn. 1) (5th Cir. 1984). It "involves

the total image of a product and may include features such as size, shape, color or color combinations. . . . (citations omitted). *Two Pesos,* 120 L. Ed 2d at 621 (fn. 1).

A product feature is not subject to trade dress protection if it is functional. "[I]n general terms, a product feature is functional' and cannot serve as a trademark, 'if it is essential to the use or purpose of the article or if it affects the cost or quality of the article.' " *Qualitex*, 131 L. Ed at 255 (citing *Inwood Laboratories. Inc.*, 456 U.S. at 850 (fn. 10), 72 L. Ed 2d at 606, 102 S. Ct. 2182.

Defendant strongly argues that Plaintiffs Model 2360 mixer is not entitled to trade dress protection because it is functional. Although various features of a product may not be protected as trade dress because these features are functional, a combination of visual elements taken together may create a distinctive visual impression and thus entitles an owner to trade dress protection. One does not focus on the individual components but on the integration of those components into a single product. *See, Taco Cabano International v. Two Pesos, Inc.*, 932 F.2d 1113, 1118 (5th Cir. 1991).

As stated in *McCarthy on Trademarks*:

> A defendant cannot avoid liability for unfair competition simply by segregating out the various aspects of plaintiff's product, packaging and labels, and claiming that no one of these is protectable in and of itself. It is the total combination of elements that is at issue.
>
> . . .

> Thus, the issue is not whether defendant's package or trade dress is identical to plaintiffs in each and every particular. Rather, it is the similarity of the *total*, overall impression that is to be tested.

McCarthy on Trademarks § 8.01[1][b] (other citations omitted).

Consequently, in order to obtain trade dress protection the owner of a product must establish that his product is either distinctive or has acquired secondary meaning and that that which is sought to be protected is not functional. In determining whether or not the trade dress is entitled to protection, the Court must also determine if there is a likelihood of confusion of the ultimate consumer between the product of the Plaintiff and the Defendant. *See, Sno-Wizard Manufacturing v. Eisemann Products Company*, 791 F.2d 423, 425-26 (5th Cir. 1986); *Sicilia Di R. Biebow and Company v. Cox*, 732 F.2d 417, 425 (5th Cir. 1984).

IV. APPLICABLE LAW AS TO DILUTION OF FAMOUS TRADEMARK.

In order to succeed on the merits under the Federal Trademark Dilution Act of 1995, 15 U.S.C. § 1125(c), the Plaintiff must establish that it is the owner of a famous trademark, that West Bend's use of its stand mixer configuration and the West Bend mark applied thereto commenced after Sunbeam's mark became famous and that such use by West Bend causes dilution of the distinctive quality of Sunbeam's famous marks. *See*, 15 U.S.C. § 1125(c). There is no requirement that Plaintiff must prove likelihood of confusion to the ultimate consumer as to the source of the produce under § 1125(c).

Appendix B

V. DETERMINING MATTERS OF FACT.

In order to determine the outcome of this particular motion, this Court must not only determine questions of law but of fact as well. This Court must approach the question of determining the factual basis the same as would a jury. In every jury case presided over by this Court, the jury has been instructed, according to Fifth Circuit pattern jury instructions that while they should consider only the evidence before the Court, that the jury is permitted to draw such reasonable inferences from the testimony and exhibits as the jury feels justified in the light of common experience. In other words, the jury is called upon to make deductions and reach conclusions which reason and common sense lead the jury to draw from the facts established by the record. The jury is further advised that they are the judges of the credibility or believability of each witness and that they are to consider the interest, the demeanor, the manner of testifying and whether the testimony of witnesses have been supported or contradicted by other credible evidence. The jury is told that in short they may accept or reject the testimony of any witness in whole or in part. It is by this same approach that this Court must evaluate and determine the facts of this case.

VI. APPLYING THE FACTS OF THIS CASE TO APPLICABLE LAW ON TRADE DRESS

The court must answer three questions in determining whether or not Plaintiff is entitled to trade dress protection. First, the Court must determine whether or not the design of Plaintiff's Model 2360 mixer is functional. Secondly, the Court must determine whether the design is inherently distinctive or has acquired secondary meaning. The third question that the Court must determine is whether or not there is likelihood of

confusion of the ultimate consumer about the source of the product of the Defendant. The Fifth Circuit has held that this last question is key in determining whether or not a product is entitled to trade dress protection.

A. FUNCTIONALITY

The Court will first determine whether or not Plaintiff's design is functional. If the design is functional the Plaintiff is not entitled to protection. The Fifth Circuit has held a particular arbitrary combination of functional figures, the combination of which is not itself functional properly enjoys protection. *Two Pesos*, 932 F.2d at 1119. The Fifth Circuit has adopted the utilitarian nature of a configuration as its test of functionality. The Court has stated "such a feature will be functional, and not entitled to trademark or trade dress protection, if it is dictated by utilitarian characteristics or by the functions that the relevant product or trade dress is intended to serve." *See Sicilia*, 732 F.2d at 428, 429. "To achieve the status of functional, a design or feature must be superior or optimal in terms of engineering, economy of manufacture or accommodation of utilitarian function or performance." *Sicilia* at 429. If "[t]he same functions can be performed by a variety of other shapes with no sacrifice of any functional advantaged[,] [t]here is no necessity to copy appellant's trade dress. . . ." *Id.* at 429. (other citations omitted).

The Court finds that the overall configuration of the Sunbeam Mixmaster® Model 2360 is non functional. It is certainly comprised of many functional components, but it is the particular way in which the Plaintiff has chosen to assemble those individual components that leads the Court to this conclusion. There is ample evidence before the Court of viable alternative designs. No other competitor has found it necessary

to produce a mixer so similar to that of Plaintiff. The Defendant provided no evidence that the particular design of the Sunbeam Mixmaster® was the most utilitarian or that it could not manufacture a viable competitive product without replicating the Sunbeam Mixmaster®. Walter Hall, Sunbeam's product quality manager testified that using the particular handle design employed in the Sunbeam Mixmaster® is in actuality more costly than handle designs which are attached to the housing at both ends because of the greater strength required for the single attachment type handle. He also testified that the chrome tear drop front face plate was more expensive than one of a different color and design. The use of any number of efficient design alternatives available to the Defendant will not unduly hinder effective competition.

The Defendant has also asserted that because the Plaintiff has been issued various utility patents on its mixers over the years, that it now cannot claim that features listed in those patents are non functional. A utility patent is only issued on functional items. A design patent is issued on design characteristics which are generally considered non functional. Design patents and trade dress may co-exist whereas utility patents and trade dress are generally considered to be mutually exclusive. However, where a utility patent has been issued on a functional feature of a particular product, that is not dispositive of whether or not the overall shape of the product is functional. *See*, *Dogloo, Inc. v. Doskocil Manufacturing Company, Inc.*, 893 F. Supp. 911, (C.D. Calif. 1995). The Court is convinced that even though each of the features claimed to have been copied by West Bend are, to some degree, functional, it is the particular combination of the functional features and the way they are arranged and packaged that supports this Court's conclusion that the Sunbeam Mixmaster® Model 2360's overall shape and

configuration is non functional. *See, Taco Cabana*, 932 F.2d at 1119.

B. DISTINCTIVENESS AND SECONDARY MEANING

McCarthy states that prior to the Supreme Court's 1992 decision in *Taco Cabana* the Fifth Circuit had made an important break with the traditional rule requiring secondary meaning by finding that inherently distinctive trade dress needs no evidence of secondary meaning to establish validity. *See Chevron Chemical Company v. Voluntary Purchasing Groups, Inc.*, 659 F.2d 695 (5th Cir. 1981), cert. denied 457 U.S. 1126, 73 L. Ed. 2d 1342,102 S. Ct. 2947 (1982). Prior to *Taco Cabana*, the majority of Circuits accepted the Fifth Circuit's formulation of the rule. In *Taco Cabana* the Supreme Court agreed with the Fifth Circuit view and held that trade dress that is inherently distinctive is protectable under Lanham Act § 43(a) without a showing that it has acquired secondary meaning. As the Fifth Circuit has stated "sufficiently distinctive trade dress upon use in the market is presumed to serve as an identifier of source without proof of secondary meaning." *Di R. Biebow and Company*, 732 F.2d at 426 (fn. 7) (other citations omitted). It is helpful to review what the Supreme Court said in *Two Pesos*. The Court in that case found

> Two Pesos adopted a motif very similar to the foregoing description of Taco Cabana's trade dress. . . .

122 L. Ed. 2d at 621.

> A trademark is defined in 15 U.S.C. § 1127 [15 U.S.C.S. §1127] as including "any word, name,

> symbol or device or any combination thereof" used by any person to identify and distinguish his or her goods, including a unique product, from those manufactured or sold by others and to indicate the source of the goods. . . .

Id. at 623.

> If temporary protection is available from the earliest use of the trade dress, it must be because it is neither functional nor description but an inherently distinctive dress that is capable of identifying a particular source of the product. Such a trade dress, or mark, is not subject to copying by concerns that have an equal opportunity to choose their own inherently distinctive trade dress. . . .

Id. at 625.

> The user of such a trade dress should be able to maintain what competitive position it has and continue to seek wider identification among potential customers.

Id. at 626.

As the Fifth Circuit held in *Taco Cabana*, *supra*,

> A competitor can use elements of Taco Cabana's trade dress, but Taco Cabana "can protect a combination of visual elements 'that, taken together, . . . may create a distinctive visual impression' " (footnote omitted) (quotations omitted). . . .

Appendix B

> Two Pesos may enter the upscale Mexican fast food market but it may not copy Taco Cabana's distinctive combination of layout and design features. . . .
>
> The instructions properly cautioned the jury not to focus on isolated components in determining the protectability of Taco Cabana's trade dress, but rather to consider the overall combination of elements. . . .

932 F.2d at 1118.

> The wide range of available packaging and design options allow a producer to appropriate a distinctive identity without unduly hindering his competitor's ability to compete. (citation omitted). Taco Cabana does not seek protection for individual elements, but for a particular combination of elements which constitute trade dress as a whole. (citation omitted). . . .

Id. at 1119.

> The whole, in trademark law, is often greater than the sum of its parts. (citation omitted.) . . .
>
> Again, competitors may use individual elements in Taco Cabana's trade dress, but the law protects the distinctive totality.

Id.

Just as Two Pesos' motif was "very similar" to that of Taco Cabana, West Bend s design of its Model 41012 mixer is "very

similar" to the design of Sunbeam's Model 2360 mixer which has been on the market unchanged for seventeen years. In accord with the Fifth Circuit decision in *Two Pesos* this Court concludes that Sunbeam's design of its Model 2360 mixer is inherently distinctive.

The Court is also convinced that over time the Sunbeam Mixmaster® mixer has acquired the necessary secondary meaning in order to entitle it to trade dress protection. The prime element of secondary meaning is a mental association in the buyer's mind between the alleged mark or product configuration and a single source of the product. *See Sno-Wizard*, 791 F.2d at 425 (fn. 2) and 427.

Sunbeam presented to the Court a line of Mixmaster® mixers from 1930 to the current date. Sunbeam asserted that its overall design and look evolved from 1930 up to the present model. The Court in reviewing the exemplar mixers provided, is certainly convinced that the current model Mixmaster® mixer evolved from Sunbeam's earlier offerings. It is equally clear that the present overall look and shape of the Sunbeam Model 2360 Mixmaster® mixer is entitled to trade dress protection because of its acquired secondary meaning in its present form. The testimony before the Court was that the mixer is unchanged in external appearance since 1979. The Court finds that since at least the mid to late 1950s the Sunbeam Mixmaster® mixer can certainly be identified as a unique and viable product configuration which has evolved into its present shape. None of the other modern mixers with the exception of the West Bend prototype even closely resemble the overall appearance of the Sunbeam Mixmaster® mixer. While all of the mixers may very well have common features, they have all evolved into separate, and in the Court's opinion, distinct entities with their own

individual personalities, if you will. A review of the mixers presented to the Court at the hearing on this cause certainly indicates a wide variety of feasible design alternatives to West Bend so that West Bend can adequately compete with Plaintiff.

C. LIKELIHOOD OF CONFUSION

Since the Court has decided that the product configuration is non functional, that it is inherently distinctive, and has additionally acquired secondary meaning, then the final step of the analysis is required. That step is to determine whether or not the trade dress has been infringed which requires a finding regarding the likelihood of confusion to the ordinary consumer as to the source of the product. The Fifth Circuit has stated that likelihood of confusion is the key to finding a violation of Lanham Act § 43(a). *See Sno-Wizard*, 791 F.2d at 425. The Fifth Circuit has referred to its test for determining likelihood of confusion as the digits of confusion test. This test includes a variety of factors including but not limited to (1) similarity of products, (2) identity of retail outlets and purchasers, (3) identity of advertising media, (4) type (i.e., strength) of trademark or trade dress, (5) defendant's intent, (6) similarity of design, (7) actual confusion, (8) degree of care exercised by purchasers. Factors 1, 2, 3 and 4 require little discussion. The two products are obviously very similar. The retail outlets and purchasers will be identical. The advertising media for both products will be virtually the same. As to the strength of Plaintiffs trade dress, the Court finds that based upon sixty years of advertising it is strong. The other elements will require more extended discussion.

Appendix B

FIFTH FACTOR, INTENT.

The Fifth Circuit has adopted the approach that proof of intentional copying of trade dress creates a presumption that the defendant intended to create confusion in the ultimate consumer of the product. *See Chevron Chemical Company v. Voluntary Purchasing Groups*, 659 F.2d 695, 703-04 (5th Cir. 1981). The Fifth Circuit went on to note;

> VPG, in designing Trade Dress NO. 1 meant to copy Ortho's Trade Dress, at least "as much as the law would allow." While the district court did not specifically find that VPG copied Ortho's Trade Dress with the intent of "cashing in" on Ortho's goodwill, we can think of no other plausible explanation for such behavior. It is so easy to a businessman who wishes to sell his goods upon their merits to select marks and packaging that cannot possibly be confused with his competitors that "courts look with suspicion upon one who, in dressing his goods for the market, approaches so near to his successful rival that the public may fail to distinguish between them."

Chevron Chemical Company, 659 F.2d at 704. Citing *Florence Manufacturing Company v. J. C. Dowd and Company*, 178 F. 73, 75 (2nd Cir. 1910). This Court agrees that there has been no other plausible explanation presented by the Defendant for the virtual replication of the Plaintiff's Mixmaster® mixer. The testimony before the Court indicated that Sunbeam had $22 milliondollars in 1994 sales or approximately forty-three percent of the total stand mixer sales in the United States. Testimony further revealed that approximately seventy percent of all

Appendix B

Sunbeam Mixmaster® sales are attributable to the Model 2360 Mixmaster®, whose trade dress is alleged to have been infringed upon by the Defendant's prototype mixer. The evidence indicates that Wal-Mart, an outlet that accounts for twenty percent of all mixer sales in the United States was very much interested in Defendant producing a mixer that had a design similar to Plaintiff's Mixmaster®.

Based on all of the evidence before it, together with reasonable inferences drawn from this evidence, as such evidence as outlined above in this opinion, the Court concludes that Defendant intended to copy Plaintiff's 2360 Mixmaster® with a few minor deviations so that hopefully Defendant would avoid trade dress or trademark or patent infringement and nevertheless be able to benefit from Plaintiffs goodwill.

SIXTH FACTOR, SIMILARITY OF DESIGN.

The second factor of the digits to be considered is similarity of design between the offending product and the Plaintiffs product. Upon seeing the two mixers side by side for the first time, the Court's impression was that the two mixers were as alike as two peas in a pod. Upon closer examination there were several slight differences in the two designs. In addition to similarities already noted, the Plaintiff also asserts that the four-quart mixing bowls included with each of the stand mixers from Sunbeam and West Bend are identical. A close comparison in the courtroom indicated very little difference between the two bowls. In fact, they are almost identical in shape, size and appearance. Plaintiff contends that Defendant used one of Plaintiff's bowls in its advertising slick. While the Court does not find this to be true, the similarity is such that it may well have occurred.

Appendix B

The Court saw several renderings introduced into evidence prepared for Sunbeam to consider as to future modifications. Sunbeam's design engineer described these as being potential future generations of the Model 2360. It should be noted that none of these renderings have been adopted or are being transformed into products for Sunbeam. What Sunbeam complains about is not infringement of any future design, but infringement on the design that has been consistent and identical for the past seventeen years. Sunbeam's expert described these as possible future generation Sunbeam mixers. Seeing these two mixers side by side, one could easily see the West Bend mixer as a part of Sunbeam's future generation of mixers. Consequently, confusion probably would result from the marketing of this very similar product.

Defense counsel made much of the argument that black and white are common kitchen appliance colors. The Court finds that it is not the colors themselves taken in a vacuum which contribute to the entitlement of the Mixmaster® to trade dress protection. However, it is the combination of colors and design replicated by West Bend in its mixer that lend credence to this Court's conclusion that the Defendant has infringed Plaintiff's protected rights.

SEVENTH FACTOR, ACTUAL CONFUSION.

Case law clearly establishes that Plaintiff does not have to prove actual confusion in order to obtain a preliminary injunction. The Fifth Circuit has held that actual consumer confusion is the best indicator of the likelihood of consumer confusion but, as stated, the absence of such evidence certainly does not demonstrate the converse. *See Chevron Chemical Company,* 659 F.2d at 704. As in the case of trademark

infringement, evidence of actual buyer confusion is not necessary in order to find a *likelihood* of confusion. *McCarthy on Trademarks* § 8.03[1] (other citations omitted). As *McCarthy* goes on to suggest "in the absence of evidence of actual confusion, a judge must try to temper his or her own subjective impression with an imaginative attempt at reconstructing the reaction of the ordinary, non-discerning buyer." *Id.* In fact actual confusion is impossible to prove in this case because Defendant's product has not yet been manufactured much less marketed. The Court understood that the first product manufactured was delivered for examination by the Court on the day of trial. It had not been available previously and for this reason since it was the first prototype actually manufactured, Defendant did not want it tested for quality.

According to *McCarthy,* "the fact that defendant places its own mark on the product, by which a careful and discriminating purchaser could tell the difference between his product and others is not the issue. It is the casual or ordinary nondiscerning buyer who is protected. To such a buyer the test is one of general overall impression gained at a glance. *McCarthy on Trademarks* § 8.04 (other citations omitted).

EIGHTH FACTOR, DEGREE OF CARE EXERCISED BY PURCHASERS.

Debra Kumm, who is the vice president of marketing for West Bend, testified that their mixer had a suggested retail price of $99.95. She said that she anticipated the actual retail selling price of the product would be fro $70 to $90. Based on this, the Defendant urges the Court to find that this mixer falls into the category of products which are not "impulse items" but items which a careful consumer will take the time to study and

differentiate between other like products. The Plaintiff asserts that this is not such a product as an automobile, stereo speaker, refrigerator or like appliance that costs many hundreds of dollars and will lead to such careful selection. The Court specifically finds that the products in question are most likely not impulse items but that they are relatively inexpensive in the household appliance field. Plaintiff's Product Quality Manager Walter Hall, testified that the wholesale price of the Sunbeam Mixmaster® Model 2360 was $70.26. The testimony before the Court indicates that the West Bend mixer will be wholesaled to retailers for approximately $20 less than the Sunbeam Mixmaster® Model 2360. It is therefore logical to assume that the retail price of the West Bend mixer will be $20 or more cheaper than the Sunbeam mixer. Obviously some consumers will not be confused. However, the Court finds that a good number of customers will probably or likely be confused under these circumstances.

Defendant argues that because its name will be on the product that confusion cannot result. This ignores the very obvious finding of the Fifth Circuit in the *Taco Cabana* case. The Fifth held that even though these restaurants had entirely different names that nevertheless there could be confusion. In *Taco Cabana*, *supra*, the Fifth Circuit noted that patrons who patronized Taco Cabana "are likely to believe that Taco Cabana and Two Pesos are owned or operated by the same company." *Id.* The Court concluded

> The issue is not whether consumers can read signs and menus that identify different restaurants, but whether consumers assume some affiliation between Taco Cabana and Two Pesos.

932 F. Rep. 2d at 1122.

The Court finds based on the evidence before it that there is enough similarity of design between the two products that the ordinary consumer would likely be confused as to the origin of the West Bend mixer. *See Sno-Wizard*, 791 F.2d at 428.

VII. APPLYING THE FACTS TO APPLICABLE LAW REGARDING THE ISSUANCE OF A PRELIMINARY INJUNCTION.

After a careful analysis of the evidence presented to the Court and a review of the law, the Court concludes that Plaintiff Sunbeam's trade dress in its Model 2360 Mixmaster® stand mixer is entitled to trade dress protection. The Court will now consider the four factors as to whether Plaintiff is entitled to a preliminary injunction. First, the Court concludes that there is a substantial likelihood that Plaintiff will succeed on the merits of its case before a jury, as set out above. Secondly, the Plaintiff has offered sufficient evidence that there is a substantial threat that it will be irreparably injured if the Defendant is allowed to market its mixer in its present form. The Plaintiff has provided evidence to establish that it has already lost substantial sales exceeding $400,000. There has also been evidence presented that the retailers who market kitchen appliances are very interested in what has been termed "vendor consolidation." The testimony revealed that retailers prefer to purchase as many products in a given line from one company as possible. In other words, if one company is handling a complete line of household appliances, then the retailers generally purchase as many of those items from that one manufacturer as possible. The Plaintiff provided testimony that it had been the victim of such vendor consolidation in the outdoor grill market where a major retailer decided to discontinue purchasing outdoor grills from Sunbeam when another company offered an almost identical product at a

lower price and the retailer informed Sunbeam that it did not have warehouse space to carry two products which were almost identical. Therefore, the evidence presented by Plaintiff indicates to the Court that if the West Bend mixer were allowed to be sold to retailers that Sunbeam would likely suffer not only the loss of sales of the Model 2360 Mixmaster® stand mixer but also other household appliances. Plaintiff would also have to lay off workers.

The third factor to be considered is the threat of injury to the movant must outweigh any damage the injunction might cause the opponent. No quantitative figures have been provided to the Court to determine precisely what damage will be caused to either company by the issuance of a preliminary injunction. The Defendant asserts that it will lose at least six million dollars in sales estimated for the next eighteen months. The Defendant also asserts that it will lose the use of approximately $700,000 worth of tooling in China which has been purchased to manufacture this product. Defendant further asserts that it will suffer a loss of reputation and possibly the sales of other products because of its inability to deliver on what it has marketed as available. While the Court is sympathetic to this Defendant's potential problems, it is convinced that the threat of injury to the Plaintiff is more substantial than that that would be suffered by the Defendant. The Plaintiff is an established marketer of the Model 2360 stand mixer and in fact controls forty-three percent of the market for stand mixers in this country. Defendant has yet to enter this market. It has no manufacturing facility, no employees manufacturing this product and elected not to introduce any contract between it and Americorp which would prove its damages for stopping AmeriCorp from manufacturing its product.

Living in the cost conscious society in which we live, the Court is convinced that a mixer offered for sale that looks almost identical to the Sunbeam and selling $20 cheaper would place Sunbeam at an unfair disadvantage. The Court absolutely agrees with the idea of competition. Competition is the life blood which produced and stimulates the continued economic vigor of the United States. However, the issue of competition in this case must be tempered when one attempts to compete unfairly.

Defendant is not being enjoined from manufacturing a mixer and selling it for $20 less than Plaintiff. Defendant is not being enjoined from competing with Plaintiff. Defendant is being enjoined from unfairly competing with Plaintiff by infringing upon Plaintiff's trade dress.

The fourth factor is whether the issuance will not disservice the public interest. Congress has made that decision when it decided that one who attempts to unfairly duplicate a successful product should be excluded from the competitive arena.

VII. DILUTION OF FAMOUS TRADE DRESS

Section 43 of the Trademark Act, 15 U.S.C. § 1125, was amended on January 16, 1996, and provides that a court may issue an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark. 15 U.S.C. § 1125(c). This section also provides for additional remedies set forth in §§ 35(a) and 36 where there is a wilful intent to trade on the owner's reputation or to cause dilution of the famous mark. The statute lists a number of factors to be considered by the court in determining whether or not a mark is distinctive and famous. They are as

follows: (1) the degree of inherent or acquired distinctiveness of the mark; (2) the duration and extent of use of the mark in connection with the goods or services with which the mark is used; (3) the duration and extent of advertising and publicity of the mark; (4) the geographical extent of the trading area in which the mark is used; (5) the channels of trade for the goods and services for which the mark is used; (6) the degree of recognition of the mark and the trading areas and channels of trade used by the mark's owner and the person against whom the injunction is sought; (7) the nature and extent of use of the same or similar marks by third parties; and (8) whether the mark was registered under the Act of March 3, 1981, or the Act of February 20, 1905, on the principal register. 15 U.S.C. §1125(c)(1) (supplement 1996). This Section does not require proof of consumer confusion. Testimony at the hearing of this matter indicated that although Sunbeam had not applied for a trademark prior to this situation that Sunbeam has now applied for registration of its overall shape and configuration as a famous mark as provided in the Act. An individual review of the factors listed and the criteria supporting a finding on each is not necessary at this point. The Court has made specific findings above which, under the factors set forth in § 1125(c), would support a finding that Sunbeam's Mixmaster® mixer would qualify as a famous mark. Such a finding will entitle the Plaintiff only to an injunction at this point until proof is offered as to whether or not the Defendant wilfully intended to trade on Plaintiff's reputation or to cause dilution of the famous mark. Such findings will properly be left to the finder of fact at the trial of this matter.

CONCLUSION

This Court is of the opinion that in framing the injunction to be entered in this matter, the specific elements of the Plaintiffs

product configuration which have led the court to conclude that it is entitled to trade dress protection should be enumerated in order to prevent dangers of anti-competitive over protection and to allow the Defendant to know precisely what elements of his product should be changed in order to avoid contempt of the injunction. The specific elements that the Court finds which, taken as a whole, create the Plaintiff's entitlement to trade dress protection for the Sunbeam Mixmaster® mixer are as follows: (1) the elongated torpedo shaped main body containing the motor and electronic switch; (2) the electronic switch control being placed on the aft end of the main body; (3) the open ended handle attached at a single location at the front of the main body and containing a slight arc from front to rear; (4) the tear drop chrome front face plate located on the front of the main body; (5) the beater eject knob located on the left front portion of the handle; (6) the black and white overall color scheme of the mixer specifically broken down as (a) white main body; (b) chrome tear drop front face plate; (c) black open ended handle attached at the front of the main body only; (d) black beater eject button; (e) black electronic speed control located at the aft end of the torpedo shaped main body; and (f) black bowl platter located on the front portion of the stand supporting the main body.

The Court does not intend to imply that the Defendant must change each and every one of these features on its mixer to avoid infringement of the Plaintiff's trade dress. The Court is specifically of the opinion that if the Defendant was to close in the open ended portion of the top handle on the main body, change the front tear drop face plate to a different design and color, and relocate the electronic speed control from the rear of the unit to the side, then there would be no infringement on the Plaintiff's trade dress.

Appendix B

The Court, considering all of the testimony adduced in regard to the potential damage that will be sustained by Defendant if the Court enjoins the manufacture of Defendant's mixer, concludes that Plaintiff should post a bond in the amount of Three Million Seven Hundred Fifty Thousand Dollars.

Upon the posting of an approved bond in the amount of Three Million Seven Hundred Fifty Thousand Dollars by Plaintiff, Defendant is enjoined from manufacturing its proposed new model 41012 stand mixer contrary to the provisions of this order.

Upon the posting of an approved bond, the Court hereby enjoins the Defendant, its officers, agents, sales representatives, servants, employees, associates, attorneys, successors and assigns, and all persons acting by, through, under or in active concert or participation with any of them from:

1. Making, using, or selling, alone or in combination with other products, words designations, designs or otherwise, any products embodying Plaintiff's Mixmaster® product design trademark, any confusingly similar design to Plaintiffs Mixmaster® product design, or any colorable imitation of Plaintiff's Mixmaster® product design trademark, such as by way of example but not limitation that design shown in Exhibit D to the Verified Complaint, or using any other mark or device likely to injure Plaintiff's business reputation or dilute the distinctive quality of said Mixmaster® product design, the Mixmaster® trademark, and/or the Sunbeams trademark.

2. Otherwise infringing Plaintiff's Mixmaster® product design mark.

Appendix B

3. Engaging in any course of conduct likely to enable Defendant to benefit from the valuable goodwill and reputation established in Plaintiff's Mixmaster® product design trademark.

4. Publicly displaying, offering for sale, promoting, advertising, marketing to the trade, or otherwise attempting to commercialize the design of the product shown in Exhibit D to the Verified Complaint or any colorable imitation thereof; or design confusingly similar thereto.

5. Showing or displaying, publicly or privately, to potential customers, the design of the product shown in Exhibit D to the Verified Complaint at the Gourmet Show in San Francisco on May 4-8, 1996; and

6. Unfairly competing with Plaintiff in any manner whatsoever.

SO ORDERED AND ADJUDGED this the 3rd day of May, 1996.

s/ Charles W. Pickering, Sr.
CHARLES W. PICKERING, SR.
UNITED STATES DISTRICT JUDGE

APPENDIX C — ORDER MODIFYING PRELIMINARY INJUNCTION OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF MISSISSIPPI, HATTIESBURG DIVISION FILED MAY 14, 1996

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF MISSISSIPPI
HATTIESBURG DIVISION

CIVIL ACTION NO. 2:96CV148PS

SUNBEAM PRODUCTS,

PLAINTIFF

vs.

THE WEST BEND COMPANY

DEFENDANT

ORDER MODIFYING PRELIMINARY INJUNCTION

On May 6, there came on for hearing the motion of Defendant The West Bend Company ("West Bend") for an emergency motion to clarify the Order Granting Preliminary Injunction entered by the Court on May 3, 1996, and the Court, having considered the motion and having heard argument of counsel and considered submissions by counsel for the parties, found and ordered as follows:

1. The preliminary injunction entered by the Court on May 3, 1996, shall remain in effect as modified herein. Pursuant to the stipulation of the parties the injunction shall be effective without any requirement that Plaintiff Sunbeam Products, Inc.

("Sunbeam") post a bond as security for issuance of the injunction. West Bend, however, reserves the right to seek any damages against Sunbeam resulting from the issuance of the injunction should it later be determined that the injunction was wrongfully issued.

2. The Court finds that the prototype mixer presented to the Court by West Bend on Saturday, May 4, 1996, a photograph of which is attached hereto as Exhibit A, does not avoid the proscription of the Preliminary Injunction entered on May 3, 1996, under the safe distance rule. Such prototype has the following changes from West Bend's original product (Court's Exhibit 2):

a. closing in the open-end portion of the handle so that the handle visually or actually connects to the body;

b. eliminating the chrome plating of the faceplate and making it white or some other non-chrome color;

c. increasing the size of the West Bend logo on the motor housing to over two and one-half (2 1/2) times its original size with the logo to appear on the mixer stand and both sides of the mixer housing;

d. changing the color of the speed control dial to white to match the color of the body of the mixer;

e. changing the handle color to white to match the color of the body of the mixer;

f. changing the turntable color to white to match the color of the body of the mixer; and

g. changing the ejection button color to white to match the color of the body of the mixer.

3. However, West Bend can manufacture, sell and promote its stand mixer without falling within the proscription of the Preliminary Injunction entered on May 3, 1996, if the following additional change, as proposed by West Bend (Exhibit B), is made:

h. changing the shape of the speed control dial such that it no longer carries through along the tapering of the motor housing, but instead flares outwardly, substantially as illustrated in Exhibit B;

4. Within two (2) months after first shipment, but in no event later than August 31, 1996, all mixers must have handles that do not have any middle-up arced nature — i.e., so that neither the bottom profile nor the top profile has any middle-up arcing curvature.

5. Within six (6) months after first shipment, but in no event later than December 31, 1996, all mixers must have the faceplate removed and redesigned.

6. West Bend shall provide to Sunbeam drawings or other clear depictions for the above-noted modifications within one (1) day of their creation.

7. The Court shall maintain continued jurisdiction over this injunction to consider any modifications or requests for modification made by the parties as the need arises.

8. This order is effective as of May 6, 1996.

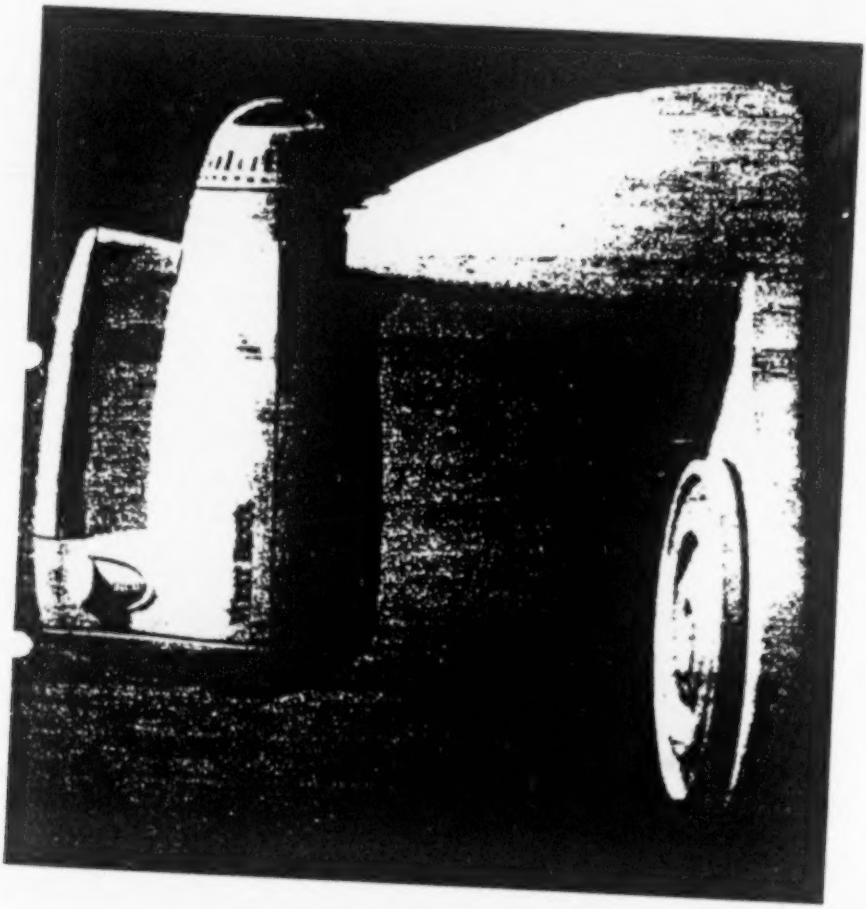
SO ORDERED this 14th day of May, 1996.

United States District Court Judge

Appendix C

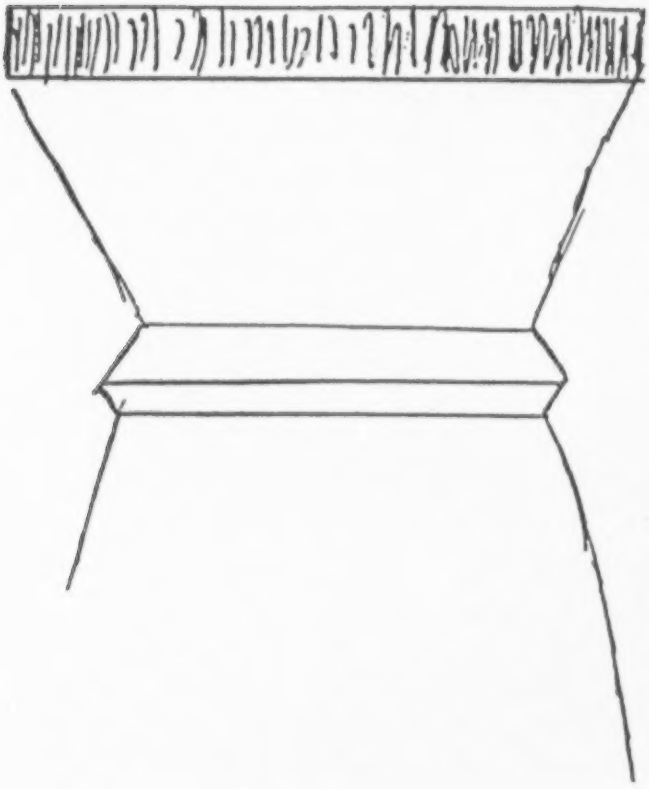
EXHIBIT A

(See Lodging Appendix at L-3)



Appendix C

EXHIBIT B



APPENDIX D — ORDER FURTHER MODIFYING PRELIMINARY INJUNCTION OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF MISSISSIPPI, HATTIESBURG DIVISION FILED MAY 14, 1996

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF MISSISSIPPI
HATTIESBURG DIVISION

CIVIL ACTION NO. 2:96CV148PS

SUNBEAM PRODUCTS, INC.

PLAINTIFF

vs.

THE WEST BEND COMPANY

DEFENDANT

ORDER FURTHER MODIFYING PRELIMINARY INJUNCTION

On May 13 and 14, there came on for hearing, based on disagreement of the parties as to whether the further-revised West Bend stand mixer prototype shown in Exhibit C (attached) falls within the proscription of the Order Granting Preliminary Injunction of May 3, 1996, as modified by order of May 6, 1996, the matter of further clarification. The Court, having considered the matters and having heard argument of counsel and considered submissions by counsel for the parties, orders as follows:

Appendix D

1. The West Bend stand mixer shown in Exhibit C does not avoid the proscription of the Preliminary Injunction entered on May 3, 1996.

2. However, West Bend can manufacture, sell and promote such stand mixer without falling within the proscription of the Preliminary Injunction if any one of the following additional changes is made:

a. eliminating the words on the annular side wall of the speed control dial (no further shape change being necessary);

b. changing the shape of the speed control knob to further increase the outward flare to substantially match the shape shown in attached Exhibit D (elimination of the words on the annular side wall of the speed control dial being unnecessary); or

c. flattening (or making concave) the rear surface of the knob shown in Exhibit C, with or without the placement of any words on such rear surface (and not on the annular side wall of the knob), such acceptable knob being shown in attached Exhibit E.

3. The Court shall maintain continued jurisdiction over this injunction to consider any modifications or requests for modification made by the parties as the need arises.

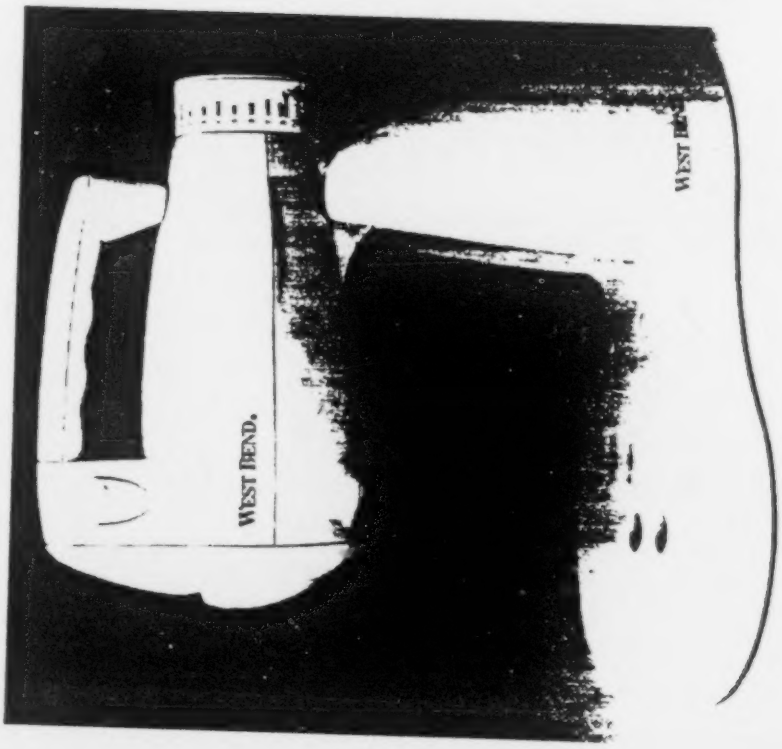
SO ORDERED this 14th day of May, 1996.

s/ illegible
United States District Court Judge

Appendix D

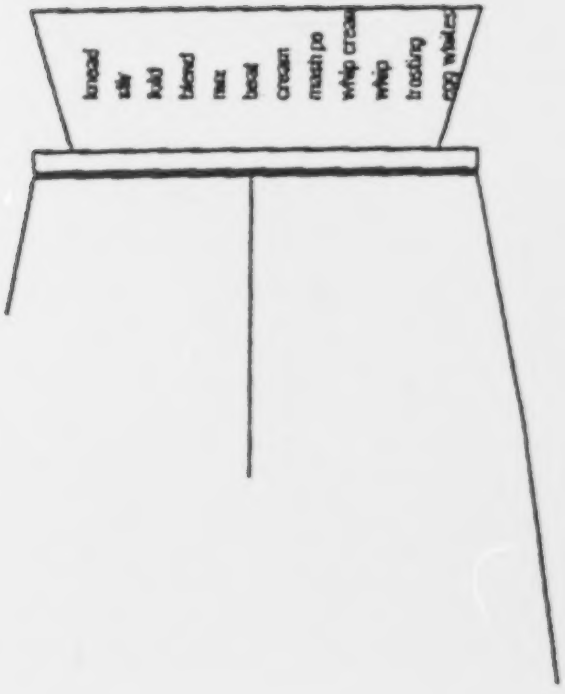
EXHIBIT C

(See Lodging Appendix at L-4)



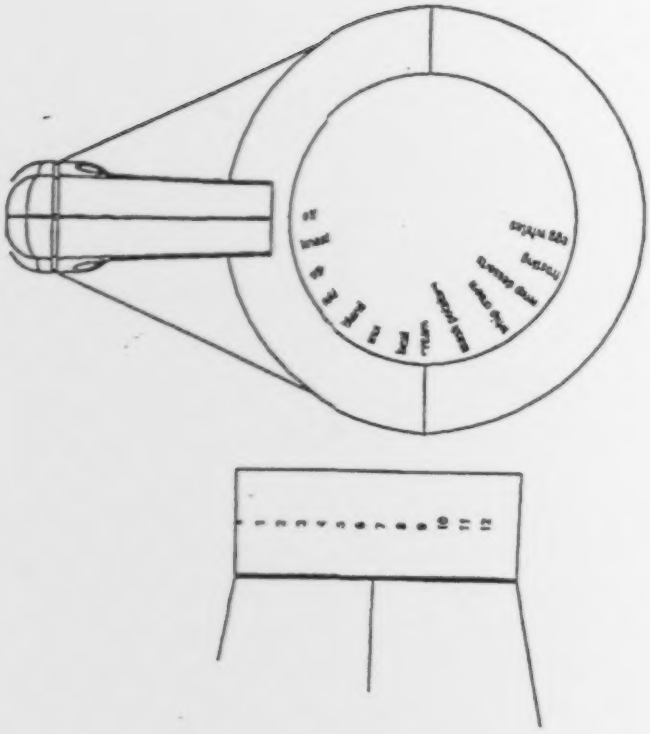
Appendix D

EXHIBIT D



Appendix D

EXHIBIT E



APPENDIX E — ORDER AND FINDINGS OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF MISSISSIPPI, HATTIESBURG DIVISION FILED MAY 24, 1996

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF MISSISSIPPI
HATTIESBURG DIVISION

CIVIL ACTION NO. 2:96cv148PS

SUNBEAM PRODUCTS, INC.

PLAINTIFF

VERSUS

THE WEST BEND COMPANY

DEFENDANT

ORDER

This matter comes on before the Court sua sponte. The Court feels that the chronology and reasoning of the Court at the various stages of this proceeding needs to become a part of the record. Accordingly, the Court drafted a document setting forth the chronology of the hearings in this case along with the Court's perception and reasoning related to these matters. The Court circulated this document to the parties and invited responses thereto. Both parties have suggested some changes. The Court has incorporated some but not all of the proposed changes. The attached document is made a part of the record in this case as setting out the sequence of events and the reasoning of the Court at the various stages.

Appendix E

SO ORDERED AND ADJUDGED this the 23 day of May 1996.

s/ Charles W. Pickering, Sr.
CHARLES W. PICKERING, SR.
UNITED STATES DISTRICT JUDGE

Appendix E

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF MISSISSIPPI
HATTIESBURG DIVISION

CIVIL ACTION NO. 2:96cv148PS

SUNBEAM PRODUCTS, INC.

PLAINTIFF

VERSUS

THE WEST BEND COMPANY

DEFENDANT

FINDINGS BY THE COURT AS TO SEQUENCE OF EVENTS AND REASONING BEHIND VARIOUS ORDERS ENTERED BY THE COURT IN THIS CAUSE

Because of the urgent and emergency nature of the various motions that have been filed in this matter, most of what has transpired in this case has not been of record. Accordingly, I am of the opinion that a record should be made of what has transpired and of my reasoning at the various stages of this litigation.

First off, Plaintiff filed its motion for a preliminary injunction and for a temporary restraining order at a time when this Court had been and was involved in a number of other issues. I felt at that time that Plaintiff had made a good case for a temporary restraining order which I issued on Friday, April 12, 1996.

Appendix E

Although this Court has not been presented with a request for very many TRO's, I have ordinarily required some type of advance notice prior to the issuance of one. In any event, the Court was contacted on Monday, April 15, by counsel for the Defendant urging that its motion for emergency dissolution of the TRO be heard immediately. The Court ordered a hearing the next morning, Tuesday, April 16, 1996, at 8:30 A.M. before the Court commenced other business. The Court concluded at that hearing that it should not have granted the TRO without at least some minimum amount of notice to the Defendant and suggested to the parties that the TRO should be dissolved. Each party alleged that it would suffer irreparable damage if it did not prevail. The Plaintiff contended that a hearing on the preliminary injunction was urgently needed before the gourmet food show in San Francisco which was scheduled to begin on Sunday, May 5, 1996, since a major part of the following year's sales would be confirmed at that meeting. The parties agreed that Defendant would not seek damages for the issuance of the TRO and that the Court should establish an expedited and limited discovery schedule and that a hearing on the preliminary injunction would be conducted prior to the gourmet food show scheduled for San Francisco. The hearing was scheduled for April 30, 1996, which was later than Plaintiff wanted and earlier than Defendant wanted.

On April 29, immediately prior to conducting the hearing on the motion for a preliminary injunction, the Court conferred with the parties. Sunbeam advised the Court of its strong feeling that its product was being copied and that the West Bend product looked very similar to its product. Sunbeam further advised that West Bend's product was going to be manufactured in China and would sell for $20 less than the Sunbeam product. Based on the foregoing, Sunbeam strongly asserted that it would be

greatly and irreparably damaged if Defendant was not prevented from marketing its proposed mixer. On the other hand, Defendant conveyed to the Court that it had already gone to considerable expense to have its mixer manufactured in China and that if it were not allowed to market its product immediately, that it too would suffer irreparable damage. After this conference but before the Court heard evidence on the preliminary injunction, the Court advised the parties that they themselves had far greater capability to make decisions about conducting their business than the Court. The Court advised the parties that business decisions made by businesses were far better than court decrees directing businesses to conduct their affairs in a given manner. In view of the foregoing and in view of the fact that the Court felt that the designers of the two parties were in a much better position to determine what would prevent Defendant from infringing on Plaintiffs trade dress and what would be feasible as to modifications that would prevent such an infringement, the Court advised the parties that due to the shortness of time that the Court would go ahead and conduct the preliminary injunction hearing but would defer ruling on the matter until the following Friday, May 3, just two days before the San Francisco gourmet food show. The Court instructed the parties to confer among themselves and see if they could not resolve their differences before the Court ruled on Friday. During the course of the hearing, the Court indicated that although it was not making a finding, the Court felt that if certain changes were made by Defendant that these changes would probably avoid trade dress infringement. The Court concluded that Defendant had in fact infringed upon Plaintiff's trade dress and the Court further concluded that this action was deliberate — that is, that Defendant had copied Plaintiffs product and then made minor modifications hoping to avoid trade dress infringement.

Appendix E

The Court should note that after it granted Defendant's emergency motion to quash the TRO and during the process of the expedited discovery, Defendant filed a motion for change of venue. After reviewing the law from the various circuits, this Court concluded that the Plaintiffs were attempting to get this matter tried within the Fifth Circuit and that Defendants were trying to get it heard within the Seventh Circuit.

The Court indicated to the parties at the preliminary hearing that it would try to render a decision by 12:00 noon on Friday. However, the Court was involved in other hearings and did not get to work on the Memorandum Opinion and Order which it ultimately rendered on Friday until the preceding evening. Because the Court felt that its reasoning needed considerable explanation in granting the preliminary injunction, the Court drafted a thirty page opinion finding that Defendant had infringed Plaintiff's trade dress which was entered at approximately 4:30 p.m. on Friday, May 3, 19[illegible].

Although the Court had admonished the parties to try to resolve their differences before the Court rendered its opinion, neither party made any effort to contact the other party and work out their differences before the entry of the Court's opinion on May 3. However, Defendant was waiting for the Court's opinion which was entered at 4:30 p.m. and by the time I arrived home at 6:00 p.m. on Friday afternoon, Defendant had already called my residence three times. At 6:00 p.m. on Friday afternoon, the Defendant advised me and counsel for the Plaintiff in a conference call that the Defendant had commenced making additional modifications to its mixer immediately after the preliminary hearing on Wednesday and that the Defendant wanted to present a prototype of that mixer to the Court and to request emergency relief from the preliminary injunction. I

agreed to an emergency hearing at my residence the following day, Saturday, May 4, 1996, at 1:00 p.m. and required all counsel to be present.

At the emergency hearing conducted at my residence on Saturday afternoon, I concluded that the modifications made by the Defendant did not comport with the safe distance rule and that even though the Defendant had made progress toward modifying its product so that it would not infringe upon Plaintiff's trade dress that the prototype presented to the Court on Saturday afternoon had not yet been sufficiently modified to avoid an infringement. The Court again advised the parties that they should confer and try to work out their differences. Plaintiff indicated that the appropriate representatives of both parties were at that time in San Francisco preparing for the start of the gourmet show. I was leaving the next day for the Fifth Circuit Judicial Conference in Fort Worth, but due to the exigency of the situation, I agreed to conduct an additional emergency hearing either with the representatives of the parties present in Fort Worth or by telephone conference. The Defendant expressed fear that the Plaintiff would not confer with them. I conveyed to the Defendant that if Plaintiff would not meet with them and discuss the issues and try to resolve it, that I would hear Defendant and would require such modifications as the Court thought appropriate, and would allow the Defendant to start manufacture of its product, with these modifications. I advised that if Defendant wanted input as to the modifications that were going to be required that they would have to meet with the Plaintiff in good faith. On Sunday evening counsel for the Defendant, who was in San Francisco, again contacted me at approximately 10:00 p.m. in Fort Worth. He advised me that he had faxed to me at the hotel an additional drawing of a modified stand mixer that the Defendant felt would

avoid infringement. I had not received the drawing at that time. Defendant agreed to make sure that this drawing was delivered to me overnight and I agreed to a conference call between the parties at 8:00 a.m. on Monday, May 6.

At 8:00 a.m. during the telephone conference, I had before me a sketch presented by Defendant reflecting the modification that Defendant proposed to make to avoid infringement under the requirements of the safe distance rule since I had found that Defendant had copied Plaintiff's product. I asked Plaintiff to respond to these modifications. Plaintiff advised that they could not agree to the modifications proposed in the drawing submitted to the Court. I concluded that the revised drawing showed sufficient differences, that with minor modifications, any objection on the part of the Plaintiff had to do with seeking to avoid competition rather than to avoid trade dress infringement. Accordingly, I ruled that the Defendants could begin manufacture of a stand mixer consistent with the drawing faxed to me in Fort Worth with one additional modification. The Defendant also advised me that the one change to the handle which they proposed to make could not be immediately made without delaying Defendant from being able to immediately market its product. I gave the Defendant two months to make that change. Additionally, because I was of the opinion that it would take a little more time to make the change to the face plate which I had required, I gave the Defendant six months to make that change. These findings and rulings were made by the Court in an effort to exercise its equitable powers and to protect the Plaintiff from trade dress infringement and yet allow the Defendant an opportunity to freely compete with Plaintiff so long as Defendant did not infringe upon Plaintiff's trade dress and consistent with the safe distance rule.

Immediately upon my return from the Fifth Circuit Conference in Fort Worth, the Defendant had delivered to the Court an

additional prototype and requested me to approve Defendant's manufacture of a stand mixer as represented by the prototype presented. This would have been on May 9. The prototype presented to me at that time was considerably different than the drawing of the proposed prototype as presented to me in Fort Worth. Defense counsel explained to me that when they actually tried to implement the production of a prototype as represented by the drawing presented to me in Fort Worth, it was not possible to do so because of the control knob contacting the stand. I concluded that when the Defendant presented the prototype on May 9 and had changed it from the drawing presented to me in Fort Worth, that the product again too closely resembled Plaintiff's product to comport with the safe distance rule. I again instructed the parties to confer and see if they could not agree upon the design changes that would be necessary to avoid trade dress infringement since I had already narrowed the differences between the parties. The parties were still unable to agree upon changes that should be made to avoid trade dress infringement and to comport with the safe distance rule. On the following day, May 10, the parties were before the Court again and still had not been able to agree upon the changes to be made. Because I did not have the ability to know what is feasible from a design standpoint I gave the Defendant a couple of options either of which I felt would make the product sufficiently different from the Plaintiff's product to avoid trade dress infringement comport with the safe distance rule and to allow the Defendant to commence manufacture and sale of its product in a reasonably expeditious time period. An order was entered accordingly.

This the 23rd day of May, 1996.

s/ Charles W. Pickering, Sr.
CHARLES W. PICKERING, SR.
UNITED STATES DISTRICT JUDGE

APPENDIX F — ORDER APPROVING STATEMENTS OF PROCEEDINGS AS SUBMITTED BY DEFENDANT OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF MISSISSIPPI, HATTIESBURG DIVISION FILED JUNE 27, 1996 WITH ATTACHED STATEMENTS OF PROCEEDINGS

IN THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF MISSISSIPPI
HATTIESBURG DIVISION

CIVIL ACTION NO. 2:96-CV-148PS

SUNBEAM PRODUCTS, INC.

PLAINTIFF

VS.

THE WEST BEND COMPANY

DEFENDANT

ORDER APPROVING STATEMENTS OF PROCEEDINGS AS SUBMITTED BY DEFENDANT

This cause coming to be heard on submittal by the defendant of Statement of Proceedings On May 4, 1996 At Judge Pickering's Residence When No Report Was Made and Statement of Proceedings In May 6, 1996 Court Teleconference When No Report Was Made, and the Court, having considered the same pursuant to Appellate Rule 10(c),

IT IS HEREBY ORDERED:

That said Statements of Proceedings be approved and included by the Clerk of this Court in the record on appeal.

Appendix F

BY THE COURT:

s/ Charles W. Pickering, Sr.
Charles W. Pickering, Sr., Judge

Dated: June 27th 1996.

Appendix F

IN THE UNITED STATES DISTRICT COURT FOR THE
SOUTHERN DISTRICT OF MISSISSIPPI
HATTIESBURG DIVISION

Civil Action No. 2:96CV148PS
Judge Pickering

SUNBEAM PRODUCTS, INC.,

Plaintiff,

v.

THE WEST BEND COMPANY,

Defendant.

STATEMENT OF PROCEEDINGS
ON MAY 4, 1996 AT JUDGE PICKERING'S RESIDENCE
WHEN NO REPORT WAS MADE

This statement is made by West Bend for inclusion in the record of the case pursuant to Rule 10(c) of the Rules of Appellate Procedure. This statement was supplemented by including, *in **bold type** below*, the "additional materials" stated by Sunbeam's counsel in an "objection and response" paper just provided to the undersigned West Bend counsel; all of Sunbeam's "additional materials" are included verbatim (on pages 2 and 4).

The hearing began shortly after 1 p.m. at Judge Pickering's residence. In addition to Judge Pickering, Paul Walters was present for the Court. The following persons participated for the parties:

Appendix F

For Sunbeam: Neville H. Boschert, attorney, for the entire session; and Michael J. Kline, attorney (in Pittsburgh), joining by speakerphone when the session resumed after a break.

For West Bend: Peter N. Jansson, attorney; Neil Halvorson, West Bend Vice President and General Counsel; and Debra Kumm, West Bend Vice President, Marketing.

* * * * *

Mr. Jansson gave Judge Pickering and Mr. Walters an original and one copy of West Bend's "Emergency Motion for Clarification." A copy was hand-delivered to Mr. Boschert and had been faxed to Mr. Kline. Mr. Jansson also gave Judge Pickering a revised West Bend prototype stand mixer, which mixer was depicted in a photograph attached to the West Bend motion. A Sunbeam stand mixer was also provided.

Mr. Boschert gave Judge Pickering and Mr. Jansson a letter in opposition to West Bend's motion, including copies of certain cases referred to in the letter.

The following is a brief summary of the proceedings which followed:

Mr. Jansson thanked Judge Pickering for agreeing to hold the hearing at his farm.

Upon looking at the revised West Bend prototype, the judge said that, after he had heard a description by telephone of the revisions proposed by West Bend (during his brief tel[illegible]onference

early Friday evening with the parties' attorneys), he had thought the revised prototype would look more different (from Sunbeam's product) than it now seemed to him. The judge said he still sees more similarities than differences.

The judge raised the possibility of West Bend's making the product "battleship gray" instead of white. In response, Ms. Kumm said that such a product would be ugly — that West Bend's product would have to be something it could sell. Mr. Jansson said that white is a common color for small kitchen appliances.

Mr. Jansson argued that the revised prototype had numerous changes, including all the changes which the judge had indicated, at the end of the preliminary injunction hearing on Wednesday, May 1, 1996, would make the West Bend product enough different that Sunbeam would have "no case" — and including changes beyond such specific changes.

Mr. Boschert said that he considered the proposed West Bend product essentially the same as the product complained of. He argued that a "safe-distance" rule required that the West Bend product be much more different than the revised prototype.

Mr. Boschert said that West Bend should not be allowed to proceed so quickly, and that West Bend could have contacted Sunbeam the previous day, before the judge's decision was issued late in the afternoon, rather than wait until after the fact. **Mr. Boschert stated that it was not until Saturday morning, May 4, 1996, that he became aware that West Bend intended to present a prototype of a revised mixer to the Court at the 1:00 p.m. hearing on May 4. Mr. Boschert also stated how he had never been provided any photographs of the revised**

mixer that could be shown to appropriate persons at Sunbeam for comment. Mr. Boschert stated how West Bend had all of these materials on Friday, May 3, and could have provided them to him and/or Mr. Kline on behalf of Sunbeam on Friday in order that these materials could have been communicated to Sunbeam personnel.

Mr. Jansson responded (1) that Sunbeam had not previously responded positively to any proposed change, (2) that West Bend had expected an earlier decision (rather than at the end of the day), (3) that West Bend had stood ready with a prototype having all of the changes which the judge had indicated (on May 1) would make the West Bend product acceptable to the Court, and (4) that additional changes were made on Friday night, May 3.

The judge asked Mr. Boschert to make suggestions for more change.

Mr. Boschert made suggestions involving a substantially revised handle and motor housing structure and a change in the control knob location.

In response, Mr. Jansson pointed out that such changes would require such complete reworking of the design and of the major molds that it would be impossible for West Bend to provide a product on time for the current selling season.

Mr. Jansson also said that the accused product had been designed to be different from Sunbeam's product design in many respects, and that it was based on a different form language. The judge pointed out that he had made a finding that West Bend had copied Sunbeam's product.

Appendix F

During the discussion of proposed changes, the judge noted and stated that the underside of the Sunbeam motor housing was substantially flattened, and that this differed from the West Bend product. In a discussion of a proposed change in the faceplate to a round shape, as suggested by Mr. Boschert, the judge noted that the Sunbeam face plate had a round element and that the West Bend faceplate differs from Sunbeam's not just in being white (instead of chrome), but in its face configuration.

The judge raised the idea of his requiring that a "Made in China" marking be placed boldly on the side of the West Bend product, but withdrew that suggestion without further discussion. The judge pressed Mr. Boschert for other suggestions of further change, but no other suggestions were made at that time.

The judge decided to take the revised West Bend prototype and the Sunbeam product downstairs for others at his residence to view — to get their reading on whether the products looked alike. The judge and Mr. Walters were gone from the room for several minutes. Upon returning, the judge said that he had shown the two products to several people, including his son, his daughter-in-law, his sister and a housekeeper, and that he himself was "the only one" who thought the products looked alike.

The judge stated that West Bend had made progress in avoiding trade dress infringement, but that he felt he had made the correct ruling on preliminary injunction. He said that West Bend had copied, and that he was not prepared at this time to conclude that the revised product was acceptable. He said that Sunbeam should cooperate in the process of West Bend's product

revision and that, in the absence of Sunbeam's input, he would have to consider giving West Bend relief.

Mr. Boschert objected he was not in a position to make suggestions and recommendations alone, and that it would be desirable for him to consult with his client and with Mr. Kline. The judge suggested that Mr. Boschert should do so, and a recess was taken so that Mr. Boschert could call Mr. Kline.

After fifteen minutes or so, the session resumed with Mr. Kline joining by speakerphone.

Mr. Kline indicated that he could not react because neither he nor his client had seen the revised prototype. Mr. Kline said that he didn't know where Sunbeam people were, but that he knew they were gone.

Ms. Kumm pointed out that she knew both West Bend and Sunbeam officials would be at the Gourmet Show in San Francisco. She said that she knew who from Sunbeam typically went to such a trade show, and that key people who could deal with this matter would be present.

Mr. Boschert stated that Sunbeam already had the relief it had sought, and that Sunbeam, therefore, had no incentive to work with West Bend. The judge said that the parties should be in contact to resolve the matter, and that he would look for more input and then consider giving West Bend relief, depending upon what happened.

As the session was breaking up, and everyone present had gone downstairs, Mr. Jansson said West Bend was concerned that Sunbeam might not make itself available, since it had no

interest in West Bend's being able to proceed with a product. The judge indicated to the attorneys that Sunbeam people should make themselves available to try to resolve the matter with West Bend in good faith and that, if they didn't, then he would allow West Bend to proceed.

Mr. Boschert stated that Sunbeam would make a good faith effort to communicate with West Bend in an attempt to resolve this matter if possible, but that locating and communicating with the appropriate Sunbeam personnel on Saturday afternoon and Sunday morning without prior notice would be difficult.

Upon Mr. Jansson's request, the judge, who had indicated that he would be attending the Fifth Circuit Judicial Conference in Fort Worth, Texas, which was about to begin, also gave notice to the parties of certain hours during which he expected to be available in Fort Worth on Sunday, May 5, 1996. He indicated that the parties could meet with him in Fort Worth or contact him by telephone conference during those times.

Everyone thanked the judge for his hospitality at his farm.

This statement is submitted on behalf of The West Bend Company, supplemented by input from Sunbeam.

Respectfully submitted,

JANSSON & SHUPE, LTD.

By s/ Peter Jansson
One of the attorneys for
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Appendix F

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Appendix F

IN THE UNITED STATES DISTRICT COURT FOR THE
SOUTHERN DISTRICT OF MISSISSIPPI
HATTIESBURG DIVISION

Civil Action No. 2:96CV148PS
Judge Pickering

SUNBEAM PRODUCTS, INC.,

Plaintiff,

v.

THE WEST BEND COMPANY,

Defendant.

**STATEMENT OF PROCEEDINGS
ON MAY 6, 1996 COURT TELECONFERENCE
WHEN NO REPORT WAS MADE**

This statement is made by West Bend for inclusion in the record of the case pursuant to Rule 10(c) of the Rules of Appellate Procedure. This statement was supplemented by including, *in **bold type** below*, the "additional material" (one sentence) stated by Sunbeam's counsel in an "objection and response" paper just provided to the undersigned West Bend counsel; Sunbeam's additional sentence is included verbatim (spanning pages 4 and 5).

The statement is presented in transcript form because Mr. Halvorson took detailed notes of what was stated for much of the conference. Nothing noted was omitted, but Mr. Halvorson's notes, since a bit incomplete, were supplemented by joint

recollections of Mr. Halvorson, Ms. Kumm and Mr. Jansson. There was no tape recording, of course, so word-for-word accuracy is not possible. The review by Sunbeam's counsel and his "additional material" (now included), confirm the accuracy of this statement.

The Court teleconference began at 8:37 a.m. CDT, Judge Pickering (in Fort Worth, TX) presiding. The following persons participated:

> For Sunbeam: Michael J. Kline (in San Francisco) and Neville H. Boschert (in Jackson, MS), attorneys; David Sergeant (in Fort Lauderdale, FL), Sunbeam General Counsel.
>
> For West Bend: Peter N. Jansson (in San Francisco), attorney; Neil Halvorson (in San Francisco), West Bend Vice President and General Counsel; and Debra Kumm (in San Francisco), West Bend Vice President, Marketing.

* * * * *

Judge: What does Sunbeam think about West Bend's latest prototype?

Kline: We have viewed it. We argued in the preliminary injunction hearing a specific form of trade dress which included the color and shape of the Sunbeam 2360. Had we seen this latest West Bend prototype at the hearing, our arguments would have been different.

The essence of Sunbeam's trade dress on the 2360 is its shape and, as you know, Judge, we've filed a

trademark application on the silhouette of that shape. I have confirmed, from my examination of West Bend's latest prototype, that this latest West Bend prototype still copies Sunbeam's silhouette, except that West Bend's prototype is bigger than Sunbeam's product. The changes West Bend has now proposed are only cosmetic — so it still infringes.

Furthermore, we need to see the additional changes proposed by West Bend. The drawing provided here is not enough. Until we see engineering drawings or a physical sample, we can't respond to West Bend's offer.

Jansson: Judge, can I respond?

Judge: No. Here's what I'm going to do:

I don't think there's any question that West Bend attempted to manufacture a product as close to Sunbeam as West Bend could get away with legally in the Seventh Circuit, where competition is emphasized over intellectual property rights. Unfortunately you found yourselves here in the Fifth Circuit where we emphasize intellectual property rights over competition. I spoke to Justice Scalia. He tells me the Supreme Court will only grant certiorari when there is a split between the circuits. I drafted my order on preliminary injunction carefully so as not to cause a split with the other circuits. I believe my order will withstand appeal.

As I said before, this is an extremely close case. However, Sunbeam has convinced me that they not

only want to protect their product, they want to prevent competition as well.

Kline: That's not the case, Judge. They have infringed our trade dress.

Judge: Look, Mr. Kline, you weren't shopping districts when you brought this case in Hattiesburg, you were shopping circuits. I gave you the benefit of the doubt on the TRO which I entered without notice to West Bend, causing them to scramble to get the TRO lifted. I've denied venue transfer without a full hearing to West Bend. Because of the urgency of the issues from Sunbeam's perspective, each side has had to work very hard to keep up with the procedures involved with the preliminary injunction hearing. Nonetheless, both of you have done a good job protecting the interests of your respective clients.

One of my findings today is that the West Bend prototype shown to me at my farm on Saturday did not meet the "safe-distance rule." However, while I was on my way to the Fifth Circuit Judicial Conference in Fort Worth, I was thinking of what West Bend could do to its prototype to distinguish it further from the Sunbeam model. I toyed with the idea of having West Bend mark its product, "West Bend, not an affiliate of Sunbeam." However, I do not believe Sunbeam wants its name anywhere near the West Bend product. I did a couple of sketches though: one involved a change in design to the knob, making the knob 1/2" to 1" larger than the taper of the motor housing; and another involved some

striping or logo on the side of the housing of the West Bend unit to make it look different than the Sunbeam.

But now I'm inclined to think that the changes to the design of the handle and power knob which West Bend has proposed is getting pretty close to what I had in mind. What do you think, Mr. Kline?

Kline: The changes proposed by West Bend are cosmetic only and, in our opinion, not enough.

Judge: Look, Mr. Kline, West Bend could have copied more of Sunbeam's functions than it has. American law allows this.

Kline: What about the torpedo shape?

Judge: In 1979 Sunbeam changed the torpedo shape when it squared off the bottom of the housing. You lost the claim to the torpedo shape then.

The West Bend prototype shown on the farm Saturday came close to not infringing, but not quite, but the additional changes West Bend is now offering are enough. I'll give you all the opportunity of a hearing back in Hattiesburg to put this on the record, if you wish.

Right now, I'm willing to consider additional suggestions by Sunbeam as to West Bend's latest offer, then I'm going to rule.

Kline: If they could just change the teardrop.

Appendix F

Judge: How?

Kline: Make it round.

Judge: The changes to the faceplate already offered by West Bend are enough for now. I'm not adverse to allowing West Bend to get into the market with the white teardrop and then require a running change in the design of the teardrop after that.

Mr. Kline, your problem is that even though Sunbeam has had a teardrop since 1979, the chrome upper part of it is flat and it has a circle configuration matching the configuration of the housing in the lower part which is different from what West Bend has proposed.

Kline: Our problem will be what do we have to do with our designs to avoid West Bend in the future?

Jansson: West Bend's faceplate is significantly different than Sunbeam's. It covers all of the edges of the motor housing. We are offering compromise on the soft overall look of our product in changing the power dial, but we are not offering additional change to the faceplate. We also are offering to put a decal on the base.

Judge, West Bend never intended to deceive the public.

Judge: I have already found that West Bend copied the Sunbeam trade dress. In the Fifth Circuit, that's enough.

Jansson: We are not intending to challenge the Court's findings at this stage of the proceedings.

Judge: I'm going to make my ruling now. If you want to discuss any of the elements of my ruling amongst yourselves, you can compromise and change any part of it.

My ruling is this:

West Bend can manufacture and sell the stand mixer that was shown me at the farm on Saturday with the following additional changes:

1. Immediately upon introduction of the product, it must have the power dial change that you have proposed, and I want to see it; **[Judge Pickering clarified that all mixers manufactured by West Bend pursuant to the Court's order must contain the flared speed control dial.]**

2. Within two months, I want West Bend to add the handle redesign as a running change;

3. Within six months, I want the teardrop faceplate completely removed and redesigned; and

4. I want West Bend to add logos to the base and to the opposite side of the motor housing.

Finally, I will allow either or both parties the opportunity to request a hearing to make an immediate record for appeal.

Appendix F

My ruling today is based upon my findings:

1. That West Bend copied Sunbeam's trade dress; and

2. That Sunbeam is trying to prevent competition in the stand mixer market.

Now that I've made this ruling, can I have the following agreement: that the preliminary injunction is in effect as modified by today's order and that Sunbeam does not have to post a bond for the preliminary injunction to take effect?

Jansson: Judge, we are not waiving damages resulting from the preliminary injunction; we want to be able to prove damages.

Judge: Fine, Sunbeam does not have to post bond, but West Bend is not waiving its claim for damages.

Jansson: Judge, regarding the changes, they may end up not looking exactly like the rough sketch. These have not yet been engineered, but the concepts will be followed.

Judge: Variation is acceptable.

Kline: Can West Bend send us whatever drawings it comes up with for the proposed changes?

Jansson: We'll send drawings within two days of their finalization.

Appendix F

Judge: West Bend should create the designs and send the drawings to Sunbeam within one day of their creation — by overnight mail.

Kline: Can we have the right to reopen should consumer confusion actually occur with the revised product?

Judge: I'll give you a hearing so you can make a record.

[Brief comments by the judge concerning *Two Pesos*.]

Conference call concluded at 9:00 a.m. CDT.

This statement is submitted on behalf of The West Bend Company, supplemented by input from Sunbeam.

Respectfully submitted,

JANSSON & SHUPE, LTD.

By s/ Peter Jansson
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APPENDIX G — ORDER OF THE UNITED STATES DISTRICT COURT FOR THE SOUTHERN DISTRICT OF MISSISSIPPI, HATTIESBURG DIVISION FILED AUGUST 7, 1996

THE UNITED STATES DISTRICT COURT
FOR THE SOUTHERN DISTRICT OF MISSISSIPPI
HATTIESBURG DIVISION

CIVIL ACTION NO. 2:96cv148PG

SUNBEAM PRODUCTS, INC.

PLAINTIFF

VERSUS

THE WEST BEND COMPANY

DEFENDANT

ORDER

On July 31, 1996, on one day's notice The West Bend Company delivered to the Court in the presence of counsel for Sunbeam a stand mixer with the request that the Court approve this stand mixer as being in compliance with Order Modifying Preliminary Injunction which was entered by this Court on May 14, 1996, and as further amended by Order Further Modifying Preliminary Injunction entered by this Court on May 16, 1996. The Court allowed Plaintiff three days to submit a response to defendant's design changes, and having considered said response together with defendant's request finds as follows:

In a previous Order of this Court this Court followed the Fifth Circuit Opinion in *Eskay Drugs, Inc. v. Smith, Kline & French Laboratories*, 188 F.2d 430, 432; 89 U.S.P.Q. 202 (5th

Cir. 1951). This case discussed the safe-distance rule which is elaborated on in McCarthy on Trademarks §30.13. The stand mixer presented to this Court by Defendant West Bend on July 31, 1996, is in direct conflict with the Orders of this Court which were entered on May 14 and 16, 1996. Defendant West Bend has altered the knob from the product that West Bend is now marketing so that the proposed change on the knob is in direct conflict with this Court's Orders of May 14 and 16, 1996. Under the teachings of the safe-distance rule, this Court declines to further modify its Orders of May 14 and 16, 1996. The Court finds that what creates the similarity and prevents West Bend from having complied with the teachings of the safe-distance rule is that the tapered shape of the whole unit when combined with the shape of the knob is not far enough removed from the design of the Sunbeam mixer to comport with the safe-distance rule. If this Court were considering the design of the mixer presented by West Bend on July 31, 1996, as a first impression and if this Court had not already entered a finding that West Bend infringed on Sunbeam's trade dress, the conclusion might be different. But the proposed mixer presented on July 31, 1996, is not designed consistent with this Court's Orders of May 14 and 16, 1996, and this Court sees no reason to disturb those Orders or to allow West Bend to come closer to utilizing Sunbeam's trade dress than allowed by those two Orders. Having infringed Sunbeam's trade dress, West Bend simply cannot come this close to continuing to utilize Sunbeam's trade dress. The stand mixer presented by West Bend on July 31, 1996, complies with this Court's previous Orders in all respects except the dial knob.

SO ORDERED AND ADJUDGED this the 6th day of August, 1996.

s/ Charles W. Pickering, Sr.
CHARLES W. PICKERING, SR.
UNITED STATES DISTRICT JUDGE

APPENDIX H — CONSTITUTIONAL PROVISIONS, STATUTES AND REGULATIONS

ARTICLE I. Sec. 8, of the United States Constitution

> Congress shall have the power . . . to regulate Commerce with foreign Nations, and among the several States, and with the Indian Tribes;
>
> Congress shall have the power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

15 U.S.C. § 1121(a) Jurisdiction of Federal courts; . . .

> (a) The district and territorial courts of the United States shall have original jurisdiction and the courts of appeal of the United States (other than the United States Court of Appeals for the Federal Circuit) shall have appellate jurisdiction, of all actions arising under this chapter, without regard to the amount in controversy or to diversity or lack of diversity of the citizenship of the parties.

15 U.S.C. § 1125 False designations of origin, false descriptions, and dilution forbidden

(a) Civil action

> (1) Any person who, on or in connection with any goods or services, or any container for goods, uses in commerce any word, term, name, symbol, or device, or any combination thereof, or any false

designation of origin, false or misleading description of fact, or false or misleading representation of fact, which —

> **(A)** is likely to cause confusion, or to cause mistake, or to deceive as to the affiliation, connection, or association of such person with another person, or as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person, or
>
> **(B)** in commercial advertising or promotion, misrepresents the nature, characteristics, qualities, or geographic origin of his or her or another person's goods, services, or commercial activities,

shall be liable in a civil action by any person who believes that he or she is or is likely to be damaged by such act.

(2) As used in this subsection, the term "any person" includes any State, instrumentality of a State or employee of a State or instrumentality of a State acting in his or her official capacity. Any State, and any such instrumentality, officer, or employee, shall be subject to the provisions of this chapter in the same manner and to the same extent as any nongovernmental entity.

(c) Remedies for dilution of famous marks

(1) The owner of a famous mark shall be entitled, subject to the principles of equity and upon such terms as the court deems reasonable, to an injunction against another person's commercial use in commerce of a mark or trade name, if such use begins after the mark has become famous and causes dilution of the distinctive quality of the mark, and to obtain such other relief as is provided in this subsection. In determining whether a mark is distinctive and famous, a court may consider factors such as, but not limited to —

(A) the degree of inherent or acquired distinctiveness of the mark;

(B) the duration and extent of use of the mark in connection with the goods or services with which the mark is used;

(C) the duration and extent of advertising and publicity of the mark;

(D) the geographical extent of the trading area in which the mark is used;

(E) the channels of trade for the goods or services with which the mark is used;

(F) the degree of recognition of the mark in the trading areas and channels of trade used by the marks' owner and the person against whom the injunction is sought;

(G) the nature and extent of use of the same or similar marks by third parties; and

(H) whether the mark was registered under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register.

(2) In an action brought under this subsection, the owner of the famous mark shall be entitled only to injunctive relief unless the person against whom the injunction is sought willfully intended to trade on the owner's reputation or to cause dilution of the famous mark. If such willful intent is proven, the owner of the famous mark shall also be entitled to the remedies set forth in sections 1117(a) and 1118 of this title, subject to the discretion of the court and the principles of equity.

(3) The ownership by a person of a valid registration under the Act of March 3, 1881, or the Act of February 20, 1905, or on the principal register shall be a complete bar to an action against that person, with respect to that mark, that is brought by another person under the common law or a statute of a State and that seeks to prevent dilution of the distinctiveness of a mark, label, or form of advertisement.

(4) The following shall not be actionable under this section:

(A) Fair use of a famous mark by another person in comparative commercial

advertising or promotion to identify the competing goods or services of the owner of the famous mark.

(B) Noncommercial use of a mark.

(C) All forms of news reporting and news commentary.

28 U.S.C. § 1254(1) Courts of Appeal; certiorari; certified questions

Cases in the courts of appeal may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment or decree;

28 U.S.C. § 1292(a)(1) Interlocutory decisions

(a) Except as provided in subsections (c) and (d) of this section, the courts of appeals shall have jurisdiction of appeals from:

(1) Interlocutory order of the district courts of the United States, the United Stats District Court for the District of the Canal Zone, the District Court of Guam, and the District Court of the Virgin Islands, or of the judges thereof, granting, continuing, modifying, refusing or dissolving injunctions, or refusing to

dissolve or modify injunctions, except where a direct review may be had in the Supreme Court;

28 U.S.C. § 1338(a) and (b) Patents, plant variety protection, copyrights, mask works, trade-marks, and unfair competition

(a) The district courts shall have original jurisdiction of any civil action arising under any Act of Congress relating to patents, plant variety protection, copyrights and trade-marks. Such jurisdiction shall be exclusive of the courts of the states in patent, plant variety protection and copyright cases.

(b) The district courts shall have original jurisdiction of any civil action asserting a claim of unfair competition when joined with a substantial and related claim under the copyright, patent, plant variety protection or trade-mark laws.

35 U.S.C. § 154(a)(2) and (c)(1) Contents and term of patent

(a) In general —

(2) Term. — Subject to the payment of fees under this title, such grant shall be for a term beginning on the date on which the patent issues and ending 20 years from the date on which the application for the patent was filed in the United States or, if the application contains a specific

reference to an earlier filed application or applications under section 120, 121, or 365(c) of this title, from the date on which the earliest such application was filed.

(c) Continuation —

(1) Determination. — The term of a patent that is in force on or that results from an application filed before the date that is 6 months after the date of the enactment of the Uruguay Round Agreements Act shall be the greater of the 20 year-term as provided in subsection (a), or 17 years from grant, subject to any terminal disclaimers.

35 U.S.C. § 171 Patents for Design

Whoever invents any new, original and ornamental design for an article of manufacture may obtain a patent therefor, subject to the conditions and requirements of this title.

The provisions of this article relating to patents for inventions shall apply to patents for designs, except as otherwise provided.

35 U.S.C. § 173 Term of Design Patent

Patents for design shall be granted for the term of fourteen years.

Appendix H

***Manual of Patent Examining Procedure (MPEP)* 1502: Definitions of a Design**

The design of an object consists of the visual characteristics or aspects displayed by the object. It is the appearance presented by the object which creates a visual impact upon the mind of the observer.

Since a design is manifested in appearance, the subject matter of a design patent application may relate to the configuration or shape of an object, to the surface ornamentation on an object, or both.

Design is inseparable from the object to which it is applied and cannot exist alone merely as a scheme of surface ornamentation. It must be a definite, preconceived thing, capable of reproduction and not merely the chance result of a method.

***MPEP* 1502.01: Distinction Between Design and Utility Patents**

In general terms, a "utility patent" protects the way an article is used and works (354 U.S.C. 101), while a "design patent" protects the way an article looks (35 U.S.C. 171). The ornamental appearance of an article includes its shape/configuration or surface ornamentation upon the article, or both. Both design and utility patents may be obtained on an article if invention resides both in its utility and ornamental appearance.

OPPOSITION

BRIEF

Supreme Court, U.S.
FILED
APR 13 1998
CLERK

No. 97-1317

In The

Supreme Court of the United States

October Term, 1997

THE WEST BEND COMPANY,

Petitioner,

vs.

SUNBEAM PRODUCTS, INC.,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

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RULE 29.6 STATEMENT

Respondent, Sunbeam Products, Inc., is a wholly owned subsidiary of Sunbeam Corporation, formerly known as Sunbeam-Oster Company, Inc. Respondent Sunbeam Products, Inc., does not have any nonwholly owned subsidiaries, except for qualifying or other nominal shares as required for foreign subsidiaries.

TABLE OF CONTENTS

	Page
Rule 29.6 Statement	i
Table of Contents	ii
Table of Citations	iii
Introduction	1
Counterstatement of the Case and the Facts	1
A. Procedural History	1
Reasons for Denying the Writ	4
I. The Fifth Circuit Court Of Appeals' Opinion Affirming The District Court's Grant Of A Preliminary Injunction Is Not In Conflict With Decisions From This Court Or With Decisions From Other Courts Of Appeal.	4
A. Federal Case Law Regarding The Applicability Of Trade Dress Protection Under Section 43(a) Of The Lanham Act Is Unambiguous And Has Been Uniformly Applied.	5
B. Any Difference In The Results Reached By The Circuit Courts Is Due To Differences In The Facts Of Each Case	9

Contents

Page

C. There Is No Conflict Between Trademark And Patent Law 12

II. The Fifth Circuit's Opinion Did Not Address The Question Of Whether The Product Configuration Of A Stand Mixer, Never Registered As A Trademark, Can Be A "Famous Trademark" Within The Meaning Of The Federal Anti-Dilution Act, 15 U.S.C. § 1125(c), And Therefore This Question Is Not Ripe For Adjudiciation By This Court. 19

III. This Court Should Not Issue A Writ Of Certiorari To Review A Decree Of The Fifth Circuit Court Of Appeals On Appeal From An Interlocutory Order Granting A Preliminary Injunction Where There Are No Extraordinary Questions Of Federal Law And Where All Of The Factual And Evidentiary Issues Raised By The Petition May Be Addressed On The Merits At Trial. 20

Conclusion 23

TABLE OF CITATIONS

Cases Cited:

American Construction Co. v. Jacksonville, T.&K.R. Co., 148 U.S. 372 (1893) 21

Black & Decker, Inc. v. Hoover Service Center, 886 F.2d 1285 (Fed. Cir. 1989) 13

Contents

Page

Blue Bell Bio-Medical v. Cin-Bad, Inc., 864 F.2d 1253 (5th Cir. 1989) 13, 18

Clamp Mfg. Co., Inc. v. Enco Mfg. Co., Inc., 870 F.2d 512 (9th Cir. 1989) 13

Davis v. United States, 417 U.S. 333 (1974) 9

Dorr-Oliver, Inc. v. Fluid-Quip, Inc., 94 F.3d 376 (7th Cir. 1996) 5, 6, 7, 8, 10

Duigan v. United States, 274 U.S. 195 (1927) 19, 20

Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd., 40 F.2d 1431 (3d Cir. 1994) 7, 10

Elmer v. ICC Fabricating, Inc., 67 F.3d 1571 (Fed. Cir. 1995) 8, 11, 16

Epic Metals Corp. v. Souliere, 99 F.3d 1034 (11th Cir. 1996) 6

Estelle v. Gamble, 429 U.S. 97 (1976) 21

Ferrari S.P.A. Esercizio Fabriche Automobile E. Corsi v. Roberts, 944 F.2d 1235 (6th Cir. 1991), *cert. denied*, 505 U.S. 1219 (1992) 13, 14

Fisher Stoves, Inc. v All Nighter Stove Works, Inc., 626 F.2d 193 (1st Cir. 1980) 10, 16, 17, 18

Contents

	Page
Gillespie v. United States Steel Corp., 379 U.S. 148 (1964)	21
Graver Mfg. Co. v. Linde Co., 336 U.S. 271 (1949)	11, 19
Hamilton-Brown Shoe Co. v. Wolfe Bros. & Co., 240 U.S. 251 (1916)	21, 22
In re: Application of Mogen David Wine Corp., 328 F.2d 925 (C.C.P.A. 1964)	14
In re: Honeywell, Inc., 497 F.2d 1344 (C.C.P.A. 1974), *cert. denied*, 419 U.S. 1080 (1974)	13, 14, 15
In re: Mogen David Wine Corp., 328 F.2d at 930	14
Insty Bit, Inc. v. Poly-Tech Indu., Inc.*, 95 F.3d 663 (8th Cir. 1996)	6
John Harland Co. v. Clarke Checks, Inc., 711 F.2d 966 (11th Cir. 1983)	13
Kellogg Co. v. National Biscuit Co., 305 U.S. 111 (1938)	15, 16
Kohler v. Moen, Inc., 12 F.3d 632 (7th Cir. 1993)	8, 13, 14
Landscape Forms, Inc. v. Columbia Cascade Company, 113 F.3d 373 (2d Cir. 1997)	10
Mana Products, Inc. v. Columbia Cosmetics Mfg., Inc., 65 F.3d 1063 (2d Cir. 1995)	6

Contents

Page

Meyers v. Bethlehem Corp., 303 U.S. 41 (1938) 21

OddzOn Products, Inc. v. Just Toys, Inc., 122 F.3d 1396 (Fed. Cir. 1997) 6

Park 'n' Fly v. Dollar Park and Fly, Inc., 469 U.S. 189 (1989) 13

Ross v. Moffitt, 417 U.S. 600 (1974) 22

Sno-Wizard Manufacturing, Inc. v. Eismann Products, Co., et al., 791 F.2d 423 (5th Cir. 1986) 17, 18

Stephen W. Boney, Inc. v. Boney Services, Inc., 127 F.3d 821 (9th Cir. 1997) 6

Sunbeam Products, Inc. v. West Bend Co., 123 F.3d 246 (5th Cir. 1997) 6, 16, 18

Taco Cabana Intern., Inc., v. Two Pesos, Inc., 932 F.2d 1113 (5th Cir. 1991). 18

TEC Engineering Corp. v. Budget Molders Supply, Inc., 82 F.3d 542 (1st Cir. 1996) 6

Thomas & Betts Corp. v. Panduit Corp., 65 F.3d 654 (7th Cir. 1995) 10

Tools USA v. Champ Frame Straightening, 87 F.3d 654 (4th Cir. 1996) 6

Contents

Page

Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992) 5, 6, 7, 8, 9, 10, 11, 12, 13

United States v. General Motors Corp., 323 U.S. 373 (1945) 21

United States v. Johnson, 268 U.S. 220 (1925) 11

Versa Products Co., Inc., v. Bifold Co. (Mfg.) Ltd., 50 F.3d 189 (3d Cir. 1995) 6, 7, 10

Vornado Air Circulation Systems, Inc. v. Duracraft Corp., 58 F.3d 1498 (10th Cir. 1995) 6, 8, 10, 17

Washington v. Fishing Vessel Association, 443 U.S. 658 (1979) 22

Youakim v. Miller, 425 U.S. 231 (1976) 19

Statutes Cited:

15 U.S.C. § 1125(a) 2, 5, 7, 8, 9, 12

15 U.S.C. § 1125(c) 2, 9, 19, 20

28 U.S.C. § 1254(1) 20

Contents

Page

Other Authorities Cited:

S. Res. No. 1333, 79th Cong. 2d Sess. (1946) 15

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I

INTRODUCTION

The Petition for Writ of Certiorari does not present any issue warranting this Court's review. The arguments asserted by Petitioner take extraordinary liberties with the facts and ignore the overwhelming evidence which supported the lower courts' findings and conclusions. Moreover, Petitioner's argument that there is a conflict within the circuits with respect to whether the product configuration of a kitchen appliance is entitled to trademark protection is baseless and deceptive. There is no such conflict. The disparate decisions reached by the various federal courts that have considered the issue of trade dress are not the result of any conflict or uncertainty in the law, but rather are simply a reflection of the reality that different factual circumstances lead to different evidentiary rulings and legal conclusions. As the following analysis will illustrate, there is no sound basis to review the decision of the Court of Appeals for the Fifth Circuit affirming the preliminary injunction issued by the district court.

COUNTERSTATEMENT OF THE CASE AND THE FACTS

A. Procedural History

On April 11, 1996, Sunbeam Products, Inc. ("Sunbeam") filed the present action in the District Court for the Southern District of Mississippi, Hattiesburg Division, against The West Bend Company ("West Bend" or "Petitioner") requesting a temporary restraining order and/or preliminary injunction enjoining West Bend from marketing a stand mixer that was a near replica of Sunbeam's longest selling and most popular stand mixer, Model No. 2360, known as the "American Classic Mixmaster®." The styling of the American Classic mixer had remained constant for at least 17 years and had evolved from a line of similar mixers dating back over 65 years.

Sunbeam alleged that the manufacture and sale of West Bend's mixer violated the Lanham Act, 15 U.S.C. § 1125(a); the Federal Trademark Dilution Act of 1995, 15 U.S.C. § 1125(c); and the common law of unfair competition, trade dress infringement, dilution, and false and misleading advertising. To demonstrate that West Bend had unlawfully replicated its product configuration, Sunbeam identified the following six "key design features" in the American Classic Mixmaster® that, in combination, distinguish the Sunbeam mixer from all other commercially available stand mixers:

(1) a "torpedo-shaped" housing configuration with a rounded rear-mounted speed control dial that conforms to the shape of the housing;

(2) a handle attached to the front of the housing that arches over the housing and terminates in space above the housing;

(3) a beater-eject button located on the left side of the housing beneath the handle;

(4) a "tear-drop shaped" face plate on the front of the housing;

(5) a horizontal stripe or groove along the side of the housing; and

(6) a combination of black and white features.

The district court granted a temporary restraining order ("TRO") on April 12, 1996, enjoining West Bend from marketing the West Bend mixer ("West Bend Mixer #1") and from displaying it at a pending Gourmet Show in San Francisco on May 4-8, 1996. West Bend filed a motion to quash the TRO,

which the court granted on April 16, 1996. Nevertheless, the court set a hearing for April 30, 1996 to consider Sunbeam's motion for preliminary injunction. Following the hearing, on May 3, 1996, the court granted Sunbeam's motion for a preliminary injunction and substantially reinstated the terms of the TRO.

West Bend filed an emergency motion to clarify the injunction, and proposed an alternative design for the mixer ("West Bend Mixer #2"). On May 6, 1996, the court ruled that West Bend Mixer #2 also violated the Sunbeam trade dress and was likewise prohibited by the preliminary injunction. However, the court suggested that West Bend could market a similar mixer if it modified the speed control dial.[1] The court modified the terms of the preliminary injunction to reflect this ruling on May 14, 1996.

West Bend redesigned the stand mixer and the new design ("West Bend Mixer #3") was presented to the court on May 13-14, 1996. On May 14, 1996, the court further modified the terms of the preliminary injunction to bar West Bend Mixer #3. The court eventually approved a design incorporating additional modifications. West Bend subsequently marketed this design ("West Bend Mixer #4"). The most prominent difference between West Bend Mixer #3 and #4 was the elimination of mixing speed terms from the speed control dial (*e.g.*, "mix," "beat," "stir," and "blend").

Finally, on May 23, 1996, the court entered an order and findings summarizing the scope of the preliminary injunction.

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1. In addition, the court required West Bend to make two future modifications: (1) eliminate the "middle-up arched" handle curvature by August 31, 1996; and (2) remove and redesign the faceplate by December 31, 1996.

West Bend filed a notice of appeal from the preliminary injunction, the two orders modifying it, and the final order and findings.

On July 31, 1996, West Bend submitted to the district court its design for a new mixer ("West Bend Mixer #5). On August 6, 1996, the court ruled that West Bend Mixer #5 was prohibited by the preliminary injunction, but approved a design that incorporated the nondescript speed control dial of Mixer #4 ("West Bend Mixer #6").

On August 12, 1996, West Bend filed a notice of appeal from the August 6, 1996 order, and the cases were consolidated. Following briefing and oral argument, the Court of Appeals for the Fifth Circuit affirmed the order granting the preliminary injunction on September 15, 1997. West Bend did not seek rehearing before the Fifth Circuit and, after seeking an extension of time to do so, filed the present Petition for Writ of Certiorari on February 12, 1998.

REASONS FOR DENYING THE WRIT

I.

THE FIFTH CIRCUIT COURT OF APPEALS' OPINION AFFIRMING THE DISTRICT COURT'S GRANT OF A PRELIMINARY INJUNCTION IS NOT IN CONFLICT WITH DECISIONS FROM THIS COURT OR WITH DECISIONS FROM OTHER COURTS OF APPEAL.

In its petition, West Bend attempts to fit its case within the narrow strictures of this Court's rules relating to writs of certiorari by raising the specter of a conflict between the circuit courts or a conflict between patent and trademark law. However,

a review of the law and cases cited by Petitioner quickly reveals, as discussed more fully below: (a) that the Fifth Circuit Court properly applied well-settled federal law, which has been uniformly followed by the circuit courts; (b) that any purported conflict between the circuit courts is merely a result of those courts applying the same law to different factual situations; and (c) that the Fifth Circuit Court's opinion did not decide an important question of federal law which has not previously been decided by this Court.

A. Federal Case Law Regarding The Applicability Of Trade Dress Protection Under Section 43(a) Of The Lanham Act Is Unambiguous And Has Been Uniformly Applied.

This action involves a claim of trade dress protection of Sunbeam's American Classic Mixmaster under Section 43(a) of the Trademark Act of 1946 (Lanham Act), 15 U.S.C. § 1125(a). This Court has previously addressed the issue of trade dress and has established a clear test which lower courts have had no difficulty in applying. Specifically, in *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992), this Court held that protection of trade dress under Section 43(a) requires proof that the identifying mark is "(1) . . . inherently distinctive *or* (2) has acquired secondary meaning." *Id.* at 769 (emphasis in original). Additionally, liability under Section 43(a) requires proof of a likelihood of confusion. *Id.* Finally, the Court in *Two Pesos* noted that "eligibility for protection under Section 43(a) depends on nonfunctionality." *Id.* Thus, the test to determine whether a trade dress is entitled to protection and has been infringed under Section 43(a) of the Lanham Act has three factors: (1) the trade dress must be inherently distinctive or have acquired secondary meaning; (2) there must be a likelihood of confusion; and (3) the trade dress must be non-functional.[2]

2. Some courts treat the final factor as a defense to be asserted by the party opposing trade dress protection. *See e.g., Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376, 380 (7th Cir. 1996).

The test set forth by this Court in *Two Pesos* has been applied by every circuit court except the Sixth Circuit. *TEC Engineering Corp. v. Budget Molders Supply, Inc.*, 82 F.3d 542 (1st Cir. 1996); *Mana Products, Inc. v. Columbia Cosmetics Mfg., Inc.*, 65 F.3d 1063 (2d Cir. 1995); *Versa Products Co., Inc., v. Bifold Co. (Mfg.) Ltd.*, 50 F.3d 189 (3d Cir. 1995); *Tools USA v. Champ Frame Straightening*, 87 F.3d 654 (4th Cir. 1996); *Sunbeam Products, Inc. v. West Bend Co.*, 123 F.3d 246 (5th Cir. 1997); *Dorr-Oliver, Inc. v. Fluid-Quip, Inc.*, 94 F.3d 376 (7th Cir. 1996); *Insty* Bit, Inc. v. Poly-Tech Indu., Inc.*, 95 F.3d 663 (8th Cir. 1996); *Stephen W. Boney, Inc. v. Boney Services, Inc.*, 127 F.3d 821 (9th Cir. 1997); *Vornado Air Circulation Systems, Inc. v. Duracraft Corp.*, 58 F.3d 1498 (10th Cir. 1995); *Epic Metals Corp. v. Souliere*, 99 F.3d 1034 (11th Cir. 1996); *OddzOn Products, Inc. v. Just Toys, Inc.*, 122 F.3d 1396 (Fed. Cir. 1997). These courts have applied the *Two Pesos* test in a variety of factual situations, from the appearance of a catalog, *see Tools USA*, to various product configurations, *see Sunbeam* and *Vornado*, to the appearance of a grocery store's vegetable displays, *see Stephen W. Boney, Inc.* Of course, due to factual differences in the nature of the trade dress at issue, not every case has resulted in a finding of a protectable trade dress. This does not mean, however, that there is a conflict between the circuits as Petitioner disingenuously asserts. It merely emphasizes how these types of cases are resolved based upon the specific and unique factual distinctions. A conflict between the circuits arises where two circuit courts apply different law to similar facts, not where the courts reach different results applying the same law to different facts.[3]

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3. In *Two Pesos*, for example, the conflict involved the Fifth Circuit's ruling that trade dress protection could be shown if the dress was inherently distinctive, without proof of secondary meaning. This was in conflict with the Second Circuit's position that inherent distinctiveness alone could not establish trade dress rights.

A study of the cases cited by Petitioner confirms that no such conflict exists among the various circuit courts of appeals. For example, in *Versa Products Co., Inc.*, the court was called upon to determine whether certain control valves used in offshore oil drilling rigs were entitled to protection under Section 43(a). At the outset of its discussion, the *Versa* court summarized the applicable standard by stating:

> To obtain trade dress protection for the [valve] under section 43(a) of the Lanham Act, Versa had to prove that (a) the design was non-functional, (b) the design was inherently distinctive or distinctive by virtue of having acquired secondary meaning, and (c) there was a likelihood of confusion.

Id. at 199 (citing *Two Pesos*).

Petitioner contends another case from the Third Circuit, which was decided prior to the Third Circuit's clear adoption of the *Two Pesos* test in *Versa*, held that a product configuration could not be protected as trade dress. *Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd.*, 40 F.2d 1431 (3d Cir. 1994). Although the court applied a stricter standard than the *Two Pesos* test, the court's analysis as to whether the product in question deserved trade dress protection relied upon *Two Pesos*. *Id.* at 1439. The court noted that because *Two Pesos* dealt with the appearance of a restaurant, the test fit more comfortably with questions as to product packaging. Nevertheless, the *Duraco* court concluded that "*Two Pesos* [gives] an imprimatur to finding trade dress in a product configuration to be inherently distinctive in certain narrow circumstances." *Id.* at 1446.

Just as the Third Circuit had no difficulty in applying the *Two Pesos* test, the Seventh Circuit applied the same test in another case cited by Petitioner. In *Dorr-Oliver, Inc.*, although not citing *Two Pesos*, the court held that in order

> [t]o prevail on its action for trade dress infringement under Section 43(a), a plaintiff must establish (1) that its trade dress has either acquired secondary meaning or is inherently distinctive and (2) that the similarity of the defendant's trade dress to that of the plaintiff causes a likelihood of consumer confusion . . .

Dorr-Oliver, Inc., 94 F.3d at 380.

Finally, Petitioner cites *Vornado Air Circulation Systems, Inc. v. Duracraft Corp.*, 58 F.3d 1498 (10th Cir. 1995) and *Elmer v. ICC Fabricating, Inc.*, 67 F.3d 1571 (Fed. Cir. 1995), for the incorrect and sweeping proposition that some circuit courts refuse to enforce trade dress protection based on product configuration. However, the *Vornado* court, citing, *Two Pesos*, held that a plaintiff in a trade dress infringement case must show

> that a product's trade dress [is] inherently distinctive . . . or [has acquired] secondary meaning . . . Second, a plaintiff must show that potential customers are likely to be confused . . .

58 F.3d at 1502-03. The *Vornado* court lastly identifies functionability as a potential defense to a claim of infringement. *Id.* Similarly, the *Elmer* court, although not citing *Two Pesos*, identifies all three elements of the *Two Pesos* test in relation to a claim under Section 43(a). *See* 67 F.3d at 1578.

As support for its contention that there is a "conflict" between the circuits, Petitioner cites only one circuit court opinion decided after *Two Pesos* for the proposition that a product configuration is protectable as a trademark: *Kohler v. Moen, Inc.*, 12 F.3d 632 (7th Cir. 1993).[4] However, *Kohler*

4. Sunbeam notes that while alleging a "conflict" among the (Cont'd)

involved an application to register a trademark under § 45 of the Lanham Act, not trade dress under Section 43(a).[5] In dicta, the Seventh Circuit cited *Two Pesos* when it discussed this Court's criticism of "the Second Circuit's line of decisions refusing trade mark protection for 'unregistered . . . marks [including] . . . distinctive product designs." *Id.* at 642. This single reference to the Second Circuit, in a case that did not address Section 43(a) trade dress protection, can scarcely be considered a basis to allege that there is "a split between the appellate courts regarding the analysis of alleged product configuration marks." Petitioner's Brief at 15. Finally, the remainder of authority cited by Petitioner in its attempt to create a "conflict" consists of cases decided prior to this Court's decision in *Two Pesos*. Thus, to the extent there may have been slight variations among the circuit courts in addressing claims for unregistered trade dress, this Court resolved the matter in *Two Pesos*.

B. Any Difference In The Results Reached By The Circuit Courts Is Due To Differences In The Facts Of Each Case

Petitioner would have this Court believe that because one court found trade dress protection based on one set of facts, and another court did not find trade dress protection based on a

(Cont'd)
circuits, Petitioner has cited cases from the Seventh, Tenth, and Federal Circuits as being both for and against permitting product configuration to be protectable as trade dress. Although Sunbeam has shown that there is no actual conflict on this point, it should be noted that this Court should not be troubled to resolve disputes, real or imagined, between various panels of a circuit court. *See Davis v. United States*, 417 U.S. 333, 340 (1974).

5. Sunbeam has also sought to register its product configuration under § 45 of the Lanham Act. Although its pending applications have been allowed to publication by the Patent and Trademark Office, West Bend has opposed their registration.

separate set of facts, a conflict has arisen between the circuits. As noted above, in every post-*Two Pesos* case cited by Petitioner, the courts have consistently applied the *Two Pesos* test when addressing the issue of trade dress protection. However, in each of the cases Petitioner cites as "conflicting" with the Fifth Circuit, trademark protection or enforcement was refused, not because product configurations are not entitled to trademark protection, but because the *particular configurations involved in each case* were not entitled to trademark protection. *See Fisher Stoves, Inc. v All Nighter Stove Works, Inc.*, 626 F.2d 193 (1st Cir. 1980) (the court held that the elements of the design which were allegedly being infringed were functional); *Landscape Forms, Inc. v. Columbia Cascade Company*, 113 F.3d 373 (2d Cir. 1997) (the court denied trademark protection because the "look" of the plaintiff's furniture was not inherently distinctive, and the plaintiff failed to demonstrate secondary meaning); *Versa Products Co., Inc.*, 50 F.3d at 216 (judgment entered in favor of the plaintiff's competitor because the court found there to be no likelihood of confusion between plaintiff's directional control valve and the valve of plaintiff's competitor); *Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd.*, 40 F.3d 1431 (3d Cir. 1994) (plaintiff had not established that the configuration of its planter was entitled to trade dress protection because the planter was not inherently distinctive, and the plaintiff failed to show secondary meaning); *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654 (7th Cir. 1995) (the court denied plaintiff trademark protection for its cable ties due to the fact that the evidence presented was insufficient to establish that the shape of plaintiff's ties had acquired the secondary meaning necessary for trade dress protection); *Dorr-Oliver, Inc.*, 94 F.3d at 384 (the court held that the plaintiff failed to establish a claim of trade dress infringement because there was no likelihood of confusion between plaintiff's and defendant's cornstarch washer); *Vornado Air Systems*, 58 F.3d at 1510 (the court denied trade dress protection for plaintiff's fan grill design given that "the

configuration is a described significant inventive aspect of [an] invention . . . so that without it the invention could not fairly be said to be the same invention"); and *Elmer*, 67 F.3d at 1580 (the court ruled in favor of the defendant with respect to plaintiff's claim of trade dress infringement based on the fact that the plaintiff's vehicle-mounted advertising signs were functional).

The specific and unique factual determinations in each of the above cases are what led to a refusal to recognize or enforce trademark rights. None of these cases held *per se* that product configuration can never qualify for trade dress protection. Simply stated, there is no split of legal authority as to whether product configurations are entitled to trademark protection under the Lanham Act. As previously noted, this has already been established in the affirmative by the Supreme Court in *Two Pesos*. Whether a specific product configuration is entitled to trademark protection, however, depends on the salient facts of each case.

In addressing the reasons for granting certiorari, the Supreme Court has stated "we do not grant certiorari to review evidence and discuss specific facts." *United States v. Johnson*, 268 U.S. 220, 227 (1925). This Court further acknowledged that it is less likely to take a case for purposes of reviewing a factual issue in instances where a court of appeals has concurred with the district court's findings. *Graver Mfg. Co. v. Linde Co.*, 336 U.S. 271, 275 (1949) ("a court of law, such as this court is, rather than a court for correction of errors in fact finding, cannot undertake to review concurrent findings of fact by two courts below in the absence of a very obvious and exceptional show of error.") Although phrased as legal issues, Petitioner's alleged reasons for granting the writ are nothing but disguised attempts to dispute the factual and evidentiary findings of the lower courts.

In the present case, the district court's specific findings concluded that the configuration of Sunbeam's Mixmaster® was non-functional, was inherently distinctive, had acquired secondary meaning, and thus could be a protected trademark. The court of appeals affirmed the district court's holding on nonfunctionality and secondary meaning.[6] As both courts' decisions were overwhelmingly based on determinations of fact, West Bend's petition for review of these decisions by the Supreme Court is without merit.

C. There Is No Conflict Between Trademark And Patent Law

In another attempt to create an issue worthy of certiorari, Petitioner contends that this Court's opinion in *Two Pesos* is ambiguous and requires clarification. Petitioner posits that there is an unaddressed issue regarding the interplay between patent and trademark law. Specifically, Petitioner states that "clarification is needed on the issue of Lanham Act protection for alleged product configuration trademarks in light of the patent laws." Petitioner's Brief at 14. However, it has long been established that trade dress, which includes product configuration, is protected under Section 43(a) of the Lanham Act, which provides a federal cause of action for both trademark and trade dress infringement claims.

> Protection of trade dress, no less than of trademarks, serves the Act's purpose to secure to the owner of the mark the goodwill of his business and to protect the ability of consumers to distinguish among competing producers. National protection of trademarks is desirable, Congress concluded, because trademarks foster competition and the maintenance

6. The Fifth Circuit Court did not decide whether Sunbeam's trade dress was inherently distinctive.

> of quality by securing to the producer the benefits of a good reputation.

Two Pesos, 505 U.S. at 774 (citing *Park 'n' Fly v. Dollar Park and Fly, Inc.*, 469 U.S. 189 (1989)). Significantly, trade dress is a product's "total image and overall appearance," *Blue Bell Bio-Medical v. Cin-Bad, Inc.*, 864 F.2d 1253 (5th Cir. 1989). "Total image" includes size, shape, color, color combinations, textures, graphics and even sales techniques of a product. *John Harland Co. v. Clarke Checks, Inc.*, 711 F.2d 966 (11th Cir. 1983).

Petitioner concedes that product configurations, some of which have been the subject of design patents, have been held to be trademarks, and thus qualify for protection under the Lanham Act. *See e.g., Ferrari S.P.A. Esercizio Fabriche Automobile E. Corsi v. Roberts*, 944 F.2d 1235 (6th Cir. 1991), *cert. denied*, 505 U.S. 1219 (1992) (exterior design features of automobile, for which plaintiff previously held a design patent, held to be protectable trade dress under the Lanham Act); *Kohler Co. v. Moen Inc.*, 12 F.3d 632 (7th Cir. 1993) (design of water faucet and faucet handle registrable as a trademark); *Clamp Mfg. Co., Inc. v. Enco Mfg. Co., Inc.*, 870 F.2d 512 (9th Cir. 1989) (physical details and design of "C" clamp, which were subject of an expired utility patent, constitutes valid product configuration trademark); and *Black & Decker, Inc. v. Hoover Service Center*, 886 F.2d 1285 (Fed. Cir. 1989) (bowl shaped hand vacuum cleaner, the mechanical functions for which plaintiff had held a utility patent, entitled to trademark protection).

Courts have long held that trademark protection for a product configuration may be obtained after the expiration of a design patent covering that configuration. *In re: Honeywell, Inc.*, 497 F.2d 1344 (C.C.P.A. 1974), *cert. denied*, 419 U.S.

1080 (1974); *Kohler Co. v. Moen, Inc., supra; Ferrari S.P.A. Esercizio Fabriche Automobile E. Corse v. Roberts, supra.* Moreover,

> [c]ourts have consistently held that a product's different qualities can be protected simultaneously, or successively, by more than one of the statutory means for protection of intellectual property.

Kohler Co., 12 F.3d at 638. Indeed, the period of exclusivity conferred by the design patent may be relied upon in establishing secondary meaning for the trade dress of the design. *In re: Application of Mogen David Wine Corp.*, 328 F.2d 925, 931 (C.C.P.A. 1964). As stated by the Sixth Circuit Court:

> Trademark rights, or rights under the law of unfair competition, which happen to continue beyond the expiration of a design patent, do not "extend" the patent monopoly. They exist independently of it, under different law and for different reasons. The termination of either has no legal effect on the continuance of the other.

Ferrari, 944 F.2d at 1241 (citing *In re: Mogen David Wine Corp.*, 328 F.2d at 930).

Furthermore, the United States Court of Customs and Patent Appeals (C.C.P.A.), has determined that the prevention of confusion, mistake or deception on the public far outweighs the ability to acquire simultaneous design patent and trademark rights. As Judge Rich aptly noted:

> Federal trademark laws, which are independent in origin from the design patent laws, seek to prevent

> the public from encountering confusion, mistake, and deception in the purchase of goods and services and to protect the integrity of the trademark owner's product identity. With that distinction in mind, this Court decided that the public interest — protection from confusion, mistake, and deception in the purchase of goods and services must prevail over any alleged extension of design patent rights, when a trademark is non-functional and does in fact serve as a means to distinguish the goods of the trademark owner from those of others.

In re Honeywell, Inc., 497 F.2d at 1348.

In spite of the substantial amount of recently decided cases which support trademark protection for product configurations, Petitioner argues that affording trademark protection to product configuration is contradictory to the holding in *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111 (1938). Petitioner's reliance on *Kellogg*, however, is misplaced. First, *Kellogg* is a pre-Lanham Act case, which necessarily fails to take into consideration the meaning and purpose of the Act, namely ". . . protection to goodwill, to prevent diversion of trade through misrepresentation, and the protection of the public against the deception. . . ." S. Res. No. 1333, 79th Cong. 2d Sess. (1946).

Second, in *Kellogg*, the senior user of the biscuit shape for its shredded wheat failed to demonstrate that its biscuit shape had acquired any secondary meaning or served as an identifier of source. Rather, it is clear that the biscuit in *Kellogg* had, essentially, become generic. The *Kellogg* Court specifically stated

> [w]here an article may be manufactured by all, a particular manufacturer can no more assert exclusive rights *in the form in which the public has become*

> *accustomed to see the article and which, in the minds of the public, is primarily associated with the article than a particular producer*, than it can in the case of a name with similar connections in the public mind.

Kellogg, 305 U.S. at 120 (emphasis added). In the present case, both the District Court and the Court of Appeals held that the configuration of Sunbeam's Mixmaster® mixer did in fact serve as an identifier of source, and did distinguish Sunbeam's mixer from those sold by others. Thus, the 1938 *Kellogg* decision is not applicable to the present case, and there is no current conflict between courts regarding allowing a product configuration to acquire trademark status as a result of secondary meaning.[7]

As further support for its Petition for Certiorari, Petitioner alleges that "clarification of the functionality analysis with respect to alleged product configuration marks is needed." Petitioner's Brief at 21. Petitioner also claims that there exists "a split between the appellate courts" as to whether a combination of functional features can be nonfunctional. *Id.* at 22. Petitioner cites *Elmer* and *Fisher Stoves* as standing for the proposition that trade dress protection is not available for a product configuration that includes functional features. However, as the Fifth Circuit Court of Appeals noted in the instant case, *Elmer* "is plainly distinguishable from [this] case." *Sunbeam Products, Inc. v. West Bend Company*, 123 F.3d at 256, n.19. In *Elmer*, each and every element of the alleged trade dress was functional,

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7. In contrast, certain federal courts have split on the issue of whether trade dress in the form of product configuration could be protected as inherently distinctive, without proof of secondary meaning, which issue is not presently before this Court. *See generally*, G. Dinwoodie, *Reconceptualizing The Inherent Distinctiveness of Product Design Trade Dress*, 75 N.C.L.REV. 471, 490-91 (1997).

and the subject of a utility patent. Here, in contrast, not all of the elements of Sunbeam's Mixmaster® are functional, including, for example, the color combination and shape and open end of the handle. Furthermore, any prior utility patents owned by Sunbeam were for *individual* features of the mixer, not for the overall mixer design. Where the subject of trademark protection is an arbitrary combination of features, not individual features, such protection does not conflict with the rules of patent law.[8]

The case of *Fisher Stoves* is likewise distinguishable. In *Fisher Stoves*, unlike the present case, the lower court found that "the functional features [of plaintiff's stove] were not only the basics . . . but *the design itself*." 626 F.2d at 195 (emphasis added). The arbitrary combination of features which comprise the design of Sunbeam's Mixmaster® mixer, on the other hand, is not functional, as properly held by the district court and the court of appeals. The alleged "split between the appellate courts as to whether a combination of functional features can be non-functional" is based on the different factual determinations made with respect to individual cases, rather than any actual conflict in the law. Accordingly, no clarification of the functionality analysis is required.

As a fourth basis for granting its Petition for Certiorari, Petitioner asserts that "[i]n cases involving similar product configurations, distinctive marking of products and packaging is legally sufficient to avoid confusion as to source." Petitioner's Brief at 24. While courts have held that labeling may help to dispel consumer confusion, "the labeling of a product will not always negate a likelihood of confusion." *Sno-Wizard Manufacturing, Inc. v. Eismann Products, Co., et al.*, 791 F.2d

8. This distinguishes the present case from *Vornado*, where there was one-to-one correspondence between what was claimed to be trade dress and what had been the subject of an expired utility patent.

423, 429 (5th Cir. 1986). *See also Fisher Stoves*, 626 F.2d at 194 ("display of the manufacturer's name is not always determinative of the confusion issue"). Furthermore, likelihood of confusion is a question of fact *Blue Bell Bio-Medical*, 864 F.2d at 1260. As the Fifth Circuit noted in *Two Pesos*,

> The issue is not whether consumers can read signs and menus that identify different restaurants, but whether consumers assume some affiliation between Taco Cabana and Two Pesos.

Taco Cabana Intern., Inc., v. Two Pesos, Inc., 932 F.2d 1113, 1122 (5th Cir. 1991).

In this case, the district court concluded that the appearance of Petitioner's name on its product was not sufficient to eliminate a likelihood of confusion. *Sunbeam Products, Inc. v. West Bend Company*, 39 U.S.P.Q. 1545, 1553-4 (S.D. Miss. 1996). The Court of Appeals concurred with the District Court, noting that

> [w]hile we have recognized that labels may dispel consumer confusion, under appropriate circumstances, we have never held that this is an absolute affirmative defense to every infringement claim. To the contrary, we have also observed that the mere labeling of a product will not automatically alleviate a likelihood of confusion, *Sno-Wizard*, 791 F.2d at 429, and the ultimate determination of consumer confusion is a question of fact for the district court.

Sunbeam Products, Inc. v. West Bend Company, 123 F.3d at 259. Whether Petitioner's labeling of its infringing mixer is sufficient to preclude confusion is a fact-driven question. Because the court of appeals concurred with the district court's

findings, under *Graver Mfg. Co.*, review of this issue by the Supreme Court is not justified.

II.

THE FIFTH CIRCUIT'S OPINION DID NOT ADDRESS THE QUESTION OF WHETHER THE PRODUCT CONFIGURATION OF A STAND MIXER, NEVER REGISTERED AS A TRADEMARK, CAN BE A "FAMOUS TRADEMARK" WITHIN THE MEANING OF THE FEDERAL ANTI-DILUTION ACT, 15 U.S.C. § 1125(c), AND THEREFORE THIS QUESTION IS NOT RIPE FOR ADJUDICIATION BY THIS COURT.

Petitioner argues that granting certiorari will provide the Court with an opportunity for clarification and direction to the lower courts in defining the term "famous mark" under the Federal Anti-Dilution Act, as it applies to product configuration trademarks. In furtherance of this argument, Petitioner inaccurately states that

> [t]he Fifth Circuit affirmed the District Court's holding that the unregistered product configuration of the Sunbeam stand mixer is a "famous mark" within the meaning of the Act.

Petitioner's Brief at 26. Quite tellingly, however, the Fifth Circuit did not address this issue anywhere in its opinion.

With respect to reviewing issues not addressed by the lower courts, this Court has stated "[o]rdinarily, this Court does not decide questions not raised or resolved in the lower court." *Youakim v. Miller*, 425 U.S. 231, 234 (1976). In *Duigan v. United States*, 274 U.S. 195 (1927), the Court stressed that "[t]his court sits as a court of review. It is only in exceptional cases coming from the federal courts that questions not pressed

or passed upon below are reviewed." *Id.* at 200. In *Duigan*, for example, the Court declined to review the issue of whether a forfeiture of a leasehold was a denial of due process when the issue was not addressed by the court below.

Because the issue of whether the configuration of Sunbeam's Mixmaster® mixer qualifies as a famous trademark under 15 U.S.C. § 1125(c) was not addressed by the Fifth Circuit Court of Appeals, it should not be addressed by this Court.

III.

THIS COURT SHOULD NOT ISSUE A WRIT OF CERTIORARI TO REVIEW A DECREE OF THE FIFTH CIRCUIT COURT OF APPEALS ON APPEAL FROM AN INTERLOCUTORY ORDER GRANTING A PRELIMINARY INJUNCTION WHERE THERE ARE NO EXTRAORDINARY QUESTIONS OF FEDERAL LAW AND WHERE ALL OF THE FACTUAL AND EVIDENTIARY ISSUES RAISED BY THE PETITION MAY BE ADDRESSED ON THE MERITS AT TRIAL.

While this Court has unquestioned jurisdiction to review interlocutory judgments of federal courts of appeals pursuant to 28 U.S.C. § 1254(1), the interlocutory nature of such a judgment or order is relevant to this Court's discretionary assessment of the appropriateness of immediately reviewing it. Generally, in the context of certiorari,

> this court should not issue a writ of certiorari to review a decree of the circuit court of appeals on appeal from an interlocutory order, unless it is necessary to prevent extraordinary inconvenience and embarrassment in the conduct of the cause.

American Construction Co. v. Jacksonville, T.&K.R. Co., 148 U.S. 372, 384 (1893). Moreover, certiorari review is

> to be exercised sparingly, and only in cases of peculiar gravity and general importance, or in order to secure uniformity of decision . . . And, except in extraordinary cases, the writ is not issued until final decree.

Hamilton-Brown Shoe Co. v. Wolfe Bros. & Co., 240 U.S. 251, 258 (1916). The lack of finality in the judgment below may "of itself alone" furnish "sufficient ground for the denial of the application." *Id. See also Estelle v. Gamble*, 429 U.S. 97, 115 (1976) (Stevens, J., dissenting) (referring to "the Court's normal practice of denying interlocutory review.").

Where there is some important and clear-cut issue of law that is fundamental to the further conduct of the case and that would otherwise qualify as a basis for certiorari, the case may be reviewed despite its interlocutory status. *See Gillespie v. United States Steel Corp.*, 379 U.S. 148, 153 (1964); *United States v. General Motors Corp.*, 323 U.S. 373, 377 (1945). Furthermore, this Court has agreed to review decisions raising important jurisdictional questions which could affect the outcome of the case. In *Meyers v. Bethlehem Corp.*, 303 U.S. 41, 52 (1938), the lower court decision affirming the issuance of a preliminary injunction was reviewed on certiorari where

> there was an insuperable objection to the maintenance of the suit in point of jurisdiction and where it clearly appears that the decree was the result of an improvident exercise of judicial discretion.

Id. In the absence of some unusual factor (*i.e.*, a novel or important issue of law or important jurisdictional question),

the interlocutory nature of a lower court judgment should result in a denial of certiorari.

In the present case, no important jurisdictional question exists. As stated previously, there are no conflicts among the decisions of federal courts, nor is there an important and clear-cut issue of law that qualifies as a basis for certiorari. Simply stated, Petitioner has failed to establish that this is an "extraordinary case" requiring immediate review of an interlocutory injunction order. To the contrary, the only actual basis for Petitioner's review is its contention that the decision below was erroneous. It must be reiterated that a Petitioner fails to warrant the grant of certiorari merely because of its belief that the decision below may have been erroneous. *See, e.g., Ross v. Moffitt*, 417 U.S. 600, 616-17 (1974) ("This Court's review . . . is discretionary and depends on numerous factors other than the perceived correctness of the judgment we are asked to review."). Denial of certiorari is even more warranted here because the issues proposed to be reviewed are factual in nature and have yet to be fully developed and resolved by a fact-finder at trial.

Finally, denial of certiorari at the interlocutory stage will not prejudice the Petitioner from raising its petition at a later time once final judgment is entered, assuming the questions are properly preserved in the lower courts. *See, e.g., Washington v. Fishing Vessel Association*, 443 U.S. 658, 672 n.19 (1979); *Hamilton-Brown Shoe Co. v. Wolfe Bros. & Co.*, 240 U.S. at 258.

CONCLUSION

For the foregoing reasons, the Petition for Writ of Certiorari should be denied.

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REPLY BRIEF

Supreme Court, U.S.
FILED
APR 23 1998
OFFICE OF THE CLERK

No. 97-1317

In The

Supreme Court of the United States

October Term, 1997

THE WEST BEND COMPANY,

Petitioner,

vs.

SUNBEAM PRODUCTS, INC.,

Respondent.

On Petition for Writ of Certiorari to the United States Court of Appeals for the Fifth Circuit

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15 pp

STATEMENT PURSUANT TO RULE 29.6

Petitioner's Rule 29.6 Statement appears in the Petition.

TABLE OF CONTENTS

	Page
Statement Pursuant to Rule 29.6	i
Table of Contents	ii
Table of Citations	ii
Introduction	1
Further Reasons for Granting the Writ	1
I. There Is A Conflict Among The Circuits In Application Of Trademark Law To *Product Configurations* Claimed To Be Trademarks.	1
II. The Ruling That Sunbeam's Product Configuration Is Itself A "Famous Mark" Under The Recent Federal Anti-Dilution Act Is Ripe For Review.	6
III. Grant Of A Writ Of Certiorari Is Not Improper In A Case Involving A Preliminary Injunction.	7
Conclusion	9

TABLE OF CITATIONS

Cases Cited:

Air Line Pilots Association International v. UAL Corporation, 897 F.2d 1394 (7th Cir. 1990) 8

Contents

	Page
American Construction Co. v. Jacksonville, T.&K.R. Co., 148 U.S. 372 (1893)	8
Brooks Shoe Manufacturing Co. v. Suave Shoe Corp., 716 F.2d 854 (11th Cir. 1983)	4
Cicena Ltd. v. Columbia Telecommunications Group, 900 F.2d 1546 (Fed. Cir. 1990)	3
Compco Corp. v. Day Brite Lighting, Inc., 376 U.S. 234 (1964), *reh. denied*, 377 U.S. 913 (1964)	5
Duigan v. United States, 274 U.S. 195 (1927)	7
Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd., 40 F.3d 1431 (3d Cir. 1994)	3, 5
Estelle v. Gamble, 429 U.S. 97 (1976)	8
Ferrari S.P.A. Esercizio Fabriche Automobili E. Corsi v. Roberts, 944 F.2d 1235 (6th Cir. 1991)	4
Gillespie v. U.S. Steel Corp., 379 U.S. 148 (1964)	8
Hamilton-Brown Shoe Co. v. Wolfe Bros. & Co., 240 U.S. 251 (1916)	8
Inwood Laboratories, Inc. v. Ives Laboratories, Inc., 456 U.S. 844 (1982)	5
Kellogg Co. v. National Biscuit Co., 305 U.S. 674 (1938), *reh. denied*, 305 U.S. 674 (1938)	5

Contents

	Page
Meyers v. Bethlehem Corp., 303 U.S. 41 (1938)	8
Osem Food Industries v. Sherwood Foods, Inc., 917 F.2d 161 (4th Cir. 1990)	4
Qualitex Co. v. Jacobson Products Co., 514 U.S. 159 (1995)	2, 5
Schwinn Bicycle Co. v. Ross Bicycles, Inc., 870 F.2d 1176 (7th Cir. 1989)	4
Scott Paper Co. v. Marcalus Mfg. Co., Inc. et al., 326 U.S. 249 (1945), *reh. denied*, 326 U.S. 811 (1945)	5
Sears, Roebuck & Co. v. Stiffel Co., 376 U.S. 224 (1964), *reh. denied*, 376 U.S. 973 (1964)	5
Singer Mfg. Co. v. June Mfg. Co., 163 U.S. 169 (1896)	5
Thomas & Betts Corp. v. Panduit Corp., 65 F.3d 654 (7th Cir. 1995)	3
Two Pesos, Inc. v. Taco Cabana, Inc., 505 U.S. 763 (1992)	2, 3, 5
United States v. General Motors Corp., 323 U.S. 373 (1945)	8
Versa Products Co., Inc. v. Bifold Co. (Mfg.) Ltd., 50 F.3d 189 (3d Cir. 1995)	3, 4

Contents

	Page
Vision Sports, Inc. v. Melville Corp., 888 F.2d 609 (9th Cir. 1989)	4
Warner & Co. v. Eli Lilly & Co., 265 U.S. 526 (1924)	5
Youakim v. Miller, 425 U.S. 231 (1976)	7
Statutes Cited:	
15 U.S.C. § 1125(c)	1, 6, 8
28 U.S.C. § 1254(1)	8
28 U.S.C. § 2101(e)	8
Other Authority Cited:	
Dinwoodie, "Reconceptualizing The Inherent Distinctiveness of Product Design and Trade Dress," 75 *North Carolina Law Review* 471 (1997)	4

INTRODUCTION

The Petition for Writ of Certiorari of The West Bend Company ("West Bend") presents important public policy issues in need of this Court's review. The contrary arguments of Sunbeam Products, Inc. ("Sunbeam") are without merit and not well supported.

Sunbeam first argues there is no conflict among the circuits in application of trademark law to product configurations alleged to be trademarks. But Sunbeam bases such assertion on typical trade dress cases — *not* involving *product configurations*. A clear split exists in legal analysis and application of principles of trademark protection to *product configuration* cases.

Sunbeam also argues that the lower courts' decision that Sunbeam's stand mixer is itself a "famous mark" within the meaning of the Federal Anti-Dilution Act, 15 U.S.C. § 1125(c), is not ripe for consideration by this Court because it was not specifically dealt with by the Fifth Circuit in affirming the District Court. This contention is without merit. The issue of whether an unregistered product configuration is a "famous mark" is ripe for consideration — and is unique.

Sunbeam last argues that this Court should deny certiorari because the case involves a preliminary injunction. This argument is without merit. The trial court issued a lengthy preliminary injunction opinion after substantial hearings. It is appropriate that the issues raised by such opinion, as affirmed by the Fifth Circuit, to be addressed by this Court.

FURTHER REASONS FOR GRANTING THE WRIT

I. THERE IS A CONFLICT AMONG THE CIRCUITS IN APPLICATION OF TRADEMARK LAW TO *PRODUCT CONFIGURATIONS* CLAIMED TO BE TRADEMARKS.

Sunbeam states that trade dress law is uniformly applied by the circuits and that the discrepancies in outcome and analysis are

only due to factual differences. Sunbeam makes much of the fact that the circuits all refer (of course) to *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763 (1992), in dealing with trade dress claims, but Sunbeam never acknowledges that *Two Pesos* does *not* involve a product configuration. In fact, Sunbeam's argument draws primarily on trade dress cases *unrelated* to product configurations. Furthermore, Sunbeam chooses to ignore this Court's recent decision in *Qualitex Co. v. Jacobson Products Co.*, 514 U.S. 159 (1995), and its cautionary dictum concerning trade dress claims for *product configurations*.

Furthermore, Sunbeam ignores the fact that some circuits analyze all trade dress claims alike, whether or not they involve claims for *product configurations* as marks, while other circuits draw major distinctions between product configurations and typical trade dress.[1] Given that these analytical distinctions arise, at least in part, due to a clash between the patent laws and the Lanham Act in product configuration cases,[2] the conflict among circuits is particularly significant, and calls for resolution.

Typically, trade dress is decorative rather than a product itself. When trade dress protection is extended to product configurations, the legal implications become quite different. This should, but in some circuits does not, affect trademark analysis on matters like inherent distinctiveness, acquired distinctiveness (secondary meaning), likelihood of public confusion, and the appropriateness of presumptions resulting from a defendant's intent. There is an urgent need for clarification of the proper legal analysis in *product configuration* cases.

Sunbeam admits that there is a split among the circuits as to the proper treatment of product configurations with respect to the

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1. In this case, the Fifth Circuit expressly recognized this split in analysis between the circuits. *See* App. A, pp. 10a-12a.

2. This tension was noted in the dictum in *Qualitex*, *supra*, at 164-165, in reference to "product designs" and "features."

issue of inherent distinctiveness.[3] But Sunbeam asserts there is no *other* split among the circuits in the legal analysis of trade dress cases. This is incorrect.

For example, the Third Circuit distinguishes between packaging and product configuration in its analysis of three issues: (1) inherent distinctiveness; (2) secondary meaning; and (3) likelihood of confusion. *See Duraco Products, Inc. v. Joy Plastic Enterprises, Ltd.*, 40 F.3d 1431 (3d Cir. 1994); and *Versa Products Co., Inc. v. Bifold Co. (Mfg.) Ltd.*, 50 F.3d 189 (3d Cir. 1995) (secondary meaning and likelihood of confusion only).[4]

In the Third Circuit, the issue of secondary meaning is affected in two ways if product configurations are claimed as marks. First, the commercial success of a product does not necessarily mean that the configuration acts as a source designator and, second, intentional copying does not give rise to a presumption of secondary meaning.[5] Additionally, in the Third Circuit, clear and distinct labeling of products is considered likely to avoid confusion where product configuration is involved. *See, e.g., Versa Products*, 50 F.3d at 22.

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3. Respondent's Brief in Opposition, p. 16, n.7.

4. Both of these cases were decided after the Supreme Court decision of *Two Pesos, supra*. *Duraco* distinguishes *Two Pesos* in that *Two Pesos* was not a product configuration case. *See Duraco*, 40 F.3d at 10.

5. Likewise, the Federal Circuit Court of Appeals in *Cicena Ltd. v. Columbia Telecommunications Group*, 900 F.2d 1546, 1552 (Fed. Cir. 1990) stated, "Attempting to capitalize on a market demand for a type of product does not always indicate secondary meaning." Similarly, the Seventh Circuit, in *Thomas & Betts Corp. v. Panduit Corp.*, 65 F.3d 654, 663 (7th Cir. 1995), recognized that intentional copying of a product configuration does not result in a presumption of secondary meaning.

In contrast, other circuits, such as the Sixth, Fourth and Ninth, apply a *presumption* of secondary meaning where intentional product copying is found. *See Ferrari S.P.A. Esercizio Fabriche Automobili E. Corsi v. Roberts*, 944 F.2d 1235, 1239 (6th Cir. 1991); *Osem Food Industries v. Sherwood Foods, Inc.*, 917 F.2d 161, 163 (4th Cir. 1990); *Vision Sports, Inc. v. Melville Corp.*, 888 F.2d 609, 615 (9th Cir. 1989).

Still other circuits, such as the Seventh and Eleventh, have adopted a "blended" approach, viewing intentional copying as evidence of secondary meaning without resulting in a presumption. *Schwinn Bicycle Co. v. Ross Bicycles, Inc.*, 870 F.2d 1176, 1183 (7th Cir. 1989); *Brooks Shoe Manufacturing Co. v. Suave Shoe Corp.*, 716 F.2d 854, 859-60 (11th Cir. 1983).

A review of these cases confirms that there is a clear split among the circuits as to how to analyze and apply the presumption of secondary meaning based upon use and intentional copying where the alleged mark is a product configuration.

Furthermore, with respect to the issue of public confusion, the circuits vary in the weight given to various factors in the analysis — particularly the intent of the defendant. Some circuits recognize that, in product configuration cases, an intent to copy is not equivalent to an intent to confuse.[6] Even in the article Sunbeam cites (Dinwoodie, "Reconceptualizing The Inherent Distinctiveness of Product Design and Trade Dress," 75 *North Carolina Law Review* 471, 522 (1997)), the author refers to the different

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6. For example, in the product configuration case of *Versa Products*, 50 F.3d at 205, the Third Circuit decided that a presumption of likelihood of confusion should not arise because of the defendant's intent to copy. However, the presumption of likelihood of confusion due to a defendant's intentional copying of a product configuration was applied in the Fourth Circuit case of *Osem Food Industries*, 917 F.2d at 164, and the Ninth Circuit case of *Vision Sports*, 888 F.2d at 616. In the present case, the Fifth Circuit in its discussion of this issue did not acknowledge any difference between intent to copy and intent to create public confusion. *See* App. A, pp. 23a-24a.

approaches of the circuits on the intent issue by noting, "[T]he Third Circuit has indicated that, in a product design trade dress action, it will attach lesser weight to evidence of intentional copying in assessing secondary meaning."

A long line of Supreme Court cases, including the case of *Kellogg Co. v. National Biscuit Co.*, 305 U.S. 674 (1938), *reh. denied*, 305 U.S. 674 (1938), have recognized that important public policy concerns, particularly those concerned with the promotion of the useful arts and competition, are involved when a product configuration is claimed as a trademark.[7] Sunbeam now suggests that, as a pre-Lanham Act case, *Kellogg* is no longer good law. But *Kellogg* has never been overruled and, as stated by Justice White in his concurring opinion in *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844 (1982), in referring to the significance of pre-Lanham Act decisions, including *Warner & Co. v. Eli Lilly & Co.*, 265 U.S. 526 (1924):

> Although *Warner* and other cases were decided before §32 was enacted, the purpose of the Lanham Act was to codify and unify the common law of unfair competition and trademark protection. S. Rep. No. 1333, 79th Cong., 2d Sess. (1946). There is no suggestion that Congress intended to depart from *Warner* and other contemporary precedents.

Inwood, 456 U.S. at 861, n.2. Furthermore, cases decided after passage of the Lanham Act have cited *Kellogg* as good precedent.[8]

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7. The other cases include: *Singer Mfg. Co. v. June Mfg. Co.*, 163 U.S. 169 (1896); *Scott Paper Co. v. Marcalus Mfg. Co., Inc. et al.*, 326 U.S. 249 (1945), *reh. denied*, 326 U.S. 811 (1945); *Compco Corp. v. Day Brite Lighting, Inc.*, 376 U.S. 234 (1964), *reh. denied*, 377 U.S. 913 (1964); *Sears, Roebuck & Co. v. Stiffel Co.*, 376 U.S. 224 (1964), *reh. denied*, 376 U.S. 973 (1964); *Qualitex, supra*. It should be emphasized that *Two Pesos, supra*, did *not* involve a product configuration.

8. *See, e.g., Duraco*, 40 F.3d at 11, 13.

The differences among the circuits in legal analysis of product configurations alleged to be trademarks have encouraged forum shopping,[9] and causes uncertainty among product developers and marketers in that it cannot be predicted what elements of a design are available for use — even after patents expire.[10]

II. THE RULING THAT SUNBEAM'S PRODUCT CONFIGURATION IS ITSELF A "FAMOUS MARK" UNDER THE RECENT FEDERAL ANTI-DILUTION ACT IS RIPE FOR REVIEW.

Sunbeam argues that because the Fifth Circuit did not specifically discuss the District Court's ruling that Sunbeam's product configuration was a "famous mark" within the meaning of the Federal Anti-Dilution Act, 15 U.S.C. § 1125(c), this point is not ripe for review. However, the Fifth Circuit affirmed the decision; all of the issues in the case are ripe for appeal.

Sunbeam suggests by its position that the Supreme Court cannot address any issue that was not specifically discussed in the

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9. Even in the instant case, Judge Pickering observed that the legal analysis applied by the Fifth Circuit differs from that of the Seventh Circuit in cases involving product configurations. Judge Pickering even stated, in addressing Sunbeam's counsel, "You weren't shopping districts when you brought this case in Hattiesburg, you were shopping circuits." (App. F, p. 94a).

10. A demonstration of just how the courts are struggling with these issues in the context of product configuration protections is illustrated by Judge Pickering's decision to enjoin West Bend Mixer #3 and West Bend Mixer #5 and to approve West Bend Mixer #4 and West Bend Mixer #6. As recognized in Sunbeam's brief (at pp. 3-4), West Bend Mixer #3 was virtually identical to West Bend Mixer #4 and West Bend Mixer #5 was virtually identical to West Bend Mixer #6, except that the mixing speed terms ("mix," "beat," "stir," "blend" etc.) were removed from the dial. It is hard to understand how West Bend's use of these terms on a speed-control dial could be viewed as likely to cause public confusion.

Fifth Circuit's decision. No precedent is cited to support this strained position.

Sunbeam cites *Youakim v. Miller*, 425 U.S. 231 (1976), and *Duigan v. United States*, 274 U.S. 195 (1927), to support its argument that unless the Fifth Circuit Court of Appeals expressly discussed its reasoning for upholding a particular issue decided by the District Court, the issue is not ripe for consideration by the Supreme Court. A careful reading of both cases shows that neither case is on point. *Youakim* and *Duigan* both deal with whether an appellant can raise an issue for the first time before this Court when such issue was never previously raised by the parties or considered by the trial court.

The quotation from *Youakim* cited by Sunbeam in its brief — *i.e.*, that "[o]rdinarily, this Court does not decide questions not raised or resolved in the lower court" — is referring to the Supreme Court's decision to allow an *entirely new issue* to be considered for the first time, when it had never even been raised by the parties — much less considered by the trial court. Thus, this quote has no relevance to the present circumstances.

In the same way, the *Duigan* decision is totally inapplicable to the case at hand.

The issue of whether Sunbeam's product configuration is a "famous mark" was raised, briefed and considered at length in the course of this case — before both the District Court and the Fifth Circuit, and the District Court's decision was affirmed. The "famous mark" issue is clearly a proper subject for this Court's consideration.

III. GRANT OF A WRIT OF CERTIORARI IS NOT IMPROPER IN A CASE INVOLVING A PRELIMINARY INJUNCTION.

Contrary to Sunbeam's suggestion, there is no requirement limiting petitions for certiorari arising from preliminary injunctions to cases which involve "extraordinary questions of federal law."

Indeed, Congress specifically authorized the grant of petitions for certiorari in cases after entry of interlocutory orders granting injunctions. 28 U.S.C. § 1254(1) and § 2101(e).

The six cases cited by Sunbeam are not on point. Four of such cases were before enactment of the statutory sections noted above,[11] and three did not involve preliminary injunctions.[12] More on point is *Air Line Pilots Association International v. UAL Corporation*, 897 F.2d 1394, 1398 (7th Cir. 1990), which states:

> A litigant in a federal case is not compelled to wait until the case is over before seeking certiorari, because it is not a requirement of certiorari to review an order of a federal court that the order be a final decision. 28 U.S.C. §§ 1254, 2101(e).

In any event, Sunbeam's argument is irrelevant. As noted above and in West Bend's petition, the instant case involves: (1) important questions on the interpretation of federal trademark law and the interplay between patent and trademark law as applied to *product configurations*; and (2) questions of first impression involving unregistered product configurations as alleged "famous" trademarks under the recent Federal Anti-Dilution Act, 15 U.S.C. § 1125(c).

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11. *American Construction Co. v. Jacksonville, T.&K.R. Co.*, 148 U.S. 372 (1893); *Hamilton-Brown Shoe Co. v. Wolfe Bros. & Co.*, 240 U.S. 251 (1916); *Meyers v. Bethlehem Corp.*, 303 U.S. 41 (1938); and *United States v. General Motors Corp.*, 323 U.S. 373 (1945).

12. *Estelle v. Gamble*, 429 U.S. 97 (1976); *Gillespie v. U.S. Steel Corp.*, 379 U.S. 148 (1964); and *General Motors, supra.*

CONCLUSION

In conclusion, West Bend respectfully asks that this Court accept the Petition for Writ of Certiorari and grant certiorari in this case.

Respectfully submitted,

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